

**REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION  
HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE EUROPEAN PATENT OFFICE (EPO) AND  
THE USPTO**

Application No:	12/674,552	Filing date:	February 22, 2010
First Named Inventor:	Sven BALK		
Title of the Invention:	PROCESS FOR PREPARING PENTABLOCK COPOLYMERS WITH OH-FUNCTIONALIZED BLOCKS <b>B</b>		

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE  
SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT  
[HTTP://WWW.USPTO.GOV/EFS/EF\\_HELP.HTML](http://www.uspto.gov/efs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE  
ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

The corresponding PCT application number(s) is/are: PCT/EP2008/060520

The international date of the corresponding PCT application(s) is/are: AUGUST 11, 2008

**I. List of Required Documents:**

- a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)

☒ Is attached See Appendix A

☐ Is not attached because the document is already in the U.S. application.

- b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).

☒ Is attached. See Appendix B and C

☐ Is not attached because the document is already in the U.S. application.

- c. English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

(continued)

Application No.:	
First Named Inventor:	

- d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

☐ WORKSHEET, TWO  
Is attached

☒ Has already been filed in the above-identified U.S. application on FEBRUARY 22, 2010

**(2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)**


☐ Are attached.

☒ Have already been filed in the above-identified U.S. application on FEBRUARY 22, 2010

## II. Claims Correspondence Table:

[illegible]

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature 	Date 9/29/10
Name (Print/Typed) Vincent K. Shier, Ph.D.	Registration Number 50,552

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant ( i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Request for Participation in the  
Patent Prosecution Highway Program  
U.S. Patent Application No. 12/674,552  
Attorney Docket No. 354652US0PCT

# APPENDIX A

Copy of the March 11, 2010 International Preliminary  
Report on Patentability Issued by the International Bureau  
of WIPO in PCT/EP2008/060520

From the INTERNATIONAL BUREAU

# PCT

NOTIFICATION OF TRANSMITTAL  
OF COPIES OF TRANSLATION  
OF THE INTERNATIONAL PRELIMINARY REPORT  
ON PATENTABILITY  
(CHAPTER I OR CHAPTER II  
OF THE PATENT COOPERATION TREATY)  
(PCT Rules 44bis.3(c) and 72.2)

To:

EVONIK RÖHM GMBH  
DG-IPM-PAT  
Postcode 84/339  
Rodenbacher Chaussee 4  
63457 Hanau  
ALLEMAGNE

19. MRZ. 2010

Standort Wolfgang

Date of mailing (day/month/year) 11 March 2010 (11.03.2010)	
Applicant's or agent's file reference 2007P00595WO	IMPORTANT NOTIFICATION
International application No. PCT/EP2008/060520	International filing date (day/month/year) 11 August 2008 (11.08.2008)
Applicant EVONIK RÖHM GMBH et al	

1. Transmittal of the translation to the applicant.



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

2. Transmittal of the copy of the translation to the designated or elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

None

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AO, AP, AT, AU, AZ, BA, BB, BG, BH, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DO, DZ, EA, EC, EE, EG, EP, ES, FI, GB, GD, GE, GH, GM, GT, HN, HR, HU, ID, IL, IN, IS, JP, KE, KG, KM, KN, KP, KR, KZ, LA, LC, LK, LR, LS, LT, LU, LY, MA, MD, ME, MG, MK, MN, MW, MX, MY, MZ, NA, NG, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RS, RU, SC, SD, SE, SG, SK, SL, SM, ST, SV, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, ZA, ZM, ZW

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.



H001008311

The International Bureau of WIPO  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

Authorized officer

Yolaine Cussac

Facsimile No. +41 22 338 82 70

e-mail: pt05.pct@wipo.int

# PCT

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 2007P00595WO	<b>FOR FURTHER ACTION</b>	See item 4 below
International application No. PCT/EP2008/060520	International filing date ( <i>day/month/year</i> ) 11 August 2008 (11.08.2008)	Priority date ( <i>day/month/year</i> ) 21 August 2007 (21.08.2007)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant EVONIK RÖHM GMBH		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 4 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- |                                     |              |   |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I    | Basis of the report   |
| <input type="checkbox"/>            | Box No. II   | Priority  |
| <input type="checkbox"/>            | Box No. III  | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability  |
| <input type="checkbox"/>            | Box No. IV   | Lack of unity of invention  |
| <input checked="" type="checkbox"/> | Box No. V    | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/>            | Box No. VI   | Certain documents cited   |
| <input type="checkbox"/>            | Box No. VII  | Certain defects in the international application  |
| <input type="checkbox"/>            | Box No. VIII | Certain observations on the international application   |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland  Facsimile No. +41 22 338 82 70	Date of issuance of this report 02 March 2010 (02.03.2010)
	Authorized officer  Yolaine Cussac  e-mail: pt05.pct@wipo.int

# PATENT COOPERATION TREATY

TRANSLATION

From the  
INTERNATIONAL SEARCHING AUTHORITY

## PCT

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing See form PCT/ISA/210  
(day/month/year)

Applicant's or agent's file reference

**2007P00595WO**

**FOR FURTHER ACTION**

See paragraph 2 below

International application No.

**PCT/EP2008/060520**

International filing date (day/month/year)

**11.08.2008**

Priority date (day/month/year)

**21.08.2007**

International Patent Classification (IPC) or both national classification and IPC

**C08F293/00 C08F297/02 C09D153/00 C09J153/00**

Applicant

**EVONIK RÖHM GMBH**

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP	Date of completion of this opinion	Authorized officer
Facsimile No.		Telephone No.

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/EP2008/060520

**Box No. I**      **Basis of this opinion**

1. With regard to the language, this opinion has been established on the basis of:
  - ☒ the international application in the language in which it was filed
  - ☐ a translation of the international application into \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).
2. ☐ This opinion has been established taking into account the rectification of an obvious mistake authorized by or notified to this Authority under Rule 91 (Rule 43bis.1(a))
3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material
    - ☐ a sequence listing
    - ☐ table(s) related to the sequence listing
  - b. format of material
    - ☐ on paper
    - ☐ in electronic form
  - c. time of filing/furnishing
    - ☐ contained in the international application as filed
    - ☐ filed together with the international application in electronic form
    - ☐ furnished subsequently to this Authority for the purposes of search
4. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
5. Additional comments:

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/EP2008/060520

<b>Box No. V</b>	<b>Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</b>		
<b>1. Statement</b>			
Novelty (N)	Claims	1-40	YES
	Claims		NO
Inventive step (IS)	Claims	1-40	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-40	YES
	Claims		NO
<b>2. Citations and explanations:</b>			
<p>None of the citations discloses pentablock copolymers according to claims 36-38, containing two blocks based on a hydroxyl-containing (meth)acrylate, three blocks based on (meth)acrylates without hydroxyl groups, wherein two of the three blocks are of corresponding composition and one block has a different composition. The pentablock copolymers of claims 36-38, the process for preparation thereof and the use thereof are therefore novel and involve an inventive step (PCT Article 33(2) and (3)).</p> <p>The requirements of PCT Article 33(4) are met.</p>			

Request for Participation in the  
Patent Prosecution Highway Program  
U.S. Patent Application No. 12/674,552  
Attorney Docket No. 354652US0PCT

## APPENDIX B

Copy of Claims Receiving Favorable Treatment in the IPRP  
Issued by the International Bureau of WIPO in  
PCT/EP2008/060520 (issued as WO 2009/024495)

(12) NACH DEM VERTRAG ÜBER DIE INTERNATIONALE ZUSAMMENARBEIT AUF DEM GEBIET DES  
PATENTWESENS (PCT) VERÖFFENTLICHTE INTERNATIONALE ANMELDUNG

(19) Weltorganisation für geistiges Eigentum  
Internationales Büro



(43) Internationales Veröffentlichungsdatum  
26. Februar 2009 (26.02.2009)

PCT

(10) Internationale Veröffentlichungsnummer  
**WO 2009/024495 A1**

(51) Internationale Patentklassifikation:

C08F 293/00 (2006.01) C09D 153/00 (2006.01)  
C08F 297/02 (2006.01) C09J 153/00 (2006.01)

Thomas [DE/DE]; Göppinger Strasse 4, 40593 Düsseldorf  
(DE).

(21) Internationales Aktenzeichen: PCT/EP2008/060520

(74) Gemeinsamer Vertreter: EVONIK RÖHM GMBH;  
DG-IPM-PAT, Postcode 84/339, Rodenbacher Chaussee 4,  
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(22) Internationales Anmeldedatum:

11. August 2008 (11.08.2008)

(25) Einreichungssprache: Deutsch

(26) Veröffentlichungssprache: Deutsch

(30) Angaben zur Priorität:

102007039535.5 21. August 2007 (21.08.2007) DE

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(81) Bestimmungsstaaten (soweit nicht anders angegeben, für  
jede verfügbare nationale Schutzrechtsart): AE, AG, AL,  
AM, AO, AT, AU, AZ, BA, BB, BG, BH, BR, BW, BY,  
BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DO,  
DZ, EC, EE, EG, ES, FI, GB, GD, GE, GH, GM, GT, HN,  
HR, HU, ID, IL, IN, IS, JP, KE, KG, KM, KN, KP, KR, KZ,  
LA, LC, LK, LR, LS, LT, LU, LY, MA, MD, ME, MG, MK,  
MN, MW, MX, MY, MZ, NA, NG, NI, NO, NZ, OM, PG,  
PH, PL, PT, RO, RS, RU, SC, SD, SE, SG, SK, SL, SM,  
ST, SV, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ,  
VC, VN, ZA, ZM, ZW.

(84) Bestimmungsstaaten (soweit nicht anders angegeben, für  
jede verfügbare regionale Schutzrechtsart): ARIPO (BW,  
GH, GM, KE, LS, MW, MZ, NA, SD, SL, SZ, TZ, UG,  
ZM, ZW), eurasisches (AM, AZ, BY, KG, KZ, MD, RU,  
TJ, TM), europäisches (AT, BE, BG, CH, CY, CZ, DE, DK,  
EE, ES, FI, FR, GB, GR, HR, HU, IE, IS, IT, LT, LU, LV,  
MC, MT, NL, NO, PL, PT, RO, SE, SI, SK, TR), OAPI (BF,  
BJ, CF, CG, CI, CM, GA, GN, GQ, GW, ML, MR, NE, SN,  
TD, TG).

Veröffentlicht:

— mit internationalem Recherchenbericht

(54) Title: METHOD FOR PREPARATION OF PENTA-BLOCK COPOLYMERS WITH OH-FUNCTIONALIZED BLOCKS  
BASED ON (METH)ACRYLATE

(54) Bezeichnung: VERFAHREN ZUR HERSTELLUNG VON PENTABLOCKCOPOLYMEREN MIT OH-FUNKTIONALI-  
SIERTEN BLÖCKEN AUF (METH)ACRYLATBASIS

(57) Abstract: The invention relates to a method for preparation of CABAC- and/or ACBCA-penta-block copolymers based on  
(meth)acrylate, with an OH-functionalizing of the A-blocks.

(57) Zusammenfassung: Die Erfindung betrifft ein Verfahren zur Herstellung von CABAC- bzw. ACBCA-Pentablockcopoly-  
meren auf (Meth)acrylatbasis mit einer OH-Funktionalisierung der A-Blöcke.

WO 2009/024495 A1

## **Verfahren zur Herstellung von Pentablockcopolymeren mit OH-funktionalisierten Blöcken auf (Meth)acrylatbasis**

### Gebiet der Erfindung

Die Erfindung betrifft ein weiteres Verfahren zur Herstellung von CABAC- bzw. ACBCA-Pentablockcopolymeren auf (Meth)acrylatbasis mit einer OH-Funktionalisierung der A-Blöcke und deren Verwendung zum Beispiel als Formulierungsbestandteil von Reaktivschmelzklebstoffen.

Maßgeschneiderte Copolymere mit definierter Zusammensetzung, Kettenlänge, Molmassenverteilung usw. sind ein breites Forschungsfeld. Man unterscheidet unter anderem zwischen Gradienten- und Blockpolymeren. Für solche Materialien sind verschiedene Anwendungen denkbar. Im Folgenden sollen einige davon kurz vorgestellt werden. Dazu wurden unter anderem Einsatzbereiche ausgewählt, in denen Polymere eingesetzt werden, von denen die aktuelle Erfindung abzugrenzen ist.

Reaktivklebstoffe sind bei Raumtemperatur feste Substanzen. Sie werden durch Erwärmen aufgeschmolzen und auf ein Substrat aufgebracht. Beim Abkühlen verfestigt sich die Klebmasse wieder und bindet somit das Substrat. Zusätzlich vernetzen die in der Klebmasse enthaltenen Polymere durch Reaktion mit Feuchtigkeit. Durch diesen Vorgang erfolgt ein endgültiges, irreversibles Aushärten.

## Stand der Technik

Derartige Klebstoffe sind zum Beispiel in US 5,021,507 beschrieben. Hauptbestandteil dieser Klebstoffe sind Verbindungen mit freien Isocyanatgruppen, welche meist durch Kondensationsreaktion eines Überschusses von Polyisocyanatgruppen mit Polyolen erhalten werden. Zur Verbesserung der Hafteigenschaften auf bestimmten Substraten wurden diesen Verbindungen mit freien Isocyanatgruppen Bindemittel, bestehend aus Polymeren aus ethylenisch ungesättigten Monomeren, zugegeben. Als Bindemittel werden typischerweise Polyalkyl(meth)acrylate mit C<sub>1</sub>- bis C<sub>20</sub>-Alkylgruppen verwendet. Diese werden aus den entsprechenden Monomeren entweder vor der Zugabe zu den Urethanen oder in deren Beisein durch freie, radikalische Polymerisation polymerisiert.

In US 5,866,656 sowie in EP 1 036 103 werden Reaktivschmelzklebstoffe beschrieben, bei denen die Bindemittel aus Poly(meth)acrylat kovalent an die Verbindungen mit freien Isocyanatgruppen in der Klebstoffzusammensetzung gebunden sind. Da diese Bindung meist durch eine Kondensationsreaktion erfolgt, spricht man bei solchen Klebstoffen, bei denen diese Bindung ausgebildet ist, von Klebstoffen in der Kondensationsstufe. Die so erhaltenen Klebstoffe zeichnen sich gegenüber denen in US 5,021,507 beschriebenen durch eine erhöhte Elastizität und eine verbesserte Haftung auf bestimmten Metallsubstraten sowie einer längeren offenen - zur Verarbeitung zur Verfügung stehenden - Zeit aus.

Allerdings weisen diese Reaktivschmelzklebstoffe erhebliche Nachteile auf. So zeigen sie zum Beispiel nur eine geringe Anfangsfestigkeit. Daraus resultiert eine besonders lange, nachteilige Fixierzeit nach dem Auftragen der Klebmasse.

Ein weiterer Nachteil der Reaktivklebstoffe des Standes der Technik ist die bei der Verarbeitung relevante, hohe Viskosität. Dadurch ist ein Verarbeiten des geschmolzenen Reaktivschmelzklebstoffs, vor allem das Auftragen auf poröse Substrate, deutlich erschwert. Teilweise tritt auch eine Vergelung in der Kondensationsstufe auf.

Ein weiterer Nachteil ist, dass der extrahierbare Anteil im ausgehärteten Klebstoff recht hoch ist. Dies verringert unter anderem die Beständigkeit der Klebmasse gegenüber Lösungsmitteln.

Weiterhin nachteilig ist, dass die freiradikalisch polymerisierten Materialien auch einen höheren Anteil niedermolekularer Bestandteile, die an den Vernetzungsreaktionen nicht teilnehmen und den extrahierbaren Bestandteil entsprechender Reaktivschmelzklebstoffe darstellen, enthalten.

Mit einer anderen Art der Polymerisation ist man dem Ziel maßgeschneiderter Polymere ein gutes Stück näher gekommen. Die ATRP-Methode (atom transfer radical polymerization) wurde in den 1990-er Jahren maßgeblich von Prof. Matyjaszewski entwickelt (Matyjaszewski et al., J.Am.Chem.Soc., 1995, 117, S.5614; WO 97/18247; Science, 1996, 272, S.866) speziell auch mit 2-Hydroxyethyl(meth)acrylat (HEMA) (Beers et al., Macromolecules; 1999, 32, S.5772-5776). Die ATRP liefert engverteilte (Homo)Polymere im Molmassenbereich von  $M_n=10.000-120.000$  g/mol. Ein besonderer Vorteil dabei ist, dass sowohl das Molekulargewicht als auch die Molekulargewichtsverteilung regelbar sind. Als lebende Polymerisation gestattet sie ferner den gezielten Aufbau von Polymerarchitekturen wie beispielsweise statistische Copolymere oder auch Block-Copolymer-Strukturen. Durch entsprechende Initiatoren sind z.B. zusätzlich ungewöhnliche Block-Copolymere und Sternpolymere zugänglich. Theoretische Grundlagen zum Polymerisationsmechanismus sind unter anderem in Hans Georg Elias, Makromoleküle, Band 1, 6.Auflage, Weinheim 1999, S.344 erläutert.

Die oben beschriebenen Probleme wurden in WO 05/047359 insofern gelöst, dass durch Anwendung einer kontrollierten Polymerisationsmethode, in Form der atom transfer radical polymerisation (ATRP), Bindemittel mit sehr engen Molekulargewichtsverteilungen zur Verfügung gestellt werden konnten, die durch den gegenüber freiradikalisch polymerisiert (Meth)acrylaten einen nur geringen Anteil hochmolekularer Bestandteile aufweisen. Diese Bestandteile bewirken in Polymermischungen insbesondere eine Erhöhung der Viskosität.

Nachteil der nach WO 05/047359 dargestellten Reaktivklebstoffe ist jedoch eine statistische Verteilung der Hydroxy-, Mercapto-, bzw. Amingruppen in der Polymerkette

des Bindemittels. Dies führt zu einer engmaschigen Vernetzung und einer somit verminderten Elastizität der Klebmasse. Daraus kann auch eine Verschlechterung der Substratbindung resultieren. Dieser Nachteil kommt insbesondere zum Tragen, wenn man Polyisocyanate mit mehr als zwei freien Isocyanatgruppen als Formulierungsbestandteil des Reaktivschmelzklebstoffs verwendet. Zur Auflistung und Beschreibung der freien Isocyanatgruppen tragenden Verbindungen sei auf die entsprechende Beschreibung in WO 05/047359 verwiesen.

Für Dispersionen mit geringer Schaumbildung werden beispielsweise in DE 102 36 133 und DE 141 60 19 durch lebende bzw. kontrollierte Polymerisation Gradientencopolymere hergestellt. Gradientencopolymere sind Copolymere, die zum Beispiel aus den Monomeren A und B bestehen, in deren Einzelketten ein Gradient der Verteilung der Monomerbausteine entlang der Ketten besteht. Das eine Kettenende ist reich an Monomer A und arm an Monomer B, das andere Ende reich an Monomer B und arm an Monomer A. Gradientencopolymere grenzen sich zu Blockcopolymeren durch den fließenden Übergang zwischen den Monomeren A und B ab.

Blockpolymere haben einen sprunghaften Übergang zwischen den Monomeren in der Polymerkette, der als Grenze zwischen den einzelnen Blöcken definiert ist. Ein übliches Syntheseverfahren für AB-Blockpolymere ist die kontrollierte Polymerisation von Monomer A und zu einem späteren Zeitpunkt die Zugabe von Monomer B. Neben der sequentiellen Polymerisation durch chargenweise Zugabe in das Reaktionsgefäß kann ein ähnliches Ergebnis auch dadurch erzielt werden, dass man bei einer kontinuierlichen Zugabe der beiden Monomere deren Zusammensetzungen zu bestimmten Zeitpunkten sprunghaft ändert. Mit einer sprunghaften Änderung können auch kurze Übergangsbereiche, in denen die zwei Wiederholungseinheiten gemischt vorliegen können, gemeint sein.

Als lebende bzw. kontrollierte Polymerisationsmethoden eignen sich neben der anionischen oder der Gruppentransfer-Polymerisation auch moderne Methoden der kontrollierten radikalischen Polymerisation wie z.B. die RAFT-Polymerisation. Der Mechanismus der RAFT-Polymerisation wird in WO 98/01478 bzw. EP 0 910 587 näher beschrieben. Anwendungsbeispiele finden sich in EP1 205 492.

In der EP 1 375 605 werden über die ATRP-Methode AB-Blockcopolymerisate hergestellt. Als polare Komponente wird HEMA eingesetzt. Damit soll eine gute Verträglichkeit mit anderen Stoffen ermöglicht werden.

Mit der WO 00/75791 werden AB-Diblockcopolymerisate aus MMA und einer Mischung aus n-BA und HEMA mit monofunktionalisierten Katalysatoren hergestellt. Die Blöcke sind Amin-funktionalisiert. Dadurch kommt es zu Verfärbungen und Beeinträchtigungen des Geruches. Ferner weisen Polymere mit einer AB-Diblockstruktur dieser Art ein für die erfindungsgemäßen Anwendungen nicht gewünschten Polaritätsunterschied zwischen den Kettenenden auf.

In EP 1475397 werden Di- und Triblockcopolymere der Form AB bzw. ABA mit zumindest einem OH-funktionalisierten Block beschrieben. In US 2004 0147674 werden entsprechende Polymere und deren Formulierung mit kristallinen Harzen beansprucht. In beiden Schriften handelt es sich um Copolymere mit einer Acrylat und einer härteren (Meth)acrylat Zusammensetzung. Die Polymere werden ebenfalls über das ATRP-Verfahren dargestellt und finden in Kleb- bzw. Dichtstoffformulierungen Anwendung. Die hier beschriebenen Triblockcopolymere haben im Vergleich zu den erfindungsgemäßen Pentablockcopolymeren der Form CABAC bzw. ACBCA jedoch den Nachteil, dass entweder das gesamte Hart- oder Weichsegment funktionalisiert ist. Bei den erfindungsgemäßen Polymeren dagegen ist nur ein kurzes Segment der Kette OH-funktionalisiert, so dass der nicht funktionalisierte Hartblock zu einer ausreichenden Kohäsion und der nicht funktionalisierte Weichblock zu einer guten Adhäsion beitragen können. Im Falle der ABA-Triblockcopolymere muss aufgrund der Funktionalisierung zumindest einer der beiden Segmente A oder B Eigenschaftsverluste einer der beiden für Kleb- bzw. Dichtstoffe wichtigen Parameter Rechnung getragen werden. Ferner kann durch Wahl geeigneter Segmentlängen die Vernetzungsdicht gut eingestellt werden. Ein weiterer Vorteil der erfindungsgemäßen Pentablockcopolymere insbesondere der Form CABAC ist, dass durch die Funktionalisierung der Zwischenblöcke A, die Hart- (A oder B) und Weichblöcke (entsprechend B oder A) im Netzwerk von einander getrennt sind und so jeweils zu einer Verbesserung der Adhäsion bzw. Kohäsion beitragen können.

## Aufgabe

Eine neue Stufe der Entwicklung sind die im Folgenden beschriebenen Pentablockcopolymere.

Aufgabe war es, Pentablockcopolymere der Struktur CABAC bzw. ACBCA darzustellen. Insbesondere besteht der Bedarf an OH-terminierten (Meth)acrylaten bzw. (Meth)acrylaten, die in Ihren Eigenschaften OH-terminierten Materialien entsprechen oder sehr nahe kommen. Dies kann zum Beispiel durch den Einbau einer bis weniger OH-Gruppen am Kettenende erreicht werden. Mit Kettenenden wird das Endsegment eines Polymers bezeichnet, das max. 1 Gew.-% - 20 Gew.-% des Gesamtgewichtes des Polymeren ausmacht.

Unabhängig davon besteht der Bedarf an polymeren Blockstrukturen, die über nicht funktionalisierte Weichsegmente mit hoher Adhäsionswirkung, nicht funktionalisierte Hartsegmente mit guter Kohäsionswirkung und OH-funktionalisierte Segmente für Folgereaktionen wie z.B. eine Vernetzungsreaktion verfügen. Solche Polymere lassen sich erfindungsgemäß durch eine sequentielle Polymerisation unter Aufbau von Pentablockstrukturen der Form ACBCA oder CABAC aufbauen.

Eine weitere Aufgabe der Erfindung ist es, reaktive Hydroxygruppen enthaltene Polymere als Bindemittel derart zur Verfügung zu stellen, dass die Zahl solcher Gruppen im Polymer, unter guter Verfügbarkeit für die Aushärtungsreaktion, möglichst gering gehalten wird. Ein höherer Anteil polarer Gruppen im Bindemittel führt zu einer eventuellen Vergelung oder zumindest zu einer zusätzlichen Erhöhung der Schmelzviskosität des Reaktivschmelzklebstoffes.

Eine weitere Aufgabe ist es, ein solches Material mit einer möglichst engen Molekulargewichtsverteilung unter 1,8, bevorzugt unter 1,6 zur Verfügung zu stellen. Auf diese Weise werden sowohl die Anteile höhermolekularer Bestandteile, die u.a. zu einer ungewünschten Erhöhung der Schmelzviskosität beitragen, als auch die Anteile besonders niedermolekularer Bestandteile, die eine Verschlechterung der Lösungsmittelbeständigkeit der Klebmasse hervorrufen können, minimiert.

Aufgabe der vorliegenden Erfindung ist es daher, unter anderem ein Bindemittel zur Verfügung zu stellen, das über eine geringe Anzahl freier Hydroxygruppen in zwei Kettensegmenten A verfügt. In einer Ausführung liegt ein Pentablockcopolymer der Form ABCBA, das die OH-Gruppen in der Nähe der Kettenenden aufweist, vor. In einer zweiten Ausführung handelt es sich um Pentablockcopolymer der Form CABAC, das zwei OH-funktionalisierte Zwischensegmente A enthält.

#### Lösung

Die Aufgabe wurde gelöst durch das zur Verfügung Stellen von Blockcopolymeren der Zusammensetzung CABAC oder ACBCA mit  $\leq 8$  OH-Gruppen, bevorzugt  $\leq 4$  OH-Gruppe in den einzelnen A-Blöcken, dadurch gekennzeichnet, dass Block A ein Copolymer enthaltend hydroxyfunktionalisierte (Meth)acrylate und Monomere ausgewählt aus der Gruppe der (Meth)acrylate oder deren Mischungen, und ein die Blöcke B und C, enthaltend (Meth)acrylate oder deren Mischungen, die keine Hydroxyfunktion aufweisen, als Pentablockcopolymerisate polymerisiert werden.

Dabei beschreibt B entweder einen harten (Meth)acrylat-, bevorzugt Methacrylatblock oder einen weichen (Meth)acrylat-, bevorzugt Acrylatblock. C beschreibt jeweils abweichend von B einen harten (Meth)acrylat-, bevorzugt Methacrylatblock oder einen weichen (Meth)acrylat-, bevorzugt Acrylatblock, wobei C einen harten Block darstellt, wenn es sich bei B um einen Weichblock handelt oder umgekehrt. Bei A handelt es sich um einen OH-funktionalisierten Block, wobei die Hydroxylgruppen durch Copolymerisation von OH-funktionalisierten mit nicht OH-funktionalisierten Monomeren in das Polymersegment eingebaut werden. Die Zusammensetzung der nicht OH-funktionalisierten Monomere kann dabei bevorzugt entweder der Zusammensetzung der Monomermischung, die zum Aufbau des B-Blocks verwendet wird, oder der Zusammensetzung der Monomermischung, die zum Aufbau des C-Blocks verwendet wird, entsprechen.

Die Formulierung Weichblock umschreibt Polymersegmente mit einer Glasübergangstemperatur  $T_g$ , die kleiner als 0 °C ist. Die Formulierung Hartblock beschreibt Polymersegmente mit einer Glasübergangstemperatur  $T_g$  größer 50 °C. Die Glasübergangstemperatur  $T_g$  wird mittels Differential Scanning Calorimetry (DSC) bestimmt.

Es wurde gefunden, dass auch ACBCA- bzw. CABAC-Blockcopolymeren mit  $\leq 2$  OH-Gruppen in den einzelnen A-Blöcken dargestellt werden können.

Die Blockcopolymeren der Zusammensetzung CABAC bzw. ACBCA bestehen zu weniger als 20% des Gesamtgewichtes, bevorzugt weniger als 10%, aus A-Blöcken.

Es können sowohl den Copolymeren des Blockes A, als auch den Copolymeren der Blöcke B bzw. C 0 Gew.-% - 50 Gew.-% mittels ATRP polymerisierbare Monomere, die nicht zu der Gruppe der (Meth)acrylate gezählt werden, zugegeben werden.

Die Schreibweise (Meth)acrylat steht für die Ester der (Meth)acrylsäure und bedeutet hier sowohl Methacrylat, wie z.B. Methylmethacrylat, Ethylmethacrylat usw., als auch Acrylat, wie z.B. Methylacrylat, Ethylacrylat usw., sowie Mischungen aus beiden.

Zudem wurde ein Verfahren zur Herstellung von Blockcopolymeren der Zusammensetzung CABAC entwickelt. Mit einer speziellen Form der lebenden Polymerisation, der Atom Transfer Radical Polymerisation (ATRP), können gut kontrollierte Zusammensetzungen, Architekturen und definierte Funktionalitäten in ein Polymeres eingebaut werden.

Es wurde gefunden, dass durch den Einsatz eines bifunktionalen Initiators gezielt eine CABAC Struktur aufgebaut werden kann.

Hydroxyfunktionalisierte (Meth)acrylate die in Block A polymerisiert werden sind bevorzugt Hydroxyalkyl(meth)acrylate von gradkettigen, verzweigten oder cycloaliphatischen Diolen mit 2-36 C-Atomen, wie beispielsweise 3-Hydroxypropyl(meth)acrylat, 3,4-Dihydroxybutylmono(meth)acrylat, 2-Hydroxyethyl(meth)acrylat, 4-Hydroxybutyl(meth)acrylat, 2-Hydroxypropyl(meth)acrylat,

2,5-Dimethyl-1,6-hexandiolmono(meth)acrylat, besonders bevorzugt 2-Hydroxyethylmethacrylat.

Monomere die sowohl in Block A als auch in Block B bzw. C polymerisiert werden sind ausgewählt aus der Gruppe der (Meth)acrylate wie beispielsweise Alkyl(meth)acrylate von gradkettigen, verzweigten oder cycloaliphatischen Alkoholen mit 1 bis 40 C-Atomen, wie zum Beispiel Methyl(meth)acrylat, Ethyl(meth)acrylat, n-Butyl(meth)acrylat, i-Butyl(meth)acrylat, t-Butyl(meth)acrylat, Pentyl(meth)acrylat, 2-Ethylhexyl(meth)acrylat, Stearyl(meth)acrylat, Lauryl(meth)acrylat, Cyclohexyl(meth)acrylat, Isobornyl(meth)acrylat; Aryl(meth)acrylate wie zum Beispiel Benzyl(meth)acrylat oder Phenyl(meth)acrylat die jeweils unsubstituiert oder 1-4-fach substituierte Arylreste aufweisen können; andere aromatisch substituierte (Meth)acrylate wie beispielsweise Naphthyl(meth)acrylat; Mono(meth)acrylate von Ethern, Polyethylenglycolen, Polypropylenglycolen oder deren Mischungen mit 5-80 C-Atomen, wie beispielsweise Tetrahydrofurfurylmethacrylat, Methoxy(m)ethoxyethylmethacrylat, 1-Butoxypropylmethacrylat, Cyclohexyloxymethylmethacrylat, Benzyloxymethylmethacrylat, Furfurylmethacrylat, 2-Butoxyethylmethacrylat, 2-Ethoxyethylmethacrylat, Allyloxymethylmethacrylat, 1-Ethoxybutylmethacrylat, 1-Ethoxyethylmethacrylat, Ethoxymethylmethacrylat, Poly(ethylenglycol)methylether(meth)acrylat und Poly(propylenglycol)methylether(meth)acrylat.

Neben den zuvor dargelegten (Meth)acrylaten können die zu polymerisierenden Zusammensetzungen auch weitere ungesättigte Monomere aufweisen, die mit den zuvor genannten (Meth)acrylaten und mittels ATRP copolymerisierbar sind. Hierzu gehören unter anderem 1-Alkene, wie 1-Hexen, 1-Hepten, verzweigte Alkene wie beispielsweise Vinylcyclohexan, 3,3-Dimethyl-1-propen, 3-Methyl-1-diisobutylen, 4-Methyl-1-penten, Acrylnitril, Vinylester wie z.B. Vinylacetat, Styrol, substituierte Styrole mit einem Alkylsubstituenten an der Vinylgruppe, wie z.B.  $\alpha$ -Methylstyrol und  $\alpha$ -Ethylstyrol, substituierte Styrole mit einem oder mehreren Alkylsubstituenten am Ring wie Vinyltoluol und p-Methylstyrol, halogenierte Styrole wie beispielsweise Monochlorstyrole, Dichlorstyrole, Tribromstyrole und Tetrabromstyrole; heterocyclische

Verbindungen wie 2-Vinylpyridin, 3-Vinylpyridin, 2-Methyl-5-vinylpyridin, 3-Ethyl-4-vinylpyridin, 2,3-Dimethyl-5-Vinylpyridin, Vinylpyrimidin, 9-Vinylcarbazol, 3-Vinylcarbazol, 4-Vinylcarbazol, 2-Methyl-1-vinylimidazol, Vinloxolan, Vinylfuran, Vinylthiophen, Vinylthiolan, Vinylthiazole, Vinyloxazole und Isoprenylether; Maleinsäurederivate, wie beispielsweise Maleinsäureanhydrid, Maleinimid, Methylmaleinimid und Diene wie z.B. Divinylbenzol, sowie in den A-Blöcken die jeweiligen hydroxyfunktionalisierten und/oder aminofunktionalisierten und/oder mercaptofunktionalisierten Verbindungen. Ferner können diese Copolymere auch derart hergestellt werden, dass sie eine Hydroxy- und/oder Amino- und/oder Mercaptofunktionalität in einem Substituenten aufweisen. Solche Monomere sind beispielsweise Vinylpiperidin, 1-Vinylimidazol, N-Vinylpyrrolidon, 2-Vinylpyrrolidon, N-Vinylpyrrolidin, 3-Vinylpyrrolidin, N-Vinylcaprolactam, N-Vinylbutyrolactam, hydrierte Vinylthiazole und hydrierte Vinyloxazole. Besonders bevorzugt werden Vinylester, Vinylether, Fumarate, Maleate, Styrole oder Acrylonitrile mit den A-Blöcken und/oder B-Blöcken copolymerisiert.

Das Verfahren kann in beliebigen halogenfreien Lösungsmitteln durchgeführt werden. Bevorzugt werden Toluol, Xylol, H<sub>2</sub>O; Acetate, vorzugsweise Butylacetat, Ethylacetat, Propylacetat; Ketone, vorzugsweise Ethylmethylketon, Aceton; Ether; Aliphate, vorzugsweise Pentan, Hexan, aber auch Biodiesel.

Die Blockcopolymere der Zusammensetzung CABAC werden mittels sequentieller Polymerisation dargestellt.

Neben der Lösungspolymerisation kann die ATRP auch als Emulsions-, Miniemulsions-, Mikroemulsions-, Suspension- oder Substanzpolymerisation durchgeführt werden.

Die Polymerisation kann bei Normaldruck, Unter- oder Überdruck durchgeführt werden. Auch die Polymerisationstemperatur ist unkritisch. Im Allgemeinen liegt sie jedoch im Bereich von -20°C bis 200°C, vorzugsweise von 0°C bis 130°C und besonders bevorzugt von 50°C bis 120°C.

Vorzugsweise weist das erfindungsgemäße Polymer ein zahlenmittleres Molekulargewicht zwischen 5.000 g/mol und 120.000 g/mol, besonders bevorzugt

$\leq 50000$  g/mol und ganz besonders bevorzugt zwischen 7.500 g/mol und 25.000 g/mol auf.

Es wurde gefunden, dass die Molekulargewichtsverteilung unter 1,8, bevorzugt unter 1,6, besonders bevorzugt unter 1,4 und idealerweise unter 1,3 liegt.

Als bifunktionelle Initiatoren können  $\text{RO}_2\text{C-CHX-(CH}_2)_n\text{-CHX-CO}_2\text{R}$ ,  $\text{RO}_2\text{C-C(CH}_3)_n\text{-X-(CH}_2)_n\text{-C(CH}_3)_n\text{-X-CO}_2\text{R}$ ,  $\text{RO}_2\text{C-CX}_2\text{-(CH}_2)_n\text{-CX}_2\text{-CO}_2\text{R}$ ,  $\text{RC(O)-CHX-(CH}_2)_n\text{-CHX-C(O)R}$ ,  $\text{RC(O)-C(CH}_3)_n\text{-X-(CH}_2)_n\text{-C(CH}_3)_n\text{-X-C(O)R}$ ,  $\text{RC(O)-CX}_2\text{-(CH}_2)_n\text{-CX}_2\text{-C(O)R}$ ,  $\text{XCH}_2\text{-CO}_2\text{-(CH}_2)_n\text{-OC(O)CH}_2\text{X}$ ,  $\text{CH}_3\text{CHX-CO}_2\text{-(CH}_2)_n\text{-OC(O)CHXCH}_3$ ,  $\text{(CH}_3)_2\text{CX-CO}_2\text{-(CH}_2)_n\text{-OC(O)CX(CH}_3)_2$ ,  $\text{X}_2\text{CH-CO}_2\text{-(CH}_2)_n\text{-OC(O)CHX}_2$ ,  $\text{CH}_3\text{CX}_2\text{-CO}_2\text{-(CH}_2)_n\text{-OC(O)CX}_2\text{CH}_3$ ,  $\text{XCH}_2\text{C(O)C(O)CH}_2\text{X}$ ,  $\text{CH}_3\text{CHXC(O)C(O)CHXCH}_3$ ,  $\text{XC(CH}_3)_2\text{C(O)C(O)CX(CH}_3)_2$ ,  $\text{X}_2\text{CHC(O)C(O)CHX}_2$ ,  $\text{CH}_3\text{CX}_2\text{C(O)C(O)CX}_2\text{CH}_3$ ,  $\text{XCH}_2\text{-C(O)-CH}_2\text{X}$ ,  $\text{CH}_3\text{-CHX-C(O)-CHX-CH}_3$ ,  $\text{CX(CH}_3)_2\text{-C(O)-CX(CH}_3)_2$ ,  $\text{X}_2\text{CH-C(O)-CHX}_2$ ,  $\text{C}_6\text{H}_5\text{-CHX-(CH}_2)_n\text{-CHX-C}_6\text{H}_5$ ,  $\text{C}_6\text{H}_5\text{-CX}_2\text{-(CH}_2)_n\text{-CX}_2\text{-C}_6\text{H}_5$ ,  $\text{C}_6\text{H}_5\text{-CX}_2\text{-(CH}_2)_n\text{-CX}_2\text{-C}_6\text{H}_5$ , o-, m- bzw. p- $\text{XCH}_2\text{-Ph-CH}_2\text{X}$ , o-, m- bzw. p- $\text{CH}_3\text{CHX-Ph-CHXCH}_3$ , o-, m- bzw. p- $\text{(CH}_3)_2\text{CX-Ph-CX(CH}_3)_2$ , o-, m- bzw. p- $\text{CH}_3\text{CX}_2\text{-Ph-CX}_2\text{CH}_3$ , o-, m- bzw. p- $\text{X}_2\text{CH-Ph-CHX}_2$ , o-, m- bzw. p- $\text{XCH}_2\text{-CO}_2\text{-Ph-OC(O)CH}_2\text{X}$ , o-, m- bzw. p- $\text{CH}_3\text{CHX-CO}_2\text{-Ph-OC(O)CHXCH}_3$ , o-, m- bzw. p- $\text{(CH}_3)_2\text{CX-CO}_2\text{-Ph-OC(O)CX(CH}_3)_2$ ,  $\text{CH}_3\text{CX}_2\text{-CO}_2\text{-Ph-OC(O)CX}_2\text{CH}_3$ , o-, m- bzw. p- $\text{X}_2\text{CH-CO}_2\text{-Ph-OC(O)CHX}_2$  oder o-, m- bzw. p- $\text{XSO}_2\text{-Ph-SO}_2\text{X}$  (X steht für Chlor, Brom oder Iod; Ph steht für Phenylen ( $\text{C}_6\text{H}_4$ )); R repräsentiert einen aliphatischen Rest aus 1 bis 20 Kohlenstoffatomen, der linearer, verzweigter oder auch cyclischer Struktur sein kann, gesättigt oder einfach bzw. mehrfach ungesättigt sein kann und einen bzw. mehrere Aromaten enthalten kann oder aber aromatenfrei ist und n ist eine Zahl zwischen 0 und 20) werden. Vorzugsweise werden 1,4-Butandiol-di-(2-bromo-2-methylpropionat), 1,2-Ethylenglycol-di-(2-bromo-2-methylpropionat), 2,5-Dibrom-adipinsäure-di-ethylester oder 2,3-Dibrom-maleinsäure-di-ethylester verwendet. Aus dem Verhältnis Initiator zu Monomer ergibt sich das spätere Molekulargewicht, falls das gesamte Monomer umgesetzt wird.

Katalysatoren für ATRP sind in Chem.Rev. 2001, 101, 2921 aufgeführt. Es werden überwiegend Kupferkomplexe beschrieben - unter anderem kommen aber auch Eisen-, Rhodium-, Platin-, Ruthenium- oder Nickelverbindungen zur Anwendung. Allgemein

können alle Übergangsmetallverbindungen verwendet werden, die mit dem Initiator, bzw. der Polymerkette, die eine übertragbare Atomgruppe aufweist, einen Redox-Zyklus bilden können. Kupfer kann dazu beispielsweise ausgehend von  $\text{Cu}_2\text{O}$ ,  $\text{CuBr}$ ,  $\text{CuCl}$ ,  $\text{CuI}$ ,  $\text{CuN}_3$ ,  $\text{CuSCN}$ ,  $\text{CuCN}$ ,  $\text{CuNO}_2$ ,  $\text{CuNO}_3$ ,  $\text{CuBF}_4$ ,  $\text{Cu}(\text{CH}_3\text{COO})$  oder  $\text{Cu}(\text{CF}_3\text{COO})$  dem System zugeführt werden.

Eine Alternative zu der beschriebenen ATRP stellt eine Variante derselben dar: In der so genannten reversen ATRP können Verbindungen in höheren Oxidationsstufen wie z.B.  $\text{CuBr}_2$ ,  $\text{CuCl}_2$ ,  $\text{CuO}$ ,  $\text{CrCl}_3$ ,  $\text{Fe}_2\text{O}_3$  oder  $\text{FeBr}_3$  eingesetzt werden. In diesen Fällen kann die Reaktion mit Hilfe klassischer Radikalbildner wie beispielsweise AIBN initiiert werden. Hierbei werden die Übergangsmetallverbindungen zunächst reduziert, da sie mit den aus den klassischen Radikalbildnern erzeugten Radikalen umgesetzt werden. Die reverse ATRP wurde u.a. von Wang und Matyjaszewski in *Macromolecules* (1995), Bd. 28, S. 7572ff beschrieben.

Eine Variante der reversen ATRP stellt der zusätzliche Einsatz von Metallen in der Oxidationsstufe null dar. Durch eine anzunehmende Komproportionierung mit den Übergangsmetallverbindungen der höheren Oxidationsstufe wird eine Beschleunigung der Reaktionsgeschwindigkeit bewirkt. Dieses Verfahren wird in WO 98/40415 näher beschrieben.

Das molare Verhältnis Übergangsmetall zu bifunktionellem Initiator liegt im Allgemeinen im Bereich von 0,02:1 bis 20:1, vorzugsweise im Bereich von 0,02:1 bis 6:1 und besonders bevorzugt im Bereich von 0,2:1 bis 4:1, ohne dass hierdurch eine Beschränkung erfolgen soll.

Um die Löslichkeit der Metalle in organischen Lösungsmitteln zu erhöhen und gleichzeitig die Bildung stabiler und dadurch polymerisationsinaktiver Organometallverbindungen zu vermeiden, werden Liganden dem System zugegeben. Zusätzlich erleichtern die Liganden die Abstraktion der übertragbaren Atomgruppe durch die Übergangsmetallverbindung. Eine Auflistung bekannter Liganden findet sich beispielsweise in WO 97/18247, WO 97/47661 oder WO 98/40415. Als koordinativer Bestandteil weisen die als Ligand verwendeten Verbindungen zumeist ein oder mehrere Stickstoff-, Sauerstoff-, Phosphor- und/oder Schwefelatome auf. Besonders bevorzugt

sind dabei stickstoffhaltige Verbindungen. Ganz besonders bevorzugt sind stickstoffhaltige Chelatliganden. Als Beispiele seien 2,2'-Bipyridin, N,N,N',N'',N'''-Pentamethyldiethylentriamin (PMDETA), Tris(2-aminoethyl)amin (TREN), N,N,N',N'-Tetramethylethyldiamin oder 1,1,4,7,10,10-Hexamethyltriethylentetramin aufgeführt. Wertvolle Hinweise zur Auswahl und Kombination der einzelnen Komponenten findet der Fachmann in WO 98/40415.

Diese Liganden können in situ mit den Metallverbindungen Koordinationsverbindungen bilden oder sie können zunächst als Koordinationsverbindungen hergestellt werden und anschließend in die Reaktionsmischung gegeben werden.

Das Verhältnis Ligand (L) zu Übergangsmetall ist abhängig von der Zähigkeit des Liganden und der Koordinationszahl des Übergangsmetalls (M). Im Allgemeinen liegt das molare Verhältnis im Bereich 100:1 bis 0,1:1, vorzugsweise 6:1 bis 0,1:1 und besonders bevorzugt 3:1 bis 1:1, ohne dass hierdurch eine Beschränkung erfolgen soll.

Nach erfolgter ATRP kann die Übergangsmetallverbindung mittels Zugabe einer geeigneten Schwefelverbindung gefällt werden. Mittels Zugabe z.B. von Mercaptanen wird das kettenendständige Halogenatom unter Freisetzung eines Halogenwasserstoffs substituiert. Der Halogenwasserstoff - wie z.B. HBr - protoniert den am Übergangsmetall koordinierten Liganden L zu einem Ammoniumhalogenid. Durch diesen Vorgang wird der Übergangsmetall-Ligand Komplex gequench und das „nackte“ Metall ausgefällt. Anschließend lässt sich die Polymerlösung leicht durch eine einfache Filtration reinigen. Bei besagten Schwefelverbindungen handelt es sich bevorzugt um Verbindungen mit einer SH-Gruppe. Ganz besonders bevorzugt handelt es sich um einen aus der freiradikalischen Polymerisation bekannten Regler wie Mercaptoethanol, Ethylhexylmercaptan, n-Dodecylmercaptan oder Thioglycolsäure.

Aus den erfindungsgemäßen Copolymeren können beispielsweise Klebstoffe, Dichtmassen, Überzugsmittel oder Vergussmassen hergestellt werden. Durch die Verwendung der Copolymere kann Elastizität oder Festigkeit solcher Endprodukte

verbessert werden. Weiterhin ist eine sehr gute Haftung auf verschiedenen Substraten zu beobachten.

Ein weiterer Vorteil der Blockcopolymere ist die Farblosigkeit sowie die Geruchlosigkeit des hergestellten Produkts.

Die erfindungsgemäßen OH-Gruppen tragenden Pentablockcopolymere können in dem Fachmann bekannten Folgeverfahren weiter umgesetzt werden. Beispielsweise können die OH-Gruppen dabei mit niedermolekularen Verbindungen umgesetzt werden, die zusätzlich zu einer mit OH-Gruppen reaktiven Gruppe, beispielsweise einer NCO-Gruppe, eine weitere funktionelle unter den Reaktionsbedingungen stabile Gruppe aufweisen. Solche funktionellen Gruppen sind beispielsweise Anhydridgruppen, Säuregruppen, Silylgruppen, Epoxidgruppen oder Isocyanatgruppen. Durch diesen zusätzlichen Verfahrensschritt ist es möglich Pentablockcopolymere mit anderen funktionellen Gruppen zu erhalten.

Somit ergibt sich ein breites Anwendungsfeld für diese Produkte. Die Auswahl der Anwendungsbeispiele ist nicht dazu geeignet die Verwendung der erfindungsgemäßen Polymere einzuschränken. Die Beispiele sollen einzig dazu dienen, stichprobenartig die breite Einsatzmöglichkeit der beschriebenen Polymere darzustellen. Bevorzugt werden Blockcopolymere der Zusammensetzung CABAC oder der Zusammensetzung ACBCA als Präpolymere in Reaktivschmelzklebstoffen, Schmelzklebstoffen, Beschichtungsmassen, Grundierungslacken, PSA (Pressure sensitive adhesives), Klebmassen oder Dichtmassen verwendet. Die Blockcopolymere der Zusammensetzung CABAC oder ACBCA können auch als Additiv Verwendung finden. Ein Beispiel dafür wäre eine Zugabe als Schlagzähmodifizier in Kleb- oder Dichtstoffen.

Die im Folgenden gegebenen Beispiele werden zur besseren Veranschaulichung der vorliegenden Erfindung gegeben, sind jedoch nicht dazu geeignet, die Erfindung auf die hierin offenbarten Merkmale zu beschränken.

## Beispiele

Das Zahlenmittel  $M_n$  bzw. das Gewichtsmittel  $M_w$  des Molekulargewichts und die Molekulargewichtsverteilung  $D$  werden mittels Gelpermeationschromatographie (GPC) gegen eine PMMA-Kalibrierung gemessen.

### Beispiele 1 - 2

In einem mit Rührer, Thermometer, Rückflusskühler, Stickstoffeinleitungsrohr und Tropftrichter ausgestatteten Doppelmantelgefäß wurden unter  $N_2$ -Atmosphäre Monomer I (genaue Bezeichnung und Mengenangabe in Tabelle 2), Butylacetat, 0,9 g Kupfer(I)oxid und 2,3 g PMDETA vorgelegt. Die Lösung wird für 15 min. bei 60 °C gerührt. Anschließend wird bei gleicher Temperatur in Butylacetat gelöster Initiator 1,4-Butandiol-di-(2-bromo-2-methylpropionat) (BDBIB) zugetropft. Nach der Polymerisationszeit von 3 Stunden wird eine Probe zur Bestimmung des mittleren Molgewichts  $M_n$  (mittels SEC) entnommen und Monomer II (genaue Bezeichnung und Mengenangabe in Tabelle 2) beigelegt. Nach einem errechneten 98%igen Umsatz wird schließlich eine weitere Probe für eine SEC-Messung entnommen und die Mischung aus Monomer III und Monomer F (genaue Bezeichnung und Mengenangabe in Tabelle 2) zugegeben. Die Mischung wird bis zu einem erwarteten Umsatz von mindestens 98% polymerisiert und darauf mittels ca. fünfminütigem Einleiten von Luftsauerstoff zum Abbruch gebracht. Anschließend werden 5 g n-Dodecylmercaptan zugegeben. Die zuvor grünliche Lösung färbt sich spontan rot und ein roter Niederschlag fällt aus. Die Filtration erfolgt mittels einer Überdruckfiltration. Die Lösung wird mit 50 g Tonsil Optimum 210 FF (Fa. Südchemie) versetzt, 30 min gerührt und anschließend unter Überdruck über einen Aktivkohlefilter (AKS 5 der Fa. Pall Seitz Schenk) filtriert. Das mittlere Molekulargewicht und die Molekulargewichtsverteilung werden abschließend durch SEC-Messungen bestimmt.

**Beispiele 3 - 4**

In einem mit Rührer, Thermometer, Rückflusskühler, Stickstoffeinleitungsrohr und Tropftrichter ausgestatteten Doppelmantelgefäß wurden unter N<sub>2</sub>-Atmosphäre Monomer I (genaue Bezeichnung und Mengenangabe in Tabelle 2), Butylacetat, 0,9 g Kupfer(I)oxid und 2,3 g PMDETA vorgelegt. Die Lösung wird für 15 min. bei 60 °C gerührt. Anschließend wird bei gleicher Temperatur in 10 mL Butylacetat gelöster Initiator 1,4-Butandiol-di-(2-bromo-2-methylpropionat) (BDBIB) zugetropft. Nach einer Polymerisationszeit von 3 Stunden wird eine Probe zur Bestimmung des mittleren Molgewichts  $M_n$  (mittels SEC) entnommen und eine Mischung aus Monomer II und Monomer F (genaue Bezeichnung und Mengenangabe in Tabelle 2) beigelegt. Nach einem errechneten 98%igen Umsatz wird schließlich eine weitere Probe für eine SEC-Messung entnommen und Monomer III (genaue Bezeichnung und Mengenangabe in Tabelle 2) zugegeben. Die Mischung wird bis zu einem erwarteten Umsatz von mindestens 98% polymerisiert und darauf mittels ca. fünfminütigem Einleiten von Luftsauerstoff zum Abbruch gebracht. Anschließend werden 5 g n-Dodecylmercaptan zugegeben. Die zuvor grünliche Lösung färbt sich spontan rot und ein roter Niederschlag fällt aus. Die Filtration erfolgt mittels einer Überdruckfiltration. Die Lösung wird mit 50 g Tonsil Optimum 210 FF (Fa. Südchemie) versetzt, 30 min gerührt und anschließend unter Überdruck über einen Aktivkohlefilter (AKS 5 der Fa. Pall Seitz Schenk) filtriert. Das mittlere Molekulargewicht und die Molekulargewichtsverteilung werden abschließend durch SEC-Messungen bestimmt.

Tabelle 1

Beispiel	1	2	3	4
Monomer I	n-BA	MMA	n-BA	MMA
Menge	41,02 g	41,65 g	41,80 g	41,55 g
Monomer II	MMA	n-BA	MMA	MMA
Menge	41,02 g	41,65 g	41,23 g	41,37 g
Monomer III	MMA	n-BA	MMA	n-BA
Menge	14,66 g	14,88 g	14,85 g	14,85 g
Monomer F	HEMA	HEMA	HEMA	HEMA
Menge	3,30 g	3,25 g	3,30 g	3,30 g
Initiatormenge	2,33 g	2,55 g	2,45 g	2,48 g
M <sub>n</sub> (1.Stufe)	9300	8800	9100	8700
M <sub>n</sub> (2.Stufe)	13300	15500	13600	15700
M <sub>n</sub> (Endprodukt)	17900	18200	17200	17800
D	1,33	1,28	1,33	1,28

MMA= Methylmethacrylat; n-BA= n-Butylacrylat, HEMA= 2-Hydroxyethylmethacrylat

## Patentansprüche

1. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren, dadurch gekennzeichnet,  
dass genau zwei Blöcke, enthaltend hydroxyfunktionalisierte (Meth)acrylate und Monomere ausgewählt aus der Gruppe der nicht hydroxyfunktionalisierten (Meth)acrylate oder deren Mischungen und  
genau drei Blöcke, enthaltend (Meth)acrylate oder deren Mischungen, die keine Hydroxyfunktion aufweisen und von denen sich zwei Blöcke wiederum in ihrer Zusammensetzung entsprechen und der dritte Block eine abweichende Zusammensetzung aufweist,  
als Pentablockcopolymerisate dargestellt werden.
2. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 1, dadurch gekennzeichnet,  
dass es sich bei dem Pentablockcopolymer um ein Blockcopolymer der Form CABAC handelt,  
dass die Blöcke A aus hydroxyfunktionalisierten (Meth)acrylaten und Monomeren ausgewählt aus der Gruppe der nicht hydroxyfunktionalisierten (Meth)acrylate oder deren Mischungen zusammengesetzt sind, und  
dass die Blöcke B und C aus (Meth)acrylaten oder deren Mischungen, die keine Hydroxyfunktion enthalten, zusammengesetzt sind.
3. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 2, dadurch gekennzeichnet, dass die Zusammensetzung des nicht OH-funktionalisierten Anteils in den A-Blöcken der Zusammensetzung der C-Blöcke entspricht.

4. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 2, dadurch gekennzeichnet, dass die Zusammensetzung des nicht OH-funktionalisierten Anteils in den A-Blöcken der Zusammensetzung der B-Blöcke entspricht.
5. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 2, dadurch gekennzeichnet, dass die Glasübergangstemperatur des B-Blockes größer 50 °C und die Glasübergangstemperatur der C-Blöcke kleiner 0 °C ist.
6. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 2, dadurch gekennzeichnet, dass die Glasübergangstemperatur der C-Blöcke größer 50 °C und die Glasübergangstemperatur der B-Blocks kleiner 0 °C ist.
7. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 2, dadurch gekennzeichnet, dass die einzelnen A-Blöcke der CABAC-Blockcopolymeren eine Zusammensetzung mit  $\leq 2$  OH-Gruppen aufweisen.
8. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 2, dadurch gekennzeichnet, dass die einzelnen A-Blöcke weniger als 20% des Gesamtgewichts des CABAC-Blockcopolymeren ausmachen.
9. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 8, dadurch gekennzeichnet, dass die einzelnen A-Blöcke weniger als 10% des Gesamtgewichts des CABAC-

Blockcopolymeren ausmachen.

10. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 1, dadurch gekennzeichnet, dass es sich bei dem Pentablockcopolymer um ein Blockcopolymer der Form ACBCA handelt, dass die Blöcke A aus hydroxyfunktionalisierten (Meth)acrylaten und Monomeren ausgewählt aus der Gruppe der nicht hydroxyfunktionalisierten (Meth)acrylate oder deren Mischungen zusammengesetzt sind, und dass die Blöcke B und C aus (Meth)acrylaten oder deren Mischungen, die keine Hydroxyfunktion enthalten, zusammengesetzt sind.
11. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 10, dadurch gekennzeichnet, dass die Zusammensetzung des nicht OH-funktionalisierten Anteils in den A-Blöcken der Zusammensetzung der C-Blöcke entspricht.
12. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 10, dadurch gekennzeichnet, dass die Zusammensetzung des nicht OH-funktionalisierten Anteils in den A-Blöcken der Zusammensetzung der B-Blöcke entspricht.
13. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 10, dadurch gekennzeichnet, dass die Glasübergangstemperatur des B-Blockes größer 50 °C und die Glasübergangstemperatur der C-Blöcke kleiner 0 °C ist.
14. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 10, dadurch gekennzeichnet, dass die

Glasübergangstemperatur der C-Blöcke größer 50 °C und die Glasübergangstemperatur der B-Blocks kleiner 0 °C ist.

15. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten

Pentablockcopolymere gemäß Anspruch 10, dadurch gekennzeichnet, dass die einzelnen A-Blöcke der ACBCA-Blockcopolymere eine Zusammensetzung mit  $\leq 2$  OH-Gruppen aufweisen.

16. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten

Pentablockcopolymere gemäß Anspruch 10, dadurch gekennzeichnet, dass die einzelnen A-Blöcke weniger als 20% des Gesamtgewichts des ACBCA-Blockcopolymers ausmachen.

17. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten

Pentablockcopolymere gemäß Anspruch 16, dadurch gekennzeichnet, dass die einzelnen A-Blöcke weniger als 10% des Gesamtgewichts des ACBCA-Blockcopolymers ausmachen.

18. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten

Pentablockcopolymere gemäß Anspruch 1, dadurch gekennzeichnet, dass die Blockcopolymere mittels ATRP polymerisierbare Monomere, die nicht zu der Gruppe der (Meth)acrylate gezählt werden, in den Blöcken A und/oder Block B und/oder den Blöcken C enthalten.

19. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten

Pentablockcopolymere gemäß Anspruch 18, dadurch gekennzeichnet, dass die Blockcopolymere mittels ATRP polymerisierbare Monomere, die nicht zu der Gruppe der (Meth)acrylate gezählt werden, in Mengen von 0-50 Gew.-% in den Blöcken A und/oder Block B und/oder den Blöcken C enthalten.

20. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten

Pentablockcopolymere gemäß Anspruch 1, dadurch gekennzeichnet, dass die hydroxyfunktionalisierten (Meth)acrylate bevorzugt ausgewählt sind aus der Gruppe Hydroxyalkyl(meth)acrylate von gradkettigen, verzweigten oder cycloaliphatischen Diolen mit 2-36 C-Atomen, wie beispielsweise 3-Hydroxypropyl(meth)acrylat, 3,4-Dihydroxybutylmono(meth)acrylat, 4-Hydroxybutyl(meth)acrylat, 2-Hydroxypropyl(meth)acrylat, 2,5-Dimethyl-1,6-hexandiolmono(meth)acrylat, Hydroxyethylacrylat und besonders bevorzugt 2-Hydroxyethylmethacrylat.

21. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten

Pentablockcopolymere gemäß Anspruch 1, dadurch gekennzeichnet, dass die (Meth)acrylate bevorzugt ausgewählt sind aus der Gruppe der Alkyl(meth)acrylate von gradkettigen, verzweigten oder cycloaliphatischen Alkoholen mit 1-40 C-Atomen, wie zum Beispiel Methyl(meth)acrylat, Ethyl(meth)acrylat, n-Butyl(meth)acrylat, i-Butyl(meth)acrylat, t-Butyl(meth)acrylat, 2-Ethylhexyl(meth)acrylat, Stearyl(meth)acrylat, Lauryl(meth)acrylat, Cyclohexyl(meth)acrylat, Isobornyl(meth)acrylat, Aryl(meth)acrylate wie zum Beispiel Benzyl(meth)acrylat oder Phenyl(meth)acrylat die jeweils unsubstituiert oder 1-4-fach substituierte Arylreste aufweisen können, Mono(meth)acrylate von Ethern, Polyethylenglycolen, Polypropylenglycolen oder deren Mischungen mit 5-80 C-Atomen, wie beispielsweise Tetrahydrofurfurylmethacrylat, Methoxy(m)ethoxyethylmethacrylat, 1-Butoxypropylmethacrylat, Cyclohexyloxymethylmethacrylat, Benzyloxymethylmethacrylat, Furfurylmethacrylat, 2-Butoxyethylmethacrylat, 2-Ethoxyethylmethacrylat, Allyloxymethylmethacrylat, 1-Ethoxybutylmethacrylat, 1-Ethoxyethylmethacrylat, Ethoxymethylmethacrylat, Poly(ethylenglycol)methylether(meth)acrylat oder Poly(propylenglycol)methylether(meth)acrylat.

22. Verfahren zur Herstellung von mit OH-Gruppen funktionalisierten Pentablockcopolymeren gemäß Anspruch 1, dadurch gekennzeichnet, dass die Pentablockcopolymeren mittels Atom Transfer Radical Polymerization (ATRP) in Anwesenheit eines Initiators und eines Katalysators in einem halogenfreien Lösungsmittel dargestellt werden.
23. Verfahren zur Herstellung von Pentablockcopolymeren gemäß Anspruch 22, dadurch gekennzeichnet, dass es sich bei dem Initiator um einen bifunktionellen Initiator handelt.
24. Verfahren zur Herstellung von Pentablockcopolymeren gemäß Anspruch 23, dadurch gekennzeichnet, dass als bifunktioneller Initiator bevorzugt 1,4-Butandiol-di-(2-bromo-2-methylpropionat), 1,2-Ethylenglycol-di-(2-bromo-2-methylpropionat), 2,5-Dibrom-adipinsäure-di-ethylester oder 2,3-Dibrom-maleinsäure-di-ethylester eingesetzt wird.
25. Verfahren zur Herstellung von Pentablockcopolymeren gemäß Anspruch 22, dadurch gekennzeichnet, dass das Pentablockcopolymer mittels sequentieller Polymerisation dargestellt wird.
26. Verfahren zur Herstellung von Pentablockcopolymeren gemäß Anspruch 22, dadurch gekennzeichnet, dass als Katalysator Übergangsmetallverbindungen verwendet werden.
27. Verfahren zur Herstellung von Pentablockcopolymeren gemäß Anspruch 26, dadurch gekennzeichnet, dass als Katalysator Kupferverbindungen verwendet werden.
28. Verfahren zur Herstellung von Pentablockcopolymeren gemäß Anspruch 22, dadurch gekennzeichnet, dass der Katalysator vor der Polymerisation mit einer

stickstoff-, sauerstoff-, schwefel- oder phosphorhaltigen Verbindung, die eine oder mehrere koordinative Bindungen mit dem Übergangsmetall zu einem Metall-Ligand-Komplex eingehen kann, zusammengebracht wird.

29. Verfahren zur Herstellung von Pentablockcopolymeren gemäß Anspruch 28, dadurch gekennzeichnet, dass als Ligand N-haltige Chelatliganden verwendet werden.
30. Verfahren zur Herstellung von Pentablockcopolymeren gemäß Anspruch 29, dadurch gekennzeichnet, dass als Ligand 2,2'-Bipyridin, N,N,N',N'',N'''-Pentamethyldiethylentriamin (PMDETA), Tris(2-aminoethyl)amin (TREN), N,N,N',N'-Tetramethylethylendiamin oder 1,1,4,7,10,10-Hexamethyltriethylentetramin verwendet wird.
31. Verfahren zur Herstellung von Pentablockcopolymeren gemäß Anspruch 22, dadurch gekennzeichnet, dass das Blockcopolymer ein zahlenmittleres Molekulargewicht zwischen 5000 g/mol und 100000 g/mol aufweist.
32. Verfahren zur Herstellung von Pentablockcopolymeren gemäß Anspruch 31, dadurch gekennzeichnet, dass das Blockcopolymer bevorzugt ein zahlenmittleres Molekulargewicht zwischen 7500 g/mol und 50000 g/mol aufweist.
33. Verfahren zur Herstellung von Pentablockcopolymeren gemäß Anspruch 22, dadurch gekennzeichnet, dass der Katalysator nach der Polymerisation mittels Zugabe einer Schwefelverbindung gefällt und mittels Filtration von der Polymerlösung abgetrennt wird.
34. Verfahren zur Herstellung von Pentablockcopolymeren gemäß Anspruch 33, dadurch gekennzeichnet, dass es sich bei der Schwefelverbindung um ein

Mercaptan oder eine eine Thiolgruppe aufweisende Verbindung handelt.

35. Verfahren nach Anspruch 1 bis 34 dadurch gekennzeichnet, dass die OH-Gruppen des Polymeren mit niedermolekularen Verbindungen umgesetzt werden, die zusätzlich zu einer mit OH-Gruppen reaktiven Gruppe eine Anhydrid-, Säure-, Isocyanat-, Epoxid- oder Silylgruppe aufweisen.
36. Mit OH-Gruppen funktionalisierte Pentablockcopolymere, die gemäß des in Anspruch 1 beschriebenen Verfahren erhältlich sind, dadurch gekennzeichnet, dass diese aus genau zwei Blöcken, enthaltend hydroxyfunktionalisierte (Meth)acrylate und Monomere ausgewählt aus der Gruppe der nicht hydroxyfunktionalisierten (Meth)acrylate oder deren Mischungen und genau drei Blöcken, enthaltend (Meth)acrylate oder deren Mischungen, die keine Hydroxyfunktion aufweisen und von denen sich zwei Blöcke wiederum in ihrer Zusammensetzung entsprechen und der dritte Block eine abweichende Zusammensetzung aufweist, zusammengesetzt sind.
37. Mit OH-Gruppen funktionalisierte Pentablockcopolymere, die gemäß des in Anspruch 2 beschriebenen Verfahren erhältlich sind, dadurch gekennzeichnet, dass es sich bei dem Pentablockcopolymer um ein Blockcopolymer der Form CABAC handelt, dass die Blöcke A aus hydroxyfunktionalisierten (Meth)acrylaten und Monomeren ausgewählt aus der Gruppe der nicht hydroxyfunktionalisierten (Meth)acrylate oder deren Mischungen zusammengesetzt sind, und dass die Blöcke B und C aus (Meth)acrylaten oder deren Mischungen, die keine Hydroxyfunktion enthalten, zusammengesetzt sind.

38. Mit OH-Gruppen funktionalisierte Pentablockcopolymere, die gemäß des in Anspruch 10 beschriebenen Verfahren erhältlich sind, dadurch gekennzeichnet, dass es sich bei dem Pentablockcopolymer um ein Blockcopolymer der Form ACBCA handelt,
- dass die Blöcke A aus hydroxyfunktionalisierten (Meth)acrylaten und Monomeren ausgewählt aus der Gruppe der nicht hydroxyfunktionalisierten (Meth)acrylate oder deren Mischungen zusammengesetzt sind, und
- dass die Blöcke B und C aus (Meth)acrylaten oder deren Mischungen, die keine Hydroxyfunktion enthalten, zusammengesetzt sind.
39. Verwendung von Blockcopolymeren der Zusammensetzung CABAC mit OH-Gruppen in den einzelnen A-Blöcken, dadurch gekennzeichnet,
- dass die Blöcke A ein Copolymer enthaltend hydroxyfunktionalisierte (Meth)acrylate und Monomere ausgewählt aus der Gruppe der nicht hydroxyfunktionalisierten (Meth)acrylate oder deren Mischungen darstellen, und
- dass die Blöcke B und C, enthaltend (Meth)acrylate oder deren Mischungen, die keine Hydroxyfunktion aufweisen,
- in Reaktivschmelzklebstoffen, Schmelzklebstoffen, Beschichtungsmassen, Grundierungslacken, Haftklebstoffe, Reaktivklebstoffe, Klebmassen, Dichtmassen oder als Schlagzähmodifizier in Kleb- oder Dichtmassen.
40. Verwendung von Blockcopolymeren der Zusammensetzung ACBCA mit OH-Gruppen in den einzelnen A-Blöcken, dadurch gekennzeichnet,
- dass die Blöcke A ein Copolymer enthaltend hydroxyfunktionalisierte (Meth)acrylate und Monomere ausgewählt aus der Gruppe der nicht hydroxyfunktionalisierten (Meth)acrylate oder deren Mischungen darstellen, und
- dass die Blöcke B und C, enthaltend (Meth)acrylate oder deren Mischungen, die keine Hydroxyfunktion aufweisen,

in Reaktivschmelzklebstoffen, Schmelzklebstoffen, Beschichtungsmassen, Grundierungslacken, Haftklebstoffe, Reaktivstoffe, Klebmassen, Dichtmassen oder als Schlagzähmodifizier in Kleb- oder Dichtmassen.

## INTERNATIONAL SEARCH REPORT

International application No

PCT/EP2008/060520

## A. CLASSIFICATION OF SUBJECT MATTER

INV. C08F293/00 C08F297/02 C09D153/00 C09J153/00

According to International Patent Classification (IPC) or to both national classification and IPC

## B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

C08F C09D C09J

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

EPO-Internal, WPI Data

## C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	EP 1 475 397 A (KANEKAFUCHI CHEMICAL IND [JP]) 10 November 2004 (2004-11-10) paragraphs [0044], [0052], [0092], [0179] - [0181], [0221]; claim 1	1-40
A	WO 2006/106214 A (ARKEMA FRANCE [FR]; CENTRE NAT RECH SCIENT [FR]; EL BOUNIA NOUR-EDDINE) 12 October 2006 (2006-10-12) claims 1-3,7,9,16 ----- -/--	1-40

☒ Further documents are listed in the continuation of Box C.☒ See patent family annex.

## \* Special categories of cited documents:

- \*A\* document defining the general state of the art which is not considered to be of particular relevance
- \*E\* earlier document but published on or after the international filing date
- \*L\* document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- \*O\* document referring to an oral disclosure, use, exhibition or other means
- \*P\* document published prior to the international filing date but later than the priority date claimed

- \*T\* later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
- \*X\* document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
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- \*Z\* document member of the same patent family

Date of the actual completion of the international search

10 November 2008

Date of mailing of the international search report

14/11/2008

Name and mailing address of the ISA/

European Patent Office, P.B. 5818 Patentlaan 2  
NL - 2280 HV Rijswijk  
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Fax: (+31-70) 340-3016

Authorized officer

Clement, Silvia

# INTERNATIONAL SEARCH REPORT

International application No  
PCT/EP2008/060520

C(Continuation). DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
P,A	<p>XU F J ET AL: "Pentablock copolymers of poly(ethylene glycol), poly((2-dimethyl amino)ethyl methacrylate) and poly(2-hydroxyethyl methacrylate) from consecutive atom transfer radical polymerizations for non-viral gene delivery"</p> <p>1 July 2008 (2008-07-01), BIOMATERIALS, ELSEVIER SCIENCE PUBLISHERS BV., BARKING, GB, PAGE(S) 3023 - 3033 , XP022647944 ISSN: 0142-9612 [retrieved on 2008-04-18] the whole document</p>	1-40

# INTERNATIONAL SEARCH REPORT

Information on patent family members

International application No

PCT/EP2008/060520

Patent document cited in search report		Publication date	Patent family member(s)	Publication date
EP 1475397	A	10-11-2004	AU 2003211925 A1	04-09-2003
			WO 03068836 A1	21-08-2003
			TW 254718 B	11-05-2006
			US 2005272865 A1	08-12-2005
			US 2005085592 A1	21-04-2005
WO 2006106214	A	12-10-2006	CN 101193973 A	04-06-2008
			EP 1866370 A1	19-12-2007
			FR 2883879 A1	06-10-2006
			JP 2008534764 T	28-08-2008
			KR 20070116856 A	11-12-2007
			US 2008207817 A1	28-08-2008

# INTERNATIONALER RECHERCHENBERICHT

Internationales Aktenzeichen

PCT/EP2008/060520

## A. KLASSIFIZIERUNG DES ANMELDUNGSGEGENSTANDES

INV. C08F293/00 C08F297/02 C09D153/00 C09J153/00

Nach der Internationalen Patentklassifikation (IPC) oder nach der nationalen Klassifikation und der IPC

## B. RECHERCHIERTE GEBIETE

Recherchierter Mindestprüfstoff (Klassifikationssystem und Klassifikationssymbole)

C08F C09D C09J

Recherchierte, aber nicht zum Mindestprüfstoff gehörende Veröffentlichungen, soweit diese unter die recherchierten Gebiete fallen

Während der internationalen Recherche konsultierte elektronische Datenbank (Name der Datenbank und evtl. verwendete Suchbegriffe)

EPO-Internal, WPI Data

## C. ALS WESENTLICH ANGESEHENE UNTERLAGEN

Kategorie*	Bezeichnung der Veröffentlichung, soweit erforderlich unter Angabe der in Betracht kommenden Teile	Betr. Anspruch Nr.
A	EP 1 475 397 A (KANEKAFUCHI CHEMICAL IND [JP]) 10. November 2004 (2004-11-10) Absätze [0044], [0052], [0092], [0179] - [0181], [0221]; Anspruch 1	1-40
A	WO 2006/106214 A (ARKEMA FRANCE [FR]; CENTRE NAT RECH SCIENT [FR]; EL BOUNIA NOUR-EDDINE) 12. Oktober 2006 (2006-10-12) Ansprüche 1-3, 7, 9, 16 ----- -/-	1-40



Weitere Veröffentlichungen sind der Fortsetzung von Feld C zu entnehmen



Siehe Anhang Patentfamilie

\* Besondere Kategorien von angegebenen Veröffentlichungen :

\*A\* Veröffentlichung, die den allgemeinen Stand der Technik definiert, aber nicht als besonders bedeutsam anzusehen ist

\*E\* älteres Dokument, das jedoch erst am oder nach dem internationalen Anmeldedatum veröffentlicht worden ist

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\*Z\* Veröffentlichung, die Mitglied derselben Patentfamilie ist

Datum des Abschlusses der internationalen Recherche

10. November 2008

Absendedatum des internationalen Recherchenberichts

14/11/2008

Name und Postanschrift der internationalen Recherchenbehörde

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Bevollmächtigter Bediensteter

Clement, Silvia

# INTERNATIONALER RECHERCHENBERICHT

Internationales Aktenzeichen  
PCT/EP2008/060520

## C. (Fortsetzung) ALS WESENTLICH ANGESEHENE UNTERLAGEN

Kategorie*	Bezeichnung der Veröffentlichung, soweit erforderlich unter Angabe der in Betracht kommenden Teile	Betr. Anspruch Nr.
P,A	<p>XU F J ET AL: "Pentablock copolymers of poly(ethylene glycol), poly((2-dimethyl amino)ethyl methacrylate) and poly(2-hydroxyethyl methacrylate) from consecutive atom transfer radical polymerizations for non-viral gene delivery"</p> <p>1. Juli 2008 (2008-07-01), BIOMATERIALS, ELSEVIER SCIENCE PUBLISHERS BV., BARKING, GB, PAGE(S) 3023 - 3033 , XP022647944 ISSN: 0142-9612 [gefunden am 2008-04-18] das ganze Dokument</p> <p>-----</p>	1-40

# INTERNATIONALER RECHERCHENBERICHT

Angaben zu Veröffentlichungen, die zur selben Patentfamilie gehören

Internationales Aktenzeichen

PCT/EP2008/060520


Im Recherchenbericht angeführtes Patentdokument		Datum der Veröffentlichung	Mitglied(er) der Patentfamilie *		Datum der Veröffentlichung
EP 1475397	A	10-11-2004	AU	2003211925 A1	04-09-2003
			WO	03068836 A1	21-08-2003
			TW	254718 B	11-05-2006
			US	2005272865 A1	08-12-2005
			US	2005085592 A1	21-04-2005
WO 2006106214	A	12-10-2006	CN	101193973 A	04-06-2008
			EP	1866370 A1	19-12-2007
			FR	2883879 A1	06-10-2006
			JP	2008534764 T	28-08-2008
			KR	20070116856 A	11-12-2007
			US	2008207817 A1	28-08-2008

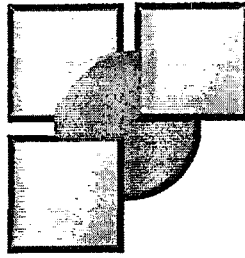
Request for Participation in the  
Patent Prosecution Highway Program  
U.S. Patent Application No. 12/674,552  
Attorney Docket No. 354652US0PCT

## APPENDIX C

English Translation of PCT/EP2008/060520 Including a Copy  
of Claims Receiving Favorable Treatment in the IPRP and  
Statement that Translation is Accurate

# RWS GROUP

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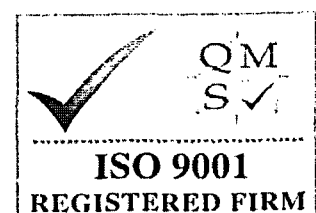
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*With Compliments*

Friday, 18 December 2009

FAO: Sabrina Werner  
Zu Händen von:  
A l'attention de:  
  
Your reference: 2007P00595WO  
Ihr Zeichen:  
Votre reference:

Dept:  
Abteilung:  
Dépt:



# Anmerkungen des Übersetzers

Ihr Zeichen: 2007P00595WO

Ihr Auftrag vom: 10/12/2009

Bei der Übersetzung des o.a. Textes schien uns folgendes unklar bzw. unrichtig zu sein. Wir haben uns deshalb erlaubt, Klarstellungen bzw. Berichtigungen vorzunehmen:

Seite/Abs./Zeile*	Anmerkung
3/-2/-4	<del>durch den</del>
5/1/1, 8/-3/3, 10/-3/1, 11/-1/1	<u>ATRP</u>
6/-2/1-2	reaktive Hydroxygruppen enthaltende Polymere
7/2/-3	ein
11/3/1-19	Als bifunktionelle Initiatoren können ... <u>eingesetzt</u> werden.
28/1/2	Reaktiv <u>kleb</u> stoffe

\* Jeweils auf den Ausgangstext bezogen. Als Absatz 1 wird auch der Rest eines auf der vorhergehenden Seite angefangenen Absatzes gewertet. Bei der Angabe eines Absatzes bezieht sich die Zeilennummer auf diesen Absatz, ansonsten auf die am Rand angegebene Zeilennummer.

IN THE MATTER OF an Indian  
Application corresponding to  
PCT Application PCT/EP2008/060520

RWS Group Ltd, of Europa House, Marsham Way, Gerrards Cross, Buckinghamshire, England, hereby solemnly and sincerely declares that, to the best of its knowledge and belief, the following document, prepared by one of its translators competent in the art and conversant with the English and German languages, is a true and correct translation of the PCT Application filed under No. PCT/EP2008/060520.

Date: 18 December 2009



N. T. SIMPKIN  
Deputy Managing Director - UK Translation Division  
For and on behalf of RWS Group Ltd

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property  
Organization  
International Bureau



(43) International Publication Date  
26 February 2009 (26.02.2009)

PCT

(10) International Publication Number  
WO 2009/024495 A1

(51) International Patent Classification:

C08F 293/00 (2006.01) C09D 153/00 (2006.01)  
C08F 297/02 (2006.01) C09J 153/00 (2006.01)

Strasse 4, 40593 Düsseldorf (DE).

(21) International Application Number: PCT/EP2008/060520

(22) International Filing Date: 11 August 2008 (11.08.2008)

(25) Filing Language: German

(26) Publication Language: German

(30) Priority Data:  
102007039535.5 21 August 2007 (21.08.2007) DE

(71) Applicant (for all designated States except US): EVONIK  
RÖHM GMBH [DE/DE]; Kirschenallee, 64293 Darmstadt  
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(72) Inventors; and

(75) Inventors/Applicants (for US only): BALK, Sven  
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Essen (DE). KAUTZ, Holger [DE/DE]; Friedrichstrasse 2  
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Borchert-Strasse 5, 40505 Düsseldorf (DE). FRANKEN,  
Uwe [DE/DE]; Haselnussweg 4, 41542 Dormagen (DE).  
KINZELMANN, Georg [DE/DE]; Dhünnstrasse 10, 50259  
Pulheim (DE). MÖLLER, Thomas [DE/DE]; Göppinger

(74) Common representative: EVONIK RÖHM GMBH;  
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4, 63457 Hanau (DE).

(81) Designated states (unless otherwise indicated, for every  
kind of national protection available): AE, AG, AL, AM,  
AO, AT, AU, AZ, BA, BB, BG, BH, BR, BW, BY, BZ,  
CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DO, DZ,  
EC, EE, EG, ES, FI, GB, GD, GE, GH, GM, GT, HN,  
HR, HU, ID, IL, IN, IS, JP, KE, KG, KM, KN, KP, KR,  
KZ, LA, LC, LK, LR, LS, LT, LU, LY, MA, MD, ME,  
MG, MK, MN, MW, MX, MY, MZ, NA, NG, NI, NO,  
NZ, OM, PG, PH, PL, PT, RO, RS, RU, SC, SD, SE, SG,  
SK, SL, SM, ST, SV, SY, TJ, TM, TN, TR, TT, TZ, UA,  
UG, US, UZ, VC, VN, ZA, ZM, ZW.

(84) Designated states (unless otherwise indicated, for every  
kind of regional protection available): ARIPO (BW, GH,  
GM, KE, LS, MW, MZ, NA, SD, SL, SZ, TZ, UG, ZM,  
ZW), Eurasian (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM),  
European (AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES,  
FI, FR, GB, GR, HR, HU, IE, IS, IT, LT, LU, LV, MC,  
MT, NL, NO, PL, PT, RO, SE, SI, SK, TR), OAPI (BF,  
BJ, CF, CG, CI, CM, GA, GN, GQ, GW, ML, MR, NE,  
SN, TD, TG).

Published:

- with international search report

As printed

(54) Title: METHOD FOR PREPARATION OF PENTA-BLOCK COPOLYMERS WITH OH-FUNCTIONALIZED BLOCKS  
BASED ON (METH)ACRYLATE

(54) Bezeichnung: VERFAHREN ZUR HERSTELLUNG VON PENTABLOCKCOPOLYMEREN MIT OH-FUNKTIONALI-  
SIERTEN BLÖCKEN AUF (METH)ACRYLATBASIS

(57) Abstract: The invention relates to a method for preparation of CABAC- and/or ACBCA-penta-block copolymers based on  
(meth)acrylate, with an OH-functionalizing of the A-blocks.

(57) Zusammenfassung: Die Erfindung betrifft ein Verfahren zur Herstellung von CABAC- bzw. ACBCA-Pentablockcopoly-  
meren auf (Meth)acrylatbasis mit einer OH-Funktionalisierung der A-Blöcke.

WO 2009/024495 A1

IN THE MATTER OF a Singapore  
Application corresponding to  
PCT Application PCT/EP2008/060520

RWS Group Ltd, of Europa House, Marsham Way, Gerrards Cross, Buckinghamshire, England, hereby solemnly and sincerely declares that, to the best of its knowledge and belief, the following document, prepared by one of its translators competent in the art and conversant with the English and German languages, is a true and correct translation of the PCT Application filed under No. PCT/EP2008/060520.

Date: 18 December 2009



N. T. SIMPKIN

Deputy Managing Director - UK Translation Division

For and on behalf of RWS Group Ltd

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property  
Organization  
International Bureau



(43) International Publication Date  
26 February 2009 (26.02.2009)

PCT

(10) International Publication Number  
WO 2009/024495 A1

- (51) International Patent Classification:  
C08F 293/00 (2006.01) C09D 153/00 (2006.01)  
C08F 297/02 (2006.01) C09J 153/00 (2006.01)
- (21) International Application Number: PCT/EP2008/060520
- (22) International Filing Date: 11 August 2008 (11.08.2008)
- (25) Filing Language: German
- (26) Publication Language: German
- (30) Priority Data:  
102007039535.5 21 August 2007 (21.08.2007) DE
- (71) Applicant (for all designated States except US): EVONIK RÖHM GMBH [DE/DE]; Kirschenallee, 64293 Darmstadt (DE). HENKEL AG & CO. KGAA [DE/DE]; Henkelstrasse 67, 40191 Düsseldorf (DE).
- (72) Inventors; and
- (75) Inventors/Applicants (for US only): BALK, Sven [NL/DE]; Martin-May-Str. 5, 60594 Frankfurt (DE). LÖHDEN, Gerd [DE/DE]; Kunstwerkerstrasse 185, 45136 Essen (DE). KAUTZ, Holger [DE/DE]; Friedrichstrasse 2 e, 63450 Hanau (DE). ERB, Volker [DE/DE]; Wolfgang-Borchert-Strasse 5, 40505 Düsseldorf (DE). FRANKEN, Uwe [DE/DE]; Haselnussweg 4, 41542 Dormagen (DE). KINZELMANN, Georg [DE/DE]; Dhünnstrasse 10, 50259 Pulheim (DE). MÖLLER, Thomas [DE/DE]; Göppinger

Strasse 4, 40593 Düsseldorf (DE).

- (74) Common representative: EVONIK RÖHM GMBH; DG-IPM-PAT, Postcode 84/339, Rodenbacher Chaussee 4, 63457 Hanau (DE).

- (81) Designated states (unless otherwise indicated, for every kind of national protection available): AE, AG, AL, AM, AO, AT, AU, AZ, BA, BB, BG, BH, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DO, DZ, EC, EE, EG, ES, FI, GB, GD, GE, GH, GM, GT, HN, HR, HU, ID, IL, IN, IS, JP, KE, KG, KM, KN, KP, KR, KZ, LA, LC, LK, LR, LS, LT, LU, LY, MA, MD, ME, MG, MK, MN, MW, MX, MY, MZ, NA, NG, NI, NO, NZ, OM, PG, PH, PL, PT, RO, RS, RU, SC, SD, SE, SG, SK, SL, SM, ST, SV, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, ZA, ZM, ZW.

- (84) Designated states (unless otherwise indicated, for every kind of regional protection available): ARIPO (BW, GH, GM, KE, LS, MW, MZ, NA, SD, SL, SZ, TZ, UG, ZM, ZW), Eurasian (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European (AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HR, HU, IE, IS, IT, LT, LU, LV, MC, MT, NL, NO, PL, PT, RO, SE, SI, SK, TR), OAPI (BF, BJ, CF, CG, CI, CM, GA, GN, GQ, GW, ML, MR, NE, SN, TD, TG).

Published:

- with international search report

As printed

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(54) Bezeichnung: VERFAHREN ZUR HERSTELLUNG VON PENTABLOCKCOPOLYMEREN MIT OH-FUNKTIONALISIERTEN BLÖCKEN AUF (METH)ACRYLATBASIS

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WO 2009/024495 A1

IN THE MATTER OF an Australian  
Application corresponding to  
PCT Application PCT/EP2008/060520

RWS Group Ltd, of Europa House, Marsham Way, Gerrards Cross, Buckinghamshire, England, hereby solemnly and sincerely declares that, to the best of its knowledge and belief, the following document, prepared by one of its translators competent in the art and conversant with the English and German languages, is a true and correct translation of the PCT Application filed under No. PCT/EP2008/060520.

Date: 18 December 2009

A handwritten signature in black ink, appearing to read 'N. T. Simpkin', with a long horizontal flourish extending to the right.

N. T. SIMPKIN  
Deputy Managing Director - UK Translation Division  
For and on behalf of RWS Group Ltd

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property  
Organization  
International Bureau



(43) International Publication Date  
26 February 2009 (26.02.2009)

PCT

(10) International Publication Number  
WO 2009/024495 A1

(51) International Patent Classification:

C08F 293/00 (2006.01) C09D 153/00 (2006.01)  
C08F 297/02 (2006.01) C09J 153/00 (2006.01)

Strasse 4, 40593 Düsseldorf (DE).

(21) International Application Number: PCT/EP2008/060520

(22) International Filing Date: 11 August 2008 (11.08.2008)

(25) Filing Language: German

(26) Publication Language: German

(30) Priority Data:  
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(71) Applicant (for all designated States except US): EVONIK  
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(72) Inventors; and

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LÖHDEN, Gerd [DE/DE]; Kunstwerkerstrasse 185, 45136  
Essen (DE). KAUTZ, Holger [DE/DE]; Friedrichstrasse 2  
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KINZELMANN, Georg [DE/DE]; Dhünnstrasse 10, 50259  
Pulheim (DE). MÖLLER, Thomas [DE/DE]; Göppinger

(74) Common representative: EVONIK RÖHM GMBH;  
DG-IPM-PAT, Postcode 84/339, Rodenbacher Chaussee  
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(81) Designated states (unless otherwise indicated, for every  
kind of national protection available): AE, AG, AL, AM,  
AO, AT, AU, AZ, BA, BB, BG, BH, BR, BW, BY, BZ,  
CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DO, DZ,  
EC, EE, EG, ES, FI, GB, GD, GE, GH, GM, GT, HN,  
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(84) Designated states (unless otherwise indicated, for every  
kind of regional protection available): ARIPO (BW, GH,  
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BJ, CF, CG, CI, CM, GA, GN, GQ, GW, ML, MR, NE,  
SN, TD, TG).

Published:

- with international search report

As printed

(54) Title: METHOD FOR PREPARATION OF PENTA-BLOCK COPOLYMERS WITH OH-FUNCTIONALIZED BLOCKS  
BASED ON (METH)ACRYLATE

(54) Bezeichnung: VERFAHREN ZUR HERSTELLUNG VON PENTABLOCKCOPOLYMEREN MIT OH-FUNKTIONALI-  
SIERTEN BLÖCKEN AUF (METH)ACRYLATBASIS

(57) Abstract: The invention relates to a method for preparation of CABAC- and/or ACBCA-penta-block copolymers based on  
(meth)acrylate, with an OH-functionalizing of the A-blocks.

(57) Zusammenfassung: Die Erfindung betrifft ein Verfahren zur Herstellung von CABAC- bzw. ACBCA-Pentablockcopoly-  
meren auf (Meth)acrylatbasis mit einer OH-Funktionalisierung der A-Blöcke.

WO 2009/024495 A1

**Method for preparation of penta-block copolymers with OH-functionalized blocks  
based on (meth)acrylate**

**Field of the invention**

The invention relates to a further process for preparing CABAC or ACBCA pentablock copolymers based on (meth)acrylate with an OH functionalization of the A blocks and to the use thereof, for example as a formulation constituent of reactive hotmelt adhesives.

Tailored copolymers with defined composition, chain length, molar mass distribution, etc. are a wide field of research. One distinction which is drawn is that between gradient and block polymers. For such materials, various applications are conceivable. Some will be presented briefly hereinafter. For this purpose, some of the fields of use which have been selected are those in which polymers are used, from which the present invention is to be delimited.

Reactive adhesives are substances which are solid at room temperature. They are melted by heating and applied to a substrate. In the course of cooling, the adhesive composition solidifies again and hence binds the substrate. In addition, the polymers present in the adhesive composition crosslink as a result of reaction with moisture. This operation results in ultimate, irreversible hardening.

#### Prior art

Such adhesives are described, for example, in US 5,021,507. The main constituent of these adhesives is compounds with free isocyanate groups, which are usually obtained by condensation reaction of an excess of polyisocyanate groups with polyols. To improve the adhesion properties to particular substrates, binders consisting of polymers composed of ethylenically unsaturated monomers have been added to these compounds with free isocyanate groups. The binders used are typically polyalkyl (meth)acrylates with C<sub>1</sub>- to C<sub>20</sub>-alkyl groups. They are polymerized from the corresponding monomers by free radical polymerization either before the addition to the urethanes or in the presence thereof.

US 5,866,656 and EP 1 036 103 describe reactive hotmelt adhesives in which the binders composed of poly(meth)acrylate are bonded covalently to the compounds with free isocyanate groups in the adhesive composition. Since this bonding is usually effected by a condensation reaction, such adhesives in which this bond has formed are referred to as adhesives at the condensation stage. The adhesives thus obtained, compared to those described in US 5,021,507, are notable for an increased elasticity and an improved adhesion to particular metal substrates, and for a longer open time - the time available for processing.

However, these reactive hotmelt adhesives have considerable disadvantages. For example, they exhibit only a low initial strength. This results in a particularly long, disadvantageous fixing time after the application of the adhesive composition.

A further disadvantage of the prior art reactive adhesives is the high viscosity, which is relevant in the course of processing. As a result, processing of the molten reactive hotmelt adhesive, in particular the application to porous substrates, is complicated significantly. In some cases, gelation also occurs at the condensation stage.

A further disadvantage is that the extractable fraction in the hardened adhesive is quite high. Among other consequences, this reduces the resistance of the adhesive composition to solvents.

Another disadvantage is that the free-radically polymerized materials also comprise a

relatively high proportion of low molecular weight constituents which do not take part in the crosslinking reactions and constitute the extractable fraction of corresponding reactive hotmelt adhesives.

Another kind of polymerization has brought the goal of tailored polymers a good deal closer. The ATRP (atom transfer radical polymerization) method was developed in the 1990s principally by Prof. Matyjaszewski (Matyjaszewski et al., J.Am.Chem.Soc., 1995, 117, p. 5614; WO 97/18247; Science, 1996, 272, p. 866) and especially with 2-hydroxyethyl (meth)acrylate (HEMA) (Beers et al., Macromolecules; 1999, 32, p. 5772-5776). The ATRP affords narrow-distribution (homo)polymers in the molar mass range of  $M_n = 10\,000\text{--}120\,000\text{ g/mol}$ . A particular advantage is that both the molecular weight and the molecular weight distribution can be regulated. As a living polymerization, it also permits the controlled formation of polymer architectures, for example random copolymers or else block copolymer structures. By virtue of appropriate initiators, for example, unusual block copolymers and star polymers are additionally obtainable. Theoretical fundamentals of the polymerization mechanism are detailed, inter alia, in Hans Georg Elias, *Makromoleküle [Macromolecules]*, volume 1, 6th edition, Weinheim 1999, p. 344.

The above-described problems have been solved in WO 05/047359 to the extent that use of a controlled polymerization method in the form of atom transfer radical polymerization (ATRP) allows binders with very narrow molecular weight distributions to be provided, which have only a low proportion of high molecular weight constituents by the compared to free-radically polymerized (meth)acrylates. In polymer mixtures, these constituents bring about especially an increase in the viscosity.

A disadvantage of the reactive adhesives detailed in WO 05/047359 is, however, a random distribution of the hydroxyl, mercapto and/or amine groups in the polymer chain of the binder. This leads to close-mesh crosslinking and hence to a reduced elasticity of the adhesive composition. This can also result in a deterioration of the substrate binding. This disadvantage comes to bear especially when polyisocyanates having more than two free isocyanate groups are used as a formulation constituent of the reactive hotmelt adhesive. For a list and description of the compounds which bear free

isocyanate groups, reference is made to the relevant description in WO 05/047359.

For dispersions with low foam formation, gradient copolymers are prepared by living and controlled polymerization, for example, in DE 102 36 133 and DE 141 60 19.

Gradient copolymers are copolymers which consist, for example, of monomers A and B, and in whose individual chains a gradient of the distribution of the monomer units along the chains exists. One chain end is high in monomer A and low in monomer B, the other end high in monomer B and low in monomer A. Gradient copolymers are delimited from block copolymers by the fluid transition between the monomers A and B.

Block polymers have an abrupt transition between the monomers in the polymer chain, which is defined as the boundary between the individual blocks. A customary synthesis method for AB block polymers is the controlled polymerization of monomer A and, at a later time, the addition of monomer B. In addition to sequential polymerization by batchwise addition to the reaction vessel, a similar result can also be achieved by, in the case of continuous addition of the two monomers, abruptly changing their compositions at different times. An abrupt change may also mean brief transition regions within which the two repeat units may be present in mixed form.

Suitable living and controlled polymerization methods are, as well as anionic or group transfer polymerization, also modern methods of controlled radical polymerization, for example RAFT polymerization. The mechanism of the RAFT polymerization is described in detail in WO 98/01478 or EP 0 910 587. Use examples are found in EP1 205 492.

In EP 1 375 605, AB block copolymers are prepared via the ATRP method. The polar component used is HEMA. This is intended to enable good compatibility with other substances.

WO 00/75791 prepares AB diblock copolymers from MMA and a mixture of n-BA and HEMA with monofunctionalized catalysts. The blocks are amine-functionalized. This results in discoloration and impairment of the odour. In addition, polymers with an AB diblock structure of this kind have a polarity difference between the chain ends which is undesired for the inventive applications.

EP 1475397 describes diblock and triblock copolymers of the AB and ABA form respectively, with at least one OH-functionalized block. US 2004 0147674 claims corresponding polymers and the formulation thereof with crystalline resins. Both documents concern copolymers with an acrylate and a harder (meth)acrylate composition. The polymers are likewise prepared via the ATRP process and find use in adhesive and/or sealant formulations. The triblock copolymers described here, compared to the inventive pentablock copolymers of the CABAC or ACBCA form, however, have the disadvantage that either the entire hard or soft segment is functionalized. In the inventive polymers, in contrast, only a short segment of the chain is OH-functionalized, such that the unfunctionalized hard block can contribute to sufficient cohesion and the unfunctionalized soft block to good adhesion. In the case of the ABA triblock copolymers, owing to the functionalization of at least one of the two segments A or B, property losses for one of the two parameters important for adhesives and sealants have to be taken into account. Moreover, through selection of suitable segment lengths, the crosslinking density can be adjusted readily. A further advantage of the inventive pentablock copolymers, especially of the CABAC form, is that, as a result of the functionalization of the intermediate A blocks, the hard blocks (A or B) and soft blocks (correspondingly B or A) are separated from one another in the network, and can thus each contribute to an improvement in the adhesion and cohesion respectively.

#### Problem

A new stage in the development is that of the pentablock copolymers described below.

It was an object of the invention to prepare pentablock copolymers of the CABAC or ACBCA structure. In particular, there is a need for OH-terminated (meth)acrylates or (meth)acrylates whose properties correspond or approximate very closely to those of OH-terminated materials. This can be achieved, for example, through the incorporation of one to a few OH groups at the chain end. Chain ends refer to the end segment of a polymer, which makes up max. 1% by weight - 20% by weight of the total weight of the polymer.

Irrespective of this, there is a need for polymeric block structures which possess unfunctionalized soft segments with high adhesive action, unfunctionalized hard

segments with good cohesive action and OH-functionalized segments for subsequent reactions, for example a crosslinking reaction. Such polymers can, in accordance with the invention, be formed by a sequential polymerization to form pentablock structures of the ACBCA or CABAC type.

It is a further object of the invention to provide reactive hydroxyl groups present polymers as binders such that the number of such groups in the polymer, with good availability for the hardening reaction, is kept as low as possible. A relatively high proportion of polar groups in the binder leads to possible gelation or at least to an additional increase in the melt viscosity of the reactive hotmelt adhesive.

It is a further object of the invention to provide such a material with a very narrow molecular weight distribution below 1.8, preferably below 1.6. In this way, both the proportions of relatively high molecular weight constituents which contribute, inter alia, to an undesired increase in the melt viscosity, and the proportions of particularly low molecular weight constituents, which can cause a deterioration in the solvent resistance of the adhesive composition, are minimized.

It is therefore an object of the present invention to provide, inter alia, a binder which possesses a low number of free hydroxyl groups in two chain segments A. In one embodiment, a pentablock copolymer of the ABCBA form is present, which has the OH groups close to the chain ends. In a second embodiment, the pentablock copolymer is of the CABAC form which contains two OH-functionalized intermediate segments A.

#### Solution

The object is achieved by providing block copolymers of the CABAC or ACBCA composition with  $\leq 8$  OH groups, preferably  $\leq 4$  OH groups, in the individual A blocks, characterized in that block A, a copolymer containing hydroxy-functionalized (meth)acrylates and monomers selected from the group of the (meth)acrylates or mixtures thereof, and blocks B and C containing (meth)acrylates or mixtures thereof which have no hydroxyl function, are polymerized as pentablock copolymers.

B describes either a hard (meth)acrylate block, preferably methacrylate block, or a soft (meth)acrylate block, preferably acrylate block. C describes in each case, differently

from B, a hard (meth)acrylate block, preferably methacrylate block, or a soft (meth)acrylate block, preferably acrylate block, in which case C is a hard block when B is a soft block or vice versa. A is an OH-functionalized block, in which case the hydroxyl groups are incorporated into the polymer segment by copolymerization of OH-functionalized with non-OH-functionalized monomers. The composition of the non-OH-functionalized monomers may preferably correspond either to the composition of the monomer mixture which is used to form the B block, or to the composition of the monomer mixture which is used to form the C block.

The formulation "soft block" describes polymer segments with a glass transition temperature  $T_g$  which is less than 0°C. The formulation "hard block" describes polymer segments with a glass transition temperature  $T_g$  greater than 50°C. The glass transition temperature  $T_g$  is determined by means of Differential Scanning Calorimetry (DSC).

It has been found that ACBCA and CABAC block copolymers with  $\leq 2$  OH groups in the individual A blocks can also be prepared.

The block copolymers of the CABAC or ACBCA composition consist of A blocks to an extent of less than 20% of the total weight, preferably less than 10%.

It is possible to add both to the copolymers of block A and to the copolymers of blocks B and C 0% by weight - 50% by weight of monomers which are polymerizable by means of ATRP and which do not form part of the group of the (meth)acrylates.

The notation (meth)acrylate represents the esters of (meth)acrylic acid and here means both methacrylate, for example methyl methacrylate, ethyl methacrylate, etc., and acrylate, for example methyl acrylate, ethyl acrylate, etc., and mixtures of the two.

In addition, a process has been developed for preparing block copolymers of the CABAC composition. With a specific form of living polymerization, atom transfer radical polymerization (ATPR), it is possible to incorporate efficiently controlled compositions, architectures and defined functionalities into a polymer.

It has been found that the use of a bifunctional initiator allows a CABAC structure to be formed in a controlled manner.

Hydroxy-functionalized (meth)acrylates which are polymerized into block A are

preferably hydroxyalkyl (meth)acrylates of straight-chain, branched or cycloaliphatic diols having 2-36 carbon atoms, for example 3-hydroxypropyl (meth)acrylate, 3,4-dihydroxybutyl mono(meth)acrylate, 2-hydroxyethyl (meth)acrylate, 4-hydroxybutyl (meth)acrylate, 2-hydroxypropyl (meth)acrylate, 2,5-dimethyl-1,6-hexanediol mono(meth)acrylate and more preferably 2-hydroxyethyl methacrylate.

Monomers which are polymerized either into block A or into block B or C are selected from the group of the (meth)acrylates, for example alkyl (meth)acrylates of straight-chain, branched or cycloaliphatic alcohols having 1-40 carbon atoms, for example methyl (meth)acrylate, ethyl (meth)acrylate, n-butyl (meth)acrylate, i-butyl (meth)acrylate, t-butyl (meth)acrylate, pentyl (meth)acrylate, 2-ethylhexyl (meth)acrylate, stearyl (meth)acrylate, lauryl (meth)acrylate, cyclohexyl (meth)acrylate, isobornyl (meth)acrylate, aryl (meth)acrylates, for example benzyl (meth)acrylate or phenyl (meth)acrylate, each of which may be unsubstituted or have mono- to tetrasubstituted aryl radicals, other aromatically substituted (meth)acrylates, for example naphthyl (meth)acrylate, mono(meth)acrylates of ethers, polyethylene glycols, polypropylene glycols or mixtures thereof having 5-80 carbon atoms, for example tetrahydrofurfuryl methacrylate, methoxy(m)ethoxyethyl methacrylate, 1-butoxypropyl methacrylate, cyclohexyloxymethyl methacrylate, benzyloxymethyl methacrylate, furfuryl methacrylate, 2-butoxyethyl methacrylate, 2-ethoxyethyl methacrylate, allyloxymethyl methacrylate, 1-ethoxybutyl methacrylate, 1-ethoxyethyl methacrylate, ethoxymethyl methacrylate, poly(ethylene glycol) methyl ether (meth)acrylate or poly(propylene glycol) methyl ether (meth)acrylate.

In addition to the (meth)acrylates detailed above, the compositions to be polymerized may also have further unsaturated monomers which are copolymerizable with the aforementioned (meth)acrylates and by means of ATRP. These include 1-alkenes, such as 1-hexene, 1-heptene, branched alkenes, for example vinylcyclohexane, 3,3-dimethyl-1-propene, 3-methyl-1-diisobutylene, 4-methyl-1-pentene, acrylonitrile, vinyl esters, for example vinyl acetate, styrene, substituted styrenes with an alkyl substituent on the vinyl group, for example  $\alpha$ -methylstyrene and  $\alpha$ -ethylstyrene, substituted styrenes with one or more alkyl substituents on the ring, such as vinyltoluene and p-methylstyrene,

halogenated styrenes, for example monochlorostyrenes, dichlorostyrenes, tribromostyrenes and tetrabromostyrenes; heterocyclic compounds such as 2-vinylpyridine, 3-vinylpyridine, 2-methyl-5-vinylpyridine, 3-ethyl-4-vinylpyridine, 2,3-dimethyl-5-vinylpyridine, vinylpyrimidine, 9-vinylcarbazole, 3-vinylcarbazole, 4-vinylcarbazole, 2-methyl-1-vinylimidazole, vinyloxolane, vinylfuran, vinylthiophene, vinylthiolane, vinylthiazoles, vinyloxazoles and isoprenyl ethers; maleic acid derivatives, for example maleic anhydride, maleimide, methylmaleimide and dienes, for example divinylbenzene, and also, in the A blocks, the particular hydroxy-functionalized and/or amino-functionalized and/or mercapto-functionalized compounds. In addition, these copolymers may also be prepared such that they have a hydroxyl and/or amino and/or mercapto functionality in a substituent. Such monomers are, for example, vinylpiperidine, 1-vinylimidazole, N-vinylpyrrolidone, 2-vinylpyrrolidone, N-vinylpyrrolidine, 3-vinylpyrrolidine, N-vinylcaprolactam, N-vinylbutyrolactam, hydrogenated vinylthiazoles and hydrogenated vinyloxazoles. Particular preference is given to copolymerizing vinyl esters, vinyl ethers, fumarates, maleates, styrenes or acrylonitriles with the A blocks and/or B blocks.

The process can be carried out in any halogen-free solvents. Preference is given to toluene, xylene, H<sub>2</sub>O; acetates, preferably butyl acetate, ethyl acetate, propyl acetate; ketones, preferably ethyl methyl ketone, acetone; ethers; aliphatics, preferably pentane, hexane, but also biodiesel.

The block copolymers of the CABAC composition are prepared by means of sequential polymerization.

In addition to solution polymerization, the ATPR can also be carried out as an emulsion, miniemulsion, microemulsion, suspension or bulk polymerization.

The polymerization can be carried out at standard pressure, reduced pressure or elevated pressure. The polymerization temperature too is uncritical. In general, however, it is in the range of -20°C to 200°C, preferably of 0°C to 130°C and more preferably of 50°C to 120°C.

The inventive polymer preferably has a number-average molecular weight between

5000 g/mol and 120 000 g/mol, more preferably  $\leq 50\,000$  g/mol and most preferably between 7500 g/mol and 25 000 g/mol.

It has been found that the molecular weight distribution is below 1.8, preferably below 1.6, more preferably below 1.4 and ideally below 1.3.

As bifunctional initiators may be  $\text{RO}_2\text{C-CHX-(CH}_2)_n\text{-CHX-CO}_2\text{R}$ ,  $\text{RO}_2\text{C-C(CH}_3)_n\text{-X-(CH}_2)_n\text{-C(CH}_3)_n\text{-X-CO}_2\text{R}$ ,  $\text{RO}_2\text{C-CX}_2\text{-(CH}_2)_n\text{-CX}_2\text{-CO}_2\text{R}$ ,  $\text{RC(O)-CHX-(CH}_2)_n\text{-CHX-C(O)R}$ ,  $\text{RC(O)-C(CH}_3)_n\text{-X-(CH}_2)_n\text{-C(CH}_3)_n\text{-X-C(O)R}$ ,  $\text{RC(O)-CX}_2\text{-(CH}_2)_n\text{-CX}_2\text{-C(O)R}$ ,  $\text{XCH}_2\text{-CO}_2\text{-(CH}_2)_n\text{-OC(O)CH}_2\text{X}$ ,  $\text{CH}_3\text{CHX-CO}_2\text{-(CH}_2)_n\text{-OC(O)CHXCH}_3$ ,  $\text{(CH}_3)_2\text{CX-CO}_2\text{-(CH}_2)_n\text{-OC(O)CX(CH}_3)_2$ ,  $\text{X}_2\text{CH-CO}_2\text{-(CH}_2)_n\text{-OC(O)CHX}_2$ ,  $\text{CH}_3\text{CX}_2\text{-CO}_2\text{-(CH}_2)_n\text{-OC(O)CX}_2\text{CH}_3$ ,  $\text{XCH}_2\text{C(O)C(O)CH}_2\text{X}$ ,  $\text{CH}_3\text{CHXC(O)C(O)CHXCH}_3$ ,  $\text{XC(CH}_3)_2\text{C(O)C(O)CX(CH}_3)_2$ ,  $\text{X}_2\text{CHC(O)C(O)CHX}_2$ ,  $\text{CH}_3\text{CX}_2\text{C(O)C(O)CX}_2\text{CH}_3$ ,  $\text{XCH}_2\text{-C(O)-CH}_2\text{X}$ ,  $\text{CH}_3\text{-CHX-C(O)-CHX-CH}_3$ ,  $\text{CX(CH}_3)_2\text{-C(O)-CX(CH}_3)_2$ ,  $\text{X}_2\text{CH-C(O)-CHX}_2$ ,  $\text{C}_6\text{H}_5\text{-CHX-(CH}_2)_n\text{-CHX-C}_6\text{H}_5$ ,  $\text{C}_6\text{H}_5\text{-CX}_2\text{-(CH}_2)_n\text{-CX}_2\text{-C}_6\text{H}_5$ ,  $\text{C}_6\text{H}_5\text{-CX}_2\text{-(CH}_2)_n\text{-CX}_2\text{-C}_6\text{H}_5$ , o-, m- or p- $\text{XCH}_2\text{-Ph-CH}_2\text{X}$ , o-, m- or p- $\text{CH}_3\text{CHX-Ph-CHXCH}_3$ , o-, m- or p- $\text{(CH}_3)_2\text{CX-Ph-CX(CH}_3)_2$ , o-, m- or p- $\text{CH}_3\text{CX}_2\text{-Ph-CX}_2\text{CH}_3$ , o-, m- or p- $\text{X}_2\text{CH-Ph-CHX}_2$ , o-, m- or p- $\text{XCH}_2\text{-CO}_2\text{-Ph-OC(O)CH}_2\text{X}$ , o-, m- or p- $\text{CH}_3\text{CHX-CO}_2\text{-Ph-OC(O)CHXCH}_3$ , o-, m- or p- $\text{(CH}_3)_2\text{CX-CO}_2\text{-Ph-OC(O)CX(CH}_3)_2$ ,  $\text{CH}_3\text{CX}_2\text{-CO}_2\text{-Ph-OC(O)CX}_2\text{CH}_3$ , o-, m- or p- $\text{X}_2\text{CH-CO}_2\text{-Ph-OC(O)CHX}_2$  or o-, m- or p- $\text{XSO}_2\text{-Ph-SO}_2\text{X}$  (X is chlorine, bromine or iodine; Ph is phenylene ( $\text{C}_6\text{H}_4$ ); R represents an aliphatic radical which is composed of 1 to 20 carbon atoms and may be linear or branched or else of cyclic structure, may be saturated or mono- or polyunsaturated and may contain one or more aromatic rings or else is aromatic-free, and n is from 0 to 20). Preference is given to using 1,4-butanediol di(2-bromo-2-methylpropionate), 1,2-ethylene glycol di(2-bromo-2-methylpropionate), diethyl 2,5-dibromoadipate or diethyl 2,3-dibromomaleate. The ratio of initiator to monomer gives the later molecular weight, if all of the monomer is converted.

Catalysts for ATRP are listed in Chem. Rev. 2001, 101, 2921. Predominantly copper complexes are described - but other compounds employed also include iron, rhodium, platinum, ruthenium or nickel compounds. In general, it is possible to use all transition metal compounds which can form a redox cycle with the initiator, or the polymer chain which has a transferable atom group. For this purpose, copper can be supplied to the

system, for example, proceeding from  $\text{Cu}_2\text{O}$ ,  $\text{CuBr}$ ,  $\text{CuCl}$ ,  $\text{CuI}$ ,  $\text{CuN}_3$ ,  $\text{CuSCN}$ ,  $\text{CuCN}$ ,  $\text{CuNO}_2$ ,  $\text{CuNO}_3$ ,  $\text{CuBF}_4$ ,  $\text{Cu}(\text{CH}_3\text{COO})$  or  $\text{Cu}(\text{CF}_3\text{COO})$ .

One alternative to the ATRP described is a variant thereof: in so-called reverse ATRP, compounds in higher oxidation states, for example  $\text{CuBr}_2$ ,  $\text{CuCl}_2$ ,  $\text{CuO}$ ,  $\text{CrCl}_3$ ,  $\text{Fe}_2\text{O}_3$  or  $\text{FeBr}_3$ , can be used. In these cases, the reaction can be initiated with the aid of classic free-radical formers, for example AIBN. This first reduces the transition metal compounds, since they are reacted with the free radicals formed from the classic free-radical formers. Reverse ATRP has been described, inter alia, by Wang and Matyjaszewski in *Macromolecules* (1995), vol. 28, p. 7572ff.

One variant of reverse ATRP is that of the additional use of metals in the zero oxidation state. Presumable comproportionation with the transition metal compounds of the higher oxidation state brings about an acceleration of the reaction rate. This process is described in detail in WO 98/40415.

The molar ratio of transition metal to bifunctional initiator is generally in the range of 0.02:1 to 20:1, preferably in the range of 0.02:1 to 6:1 and more preferably in the range of 0.2:1 to 4:1, without any intention that this should impose a restriction.

In order to increase the solubility of the metals in organic solvents and simultaneously to prevent the formation of stable and hence polymerization-inactive organometallic compounds, ligands are added to the system. In addition, the ligands facilitate the abstraction of the transferable atom group by the transition metal compound. A list of known ligands can be found, for example, in WO 97/18247, WO 97/47661 or WO 98/40415. As a coordinative constituent, the compounds used as a ligand usually have one or more nitrogen, oxygen, phosphorus and/or sulphur atoms. Particular preference is given to nitrogen compounds. Very particular preference is given to nitrogen chelate ligands. Examples include 2,2'-bipyridine, N,N,N',N'',N''-pentamethyldiethylenetriamine (PMDETA), tris(2-aminoethyl)amine (TREN), N,N,N',N'-tetramethylethylenediamine or 1,1,4,7,10,10-hexamethyltriethylenetetramine. Valuable information regarding the selection and combination of the individual components can be found by the person skilled in the art in WO 98/40415.

These ligands can form coordination compounds with the metal compounds in situ or they can first be prepared as coordination compounds and then added to the reaction mixture.

The ratio of ligand (L) to transition metal depends on the denticity of the ligand and the coordination number of the transition metal (M). In general, the molar ratio is in the range of 100:1 to 0.1:1, preferably 6:1 to 0.1:1 and more preferably 3:1 to 1:1, without any intention that this should impose a restriction.

On completion of ATRP, the transition metal compound can be precipitated by means of addition of a suitable sulphur compound. By means of addition, for example, of mercaptans, the chain-terminal halogen atom is substituted with release of a hydrogen halide. The hydrogen halide - for example HBr - protonates the ligand L which coordinates to the transition metal to give an ammonium halide. As a result of this operation, the transition metal-ligand complex is quenched, and the "naked" metal is precipitated. Subsequently, the polymer solution can be purified easily by a simple filtration. Said sulphur compounds are preferably compounds with an SH group. Most preferably, they are one of the regulators known from free-radical polymerization, such as mercaptoethanol, ethylhexyl mercaptan, n-dodecyl mercaptan or thioglycolic acid.

From the inventive copolymers, it is possible to produce, for example, adhesives, sealant compositions, coating compositions or casting compositions. The use of the copolymers allows elasticity or cohesion of such end products to be improved. Furthermore, very good adhesion is observed on various substrates.

A further advantage of the block copolymers is the colourlessness and the odourlessness of the product produced.

The inventive pentablock copolymers bearing OH groups can be converted further in subsequent processes known to those skilled in the art. For example, the OH groups can be reacted with low molecular weight compounds which, in addition to a group reactive with OH groups, for example an NCO group, have a further functional group which is stable under the reaction conditions. Such functional groups are, for example, anhydride groups, acid groups, silyl groups, epoxy groups or isocyanate groups. As a

result of this additional process step, it is possible to obtain pentablock copolymers with other functional groups.

There is thus a wide field of application for these products. The selection of the application examples is not capable of restricting the use of the inventive polymers. The examples are intended to serve merely to illustrate the wide possible uses of the polymers described by way of a random sample. Preference is given to using block copolymers of the CABAC composition or of the ACBCA composition as prepolymers in reactive hotmelt adhesives, other hotmelt adhesives, coating compositions, primer coats, PSAs (pressure-sensitive adhesives), adhesive compositions or sealant compositions. The block copolymers of the CABAC or ACBCA composition may also find use as additives. One example of this would be addition as an impact modifier to adhesives or sealants.

The examples given below are given for better illustration of the present invention, but are not capable of restricting the invention to the features disclosed herein.

## Examples

The number-average molecular weight  $M_n$  and the weight-average molecular weight  $M_w$  and the molecular weight distribution  $D$  are measured by means of gel permeation chromatography (GPC) against a PMMA calibration.

### Examples 1 - 2

A jacketed vessel equipped with stirrer, thermometer, reflux condenser, nitrogen inlet tube and dropping funnel was initially charged, under an  $N_2$  atmosphere, with monomer I (exact name and amount in Table 2), butyl acetate, 0.9 g of copper(I) oxide and 2.3 g of PMDETA. The solution is stirred at 60°C for 15 min. Subsequently, at the same temperature, the initiator 1,4-butanediol di(2-bromo-2-methylpropionate) (BDBIB), dissolved in butyl acetate, is added dropwise. After the polymerization time of 3 hours, a sample is taken to determine the mean molar mass  $M_n$  (by means of SEC), and monomer II (exact name and amount in Table 2) is added. After a calculated 98% conversion, a further sample is finally taken for an SEC measurement and the mixture of monomer III and monomer F (exact name and amount in Table 2) is added. The mixture is polymerized up to an expected conversion of at least 98% and then stopped by means of introduction of atmospheric oxygen for about five minutes. Subsequently, 5 g of n-dodecyl mercaptan are added. The solution, which had been greenish beforehand, turns red spontaneously and a red solid precipitates out. The filtration is effected by means of an elevated pressure filtration. The solution is admixed with 50 g of Tonsil Optimum 210 FF (from Südchemie), stirred for 30 min and then filtered under elevated pressure through an activated carbon filter (AKS 5 from Pall Seitz Schenk). The mean molecular weight and the molecular weight distribution are finally determined by SEC measurements.

### Examples 3 - 4

A jacketed vessel equipped with stirrer, thermometer, reflux condenser, nitrogen inlet tube and dropping funnel was initially charged, under an N<sub>2</sub> atmosphere, with monomer I (exact name and amount in Table 2), butyl acetate, 0.9 g of copper(I) oxide and 2.3 g of PMDETA. The solution is stirred at 60°C for 15 min. Subsequently, at the same temperature, the initiator 1,4-butanediol di(2-bromo-2-methylpropionate) (BDBIB), dissolved in 10 ml of butyl acetate, is added dropwise. After a polymerization time of 3 hours, a sample is taken to determine the mean molar mass  $M_n$  (by means of SEC), and a mixture of monomer II and monomer F (exact name and amount in Table 2) is added. After a calculated 98% conversion, a further sample is finally taken for an SEC measurement and monomer III (exact name and amount in Table 2) is added. The mixture is polymerized up to an expected conversion of at least 98% and then stopped by means of introduction of atmospheric oxygen for about five minutes. Subsequently, 5 g of n-dodecyl mercaptan are added. The solution, which had been greenish beforehand, turns red spontaneously and a red solid precipitates out. The filtration is effected by means of an elevated pressure filtration. The solution is admixed with 50 g of Tonsil Optimum 210 FF (from Südchemie), stirred for 30 min and then filtered under elevated pressure through an activated carbon filter (AKS 5 from Pall Seitz Schenk). The mean molecular weight and the molecular weight distribution are finally determined by SEC measurements.

Table 1

Example	1	2	3	4
Monomer I	n-BA	MMA	n-BA	MMA
Amount	41.02 g	41.65 g	41.80 g	41.55 g
Monomer II	MMA	n-BA	MMA	MMA
Amount	41.02 g	41.65 g	41.23 g	41.37 g
Monomer III	MMA	n-BA	MMA	n-BA
Amount	14.66 g	14.88 g	14.85 g	14.85 g
Monomer F	HEMA	HEMA	HEMA	HEMA
Amount	3.30 g	3.25 g	3.30 g	3.30 g
Amount of initiator	2.33 g	2.55 g	2.45 g	2.48 g
M <sub>n</sub> (1st stage)	9300	8800	9100	8700
M <sub>n</sub> (2nd stage)	13300	15500	13600	15700
M <sub>n</sub> (end product)	17900	18200	17200	17800
D	1.33	1.28	1.33	1.28

MMA= methyl methacrylate; n-BA= n-butyl acrylate, HEMA= 2-hydroxyethyl methacrylate

## Claims

1. Process for preparing pentablock copolymers functionalized with OH groups, characterized in that  
exactly two blocks containing hydroxy-functionalized (meth)acrylates and monomers selected from the group of the non-hydroxy-functionalized (meth)acrylates or mixtures thereof and  
exactly three blocks containing (meth)acrylates or mixtures thereof, which have no hydroxyl function and among which two blocks in turn are of corresponding composition and the third block has a different composition,  
are prepared as pentablock copolymers.
2. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 1, characterized in that  
the pentablock copolymer is a block copolymer of the CABAC form,  
the A blocks are composed of hydroxy-functionalized (meth)acrylates and monomers selected from the group of the non-hydroxy-functionalized (meth)acrylates or mixtures thereof, and  
blocks B and C are composed of (meth)acrylates or mixtures thereof, which have no hydroxyl function.
3. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 2, characterized in that the composition of the non-OH-functionalized fraction in the A blocks corresponds to the composition of the C blocks.
4. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 2, characterized in that the composition of the non-OH-

functionalized fraction in the A blocks corresponds to the composition of the B blocks.

5. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 2, characterized in that the glass transition temperature of the B block is greater than 50°C and the glass transition temperature of the C blocks is less than 0°C.
6. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 2, characterized in that the glass transition temperature of the C blocks is greater than 50°C and the glass transition temperature of the B block is less than 0°C.
7. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 2, characterized in that the individual A blocks of the CABAC block copolymers have a composition with  $\leq 2$  OH groups.
8. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 2, characterized in that the individual A blocks make up less than 20% of the total weight of the CABAC block copolymer.
9. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 8, characterized in that the individual A blocks make up less than 10% of the total weight of the CABAC block copolymer.
10. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 1, characterized in that  
the pentablock copolymer is a block copolymer of the ACBCA form,  
the A blocks are composed of hydroxy-functionalized (meth)acrylates and

monomers selected from the group of the non-hydroxy-functionalized (meth)acrylates or mixtures thereof, and

blocks B and C are composed of (meth)acrylates or mixtures thereof, which have no hydroxyl function.

11. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 10, characterized in that the composition of the non-OH-functionalized fraction in the A blocks corresponds to the composition of the C blocks.
12. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 10, characterized in that the composition of the non-OH-functionalized fraction in the A blocks corresponds to the composition of the B blocks.
13. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 10, characterized in that the glass transition temperature of the B block is greater than 50°C and the glass transition temperature of the C blocks is less than 0°C.
14. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 10, characterized in that the glass transition temperature of the C blocks is greater than 50°C and the glass transition temperature of the B block is less than 0°C.
15. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 10, characterized in that the individual A blocks of the ACBCA block copolymers have a composition with  $\leq 2$  OH groups.

16. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 10, characterized in that the individual A blocks make up less than 20% of the total weight of the ACBCA block copolymer.
17. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 16, characterized in that the individual A blocks make up less than 10% of the total weight of the ACBCA block copolymer.
18. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 1, characterized in that the block copolymers contain monomers which are polymerizable by means of ATRP and do not form part of the group of the (meth)acrylates in the A blocks and/or B block and/or C blocks.
19. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 18, characterized in that the block copolymers contain monomers which are polymerizable by means of ATRP and do not form part of the group of the (meth)acrylates in the A blocks and/or B block and/or C blocks in amounts of 0-50% by weight.
20. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 1, characterized in that the hydroxy-functionalized (meth)acrylates are preferably selected from the group of hydroxyalkyl (meth)acrylates of straight-chain, branched or cycloaliphatic diols having 2-36 carbon atoms, for example 3-hydroxypropyl (meth)acrylate, 3,4-dihydroxybutyl mono(meth)acrylate, 4-hydroxybutyl (meth)acrylate, 2-hydroxypropyl (meth)acrylate, 2,5-dimethyl-1,6-hexanediol mono(meth)acrylate, hydroxyethyl acrylate and more preferably 2-hydroxyethyl methacrylate.
21. Process for preparing pentablock copolymers functionalized with OH groups

according to Claim 1, characterized in that the (meth)acrylates are preferably selected from the group of alkyl (meth)acrylates of straight-chain, branched or cycloaliphatic alcohols having 1-40 carbon atoms, for example methyl (meth)acrylate, ethyl (meth)acrylate, n-butyl (meth)acrylate, i-butyl (meth)acrylate, t-butyl (meth)acrylate, 2-ethylhexyl (meth)acrylate, stearyl (meth)acrylate, lauryl (meth)acrylate, cyclohexyl (meth)acrylate, isobornyl (meth)acrylate, aryl (meth)acrylates, for example benzyl (meth)acrylate or phenyl (meth)acrylate, each of which may be unsubstituted or have mono- to tetrasubstituted aryl radicals, mono(meth)acrylates of ethers, polyethylene glycols, polypropylene glycols or mixtures thereof having 5-80 carbon atoms, for example tetrahydrofurfuryl methacrylate, methoxy(m)ethoxyethyl methacrylate, 1-butoxypropyl methacrylate, cyclohexyloxymethyl methacrylate, benzyloxymethyl methacrylate, furfuryl methacrylate, 2-butoxyethyl methacrylate, 2-ethoxyethyl methacrylate, allyloxymethyl methacrylate, 1-ethoxybutyl methacrylate, 1-ethoxyethyl methacrylate, ethoxymethyl methacrylate, poly(ethylene glycol) methyl ether (meth)acrylate or poly(propylene glycol) methyl ether (meth)acrylate.

22. Process for preparing pentablock copolymers functionalized with OH groups according to Claim 1, characterized in that the pentablock copolymers are prepared by means of atom transfer radical polymerization (ATRP) in the presence of an initiator and of a catalyst in a halogen-free solvent.

23. Process for preparing pentablock copolymers according to Claim 22, characterized in that the initiator is a bifunctional initiator.

24. Process for preparing pentablock copolymers according to Claim 23, characterized in that the bifunctional initiator used is preferably 1,4-butanediol di(2-bromo-2-methylpropionate), 1,2-ethylene glycol di(2-bromo-2-methylpropionate), diethyl 2,5-dibromoadipate or diethyl 2,3-dibromomaleate.

25. Process for preparing pentablock copolymers according to Claim 22, characterized in that the pentablock copolymer is prepared by means of sequential polymerization.
26. Process for preparing pentablock copolymers according to Claim 22, characterized in that the catalysts used are transition metal compounds.
27. Process for preparing pentablock copolymers according to Claim 26, characterized in that the catalysts used are copper compounds.
28. Process for preparing pentablock copolymers according to Claim 22, characterized in that the catalyst, before the polymerization, is combined with a nitrogen, oxygen, sulphur or phosphorus compound which can enter into one or more coordinate bonds with the transition metal to form a metal-ligand complex.
29. Process for preparing pentablock copolymers according to Claim 28, characterized in that the ligands used are N-containing chelate ligands.
30. Process for preparing pentablock copolymers according to Claim 29, characterized in that the ligand used is 2,2'-bipyridine, N,N,N',N'',N'''-penta-methyldiethylenetriamine (PMDETA), tris(2-aminoethyl)amine (TREN), N,N,N',N'-tetramethylethylenediamine or 1,1,4,7,10,10-hexamethyltriethylene-tetramine.
31. Process for preparing pentablock copolymers according to Claim 22, characterized in that the block copolymer has a number-average molecular weight between 5000 g/mol and 100 000 g/mol.

32. Process for preparing pentablock copolymers according to Claim 31, characterized in that the block copolymer preferably has a number-average molecular weight between 7500 g/mol and 50 000 g/mol.
33. Process for preparing pentablock copolymers according to Claim 22, characterized in that the catalyst, after the polymerization, is precipitated by means of addition of a sulphur compound and removed from the polymer solution by means of filtration.
34. Process for preparing pentablock copolymers according to Claim 33, characterized in that the sulphur compound is a mercaptan or a compound having a thiol group.
35. Process according to Claim 1 to 34, characterized in that the OH groups of the polymer are reacted with low molecular weight compounds which, in addition to a group reactive with OH groups, have an anhydride, acid, isocyanate, epoxide or silyl group.
36. Pentablock copolymers functionalized with OH groups which are obtainable by the process described in Claim 1, characterized in that they are composed of exactly two blocks containing hydroxy-functionalized (meth)acrylates and monomers selected from the group of the non-hydroxy-functionalized (meth)acrylates or mixtures thereof and exactly three blocks containing (meth)acrylates or mixtures thereof, which have no hydroxyl function and among which two blocks in turn are of corresponding composition and the third block has a different composition.
37. Pentablock copolymers functionalized with OH groups which are obtainable by

the process described in Claim 2, characterized in that

the pentablock copolymer is a block copolymer of the CABAC form,

the A blocks are composed of hydroxy-functionalized (meth)acrylates and monomers selected from the group of the non-hydroxy-functionalized (meth)acrylates or mixtures thereof, and

blocks B and C are composed of (meth)acrylates, or mixtures thereof, which have no hydroxyl function.

38. Pentablock copolymers functionalized with OH groups which are obtainable by the process described in Claim 10, characterized in that

the pentablock copolymer is a block copolymer of the ACBCA form,

the A blocks are composed of hydroxy-functionalized (meth)acrylates and monomers selected from the group of the non-hydroxy-functionalized (meth)acrylates or mixtures thereof, and

blocks B and C are composed of (meth)acrylates, or mixtures thereof, which have no hydroxyl function.

39. Use of block copolymers of the CABAC composition with OH groups in the individual A blocks, characterized in that

the A blocks are a copolymer comprising hydroxy-functionalized (meth)acrylates and monomers selected from the group of the non-hydroxy-functionalized (meth)acrylates or mixtures thereof, and

the B and C blocks containing (meth)acrylates, or mixtures thereof, which have no hydroxyl function

in reactive hotmelt adhesives, other hotmelt adhesives, coating materials, primer coats, pressure-sensitive adhesives, reactive adhesives, adhesive compositions, sealant compositions, or as impact modifiers in adhesive or sealant compositions.

40. Use of block copolymers of the ACBCA composition with OH groups in the individual A blocks, characterized in that

the A blocks are a copolymer comprising hydroxy-functionalized (meth)acrylates and monomers selected from the group of the non-hydroxy-functionalized (meth)acrylates or mixtures thereof, and

the B and C blocks containing (meth)acrylates, or mixtures thereof, which have no hydroxyl function

in reactive hotmelt adhesives, other hotmelt adhesives, coating materials, primer coats, pressure-sensitive adhesives, reactive substances, adhesive compositions, sealant compositions, or as impact modifiers in adhesive or sealant compositions.

# INTERNATIONAL SEARCH REPORT

International application No

PCT/EP2008/060520

## A. CLASSIFICATION OF SUBJECT MATTER

INV. C08F293/00 C08F297/02 C09D153/00 C09J153/00

According to International Patent Classification (IPC) or to both national classification and IPC

## B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

C08F C09D C09J

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

EPO-Internal, WPI Data

## C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	EP 1 475 397 A (KANEKAFUCHI CHEMICAL IND [JP]) 10 November 2004 (2004-11-10) paragraphs [0044]; [0052], [0092], [0179] - [0181], [0221]; claim 1	1-40
A	WO 2006/106214 A (ARKEMA FRANCE [FR]; CENTRE NAT RECH SCIENT [FR]; EL BOUNIA NOUR-EDDINE) 12 October 2006 (2006-10-12) claims 1-3,7,9,16 -/-	1-40



Further documents are listed in the continuation of Box C.



See patent family annex.

### \* Special categories of cited documents:

- \*A\* document defining the general state of the art which is not considered to be of particular relevance
- \*E\* earlier document but published on or after the international filing date
- \*L\* document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- \*O\* document referring to an oral disclosure, use, exhibition or other means
- \*P\* document published prior to the international filing date but later than the priority date claimed

- \*T\* later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
- \*X\* document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
- \*Y\* document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
- \*Z\* document member of the same patent family

Date of the actual completion of the international search

10 November 2008

Date of mailing of the international search report

14/11/2008

Name and mailing address of the ISA/

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Authorized officer

Clement, Silvia

# INTERNATIONAL SEARCH REPORT

International application No

PCT/EP2008/060520

## C(Continuation). DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
P,A	<p>XU F J ET AL: "Pentablock copolymers of poly(ethylene glycol), poly((2-dimethyl amino)ethyl methacrylate) and poly(2-hydroxyethyl methacrylate) from consecutive atom transfer radical polymerizations for non-viral gene delivery"</p> <p>1 July 2008 (2008-07-01), BIOMATERIALS, ELSEVIER SCIENCE PUBLISHERS BV., BARKING, GB, PAGE(S) 3023 - 3033 , XP022647944</p> <p>ISSN: 0142-9612</p> <p>[retrieved on 2008-04-18]</p> <p>the whole document</p>	1-40

# INTERNATIONAL SEARCH REPORT

Information on patent family members

International application No

PCT/EP2008/060520

Patent document cited in search report		Publication date	Patent family member(s)	Publication date
EP 1475397	A	10-11-2004	AU 2003211925 A1	04-09-2003
			WO 03068836 A1	21-08-2003
			TW 254718 B	11-05-2006
			US 2005272865 A1	08-12-2005
			US 2005085592 A1	21-04-2005
WO 2006106214	A	12-10-2006	CN 101193973 A	04-06-2008
			EP 1866370 A1	19-12-2007
			FR 2883879 A1	06-10-2006
			JP 2008534764 T	28-08-2008
			KR 20070116856 A	11-12-2007
			US 2008207817 A1	28-08-2008

# INTERNATIONALER RECHERCHENBERICHT

Internationales Aktenzeichen  
PCT/EP2008/060520

## A. KLASSIFIZIERUNG DES ANMELDUNGSGEGENSTANDES

INV. C08F293/00 C08F297/02 C09D153/00 C09J153/00

Nach der internationalen Patentklassifikation (IPC) oder nach der nationalen Klassifikation und der IPC

## B. RECHERCHIERTE GEBIETE

Recherchierte Mindestprüfstoff (Klassifikationssystem und Klassifikationssymbole)

C08F C09D C09J

Recherchierte, aber nicht zum Mindestprüfstoff gehörende Veröffentlichungen, soweit diese unter die recherchierten Gebiete fallen

Während der internationalen Recherche konsultierte elektronische Datenbank (Name der Datenbank und evtl. verwendete Suchbegriffe)

EPO-Internal, WPI Data

## C. ALS WESENTLICH ANGESEHENE UNTERLAGEN

Kategorie*	Bezeichnung der Veröffentlichung, soweit erforderlich unter Angabe der in Betracht kommenden Teile	Beitr. Anspruch Nr.
A	EP 1 475 397 A (KANEKAFUCHI CHEMICAL IND [JP]) 10. November 2004 (2004-11-10) Absätze [0044], [0052], [0092], [0179] - [0181], [0221]; Anspruch 1	1-40
A	WO 2006/106214 A (ARKEMA FRANCE [FR]; CENTRE NAT RECH SCIENT [FR]; EL BOUNIA NOUR-EDDINE) 12. Oktober 2006 (2006-10-12) Ansprüche 1-3,7,9,16	1-40
	-/-	

☒ Weitere Veröffentlichungen sind der Fortsetzung von Feld C zu entnehmen ☒ Siehe Anhang Patentfamilie

\* Besondere Kategorien von angegebenen Veröffentlichungen :

\*A\* Veröffentlichung, die den allgemeinen Stand der Technik definiert, aber nicht als besonders bedeutsam anzusehen ist

\*E\* Älteres Dokument, das jedoch erst am oder nach dem internationalen Anmeldedatum veröffentlicht worden ist

\*L\* Veröffentlichung, die geeignet ist, einen Prioritätsanspruch zweifelhaft erscheinen zu lassen, oder durch die das Veröffentlichungsdatum einer anderen im Recherchenbericht genannten Veröffentlichung belegt werden soll oder die aus einem anderen besonderen Grund angegeben ist (wie ausgeführt)

\*O\* Veröffentlichung, die sich auf eine mündliche Offenbarung, eine Benutzung, eine Ausstellung oder andere Maßnahmen bezieht

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\*T\* Spätere Veröffentlichung, die nach dem internationalen Anmeldedatum oder dem Prioritätsdatum veröffentlicht worden ist und mit der Anmeldung nicht kollidiert, sondern nur zum Verständnis des der Erfindung zugrundeliegenden Prinzips oder der ihr zugrundeliegenden Theorie angegeben ist

\*X\* Veröffentlichung von besonderer Bedeutung, die beanspruchte Erfindung kann allein aufgrund dieser Veröffentlichung nicht als neu oder auf erfinderischer Tätigkeit beruhend betrachtet werden

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\*Z\* Veröffentlichung, die Mitglied derselben Patentfamilie ist

Datum des Abschlusses der internationalen Recherche

10. November 2008

Absenddatum des internationalen Recherchenberichts

14/11/2008

Name und Postanschrift der internationalen Recherchenbehörde

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Bevollmächtigter Bediensteter

Clement, Silvia

# INTERNATIONALER RECHERCHENBERICHT

Internationales Aktenzeichen  
PCT/EP2008/060520

## C. (Fortsetzung) ALS WESENTLICH ANGESEHENE UNTERLAGEN

Kategorie*	Bezeichnung der Veröffentlichung, soweit erforderlich unter Angabe der in Betracht kommenden Teile	Betr. Anspruch Nr.
P,A	<p>XU F J ET AL: "Pentablock copolymers of poly(ethylene glycol), poly((2-dimethyl amino)ethyl methacrylate) and poly(2-hydroxyethyl methacrylate) from consecutive atom transfer radical polymerizations for non-viral gene delivery"</p> <p>1. Juli 2008 (2008-07-01), BIOMATERIALS, ELSEVIER SCIENCE PUBLISHERS BV., BARKING, GB, PAGE(S) 3023 - 3033 , XP022647944 ISSN: 0142-9612 [gefunden am 2008-04-18] das ganze Dokument</p>	1-40

# INTERNATIONALER RECHERCHENBERICHT

Angaben zu Veröffentlichungen, die zur selben Patentfamilie gehören

Internationales Aktenzeichen

PCT/EP2008/060520

Im Recherchenbericht angeführtes Patentdokument	Datum der Veröffentlichung	Mitglied(er) der Patentfamilie	Datum der Veröffentlichung
EP 1475397 A	10-11-2004	AU 2003211925 A1	04-09-2003
		WO 03068836 A1	21-08-2003
		TW 254718 B	11-05-2006
		US 2005272865 A1	08-12-2005
		US 2005085592 A1	21-04-2005
WO 2006106214 A	12-10-2006	CN 101193973 A	04-06-2008
		EP 1866370 A1	19-12-2007
		FR 2883879 A1	06-10-2006
		JP 2008534764 T	28-08-2008
		KR 20070116856 A	11-12-2007
		US 2008207817 A1	28-08-2008

Request for Participation in the  
Patent Prosecution Highway Program  
U.S. Patent Application No. 12/674,552  
Attorney Docket No. 354652US0PCT

# APPENDIX D

## Claims Correspondence Table

Request for Participation in the Patent Prosecution Highway Program  
U.S. Patent Application No. 12/674,552  
Attorney Docket No. 354652US0PCT

CLAIMS CORRESPONDENCE TABLE

Claims in US 12/674,552 as amended Feb. 22, 2010	Claims receiving favorable treatment in PCT/EP2008/060520	Explanation regarding correspondence
1	1	Claim 1 of the US application is substantively identical to claim 1 of PCT/EP2008/060520.
2	2	Claim 2 of the US application is substantively identical to claim 2 of PCT/EP2008/060520.
3	3	Claim 3 of the US application is substantively identical to claim 3 of PCT/EP2008/060520.
4	4	Claim 4 of the US application is substantively identical to claim 4 of PCT/EP2008/060520.
5	5	Claim 5 of the US application is substantively identical to claim 5 of PCT/EP2008/060520.
6	6	Claim 6 of the US application is substantively identical to claim 6 of PCT/EP2008/060520.
7	7	Claim 7 of the US application is substantively identical to claim 7 of PCT/EP2008/060520.
8	8	Claim 8 of the US application is substantively identical to claim 8 of PCT/EP2008/060520.
9	9	Claim 9 of the US application is substantively identical to claim 9 of PCT/EP2008/060520.

Claims in US 12/674,552 as amended Feb. 22, 2010	Claims receiving favorable treatment in PCT/EP2008/060520	Explanation regarding correspondence
10	10	Claim 10 of the US application is substantively identical to claim 10 of PCT/EP2008/060520.
11	11	Claim 11 of the US application is substantively identical to claim 11 of PCT/EP2008/060520.
12	12	Claim 12 of the US application is substantively identical to claim 12 of PCT/EP2008/060520.
13	13	Claim 13 of the US application is substantively identical to claim 13 of PCT/EP2008/060520.
14	14	Claim 14 of the US application is substantively identical to claim 14 of PCT/EP2008/060520.
15	15	Claim 15 of the US application is substantively identical to claim 15 of PCT/EP2008/060520.
16	16	Claim 16 of the US application is substantively identical to claim 16 of PCT/EP2008/060520.
17	17	Claim 17 of the US application is substantively identical to claim 17 of PCT/EP2008/060520.
18	18	Claim 18 of the US application is substantively identical to claim 18 of PCT/EP2008/060520.
19	19	Claim 19 of the US application is substantively identical to claim 19 of PCT/EP2008/060520.

Claims in US 12/674,552 as amended Feb. 22, 2010	Claims receiving favorable treatment in PCT/EP2008/060520	Explanation regarding correspondence
20	20	Claim 20 of the US application is substantively identical to claim 20 of PCT/EP2008/060520.
21	21	Claim 21 of the US application is substantively identical to claim 21 of PCT/EP2008/060520.
22	22	Claim 22 of the US application is substantively identical to claim 22 of PCT/EP2008/060520.
23	23	Claim 23 of the US application is substantively identical to claim 23 of PCT/EP2008/060520.
24	24	Claim 24 of the US application is substantively identical to claim 24 of PCT/EP2008/060520.
25	25	Claim 25 of the US application is substantively identical to claim 25 of PCT/EP2008/060520.
26	26	Claim 26 of the US application is substantively identical to claim 26 of PCT/EP2008/060520.
27	27	Claim 27 of the US application is substantively identical to claim 27 of PCT/EP2008/060520.
28	28	Claim 28 of the US application is substantively identical to claim 28 of PCT/EP2008/060520.
29	29	Claim 29 of the US application is substantively identical to claim 29 of PCT/EP2008/060520.

Claims in US 12/674,552 as amended Feb. 22, 2010	Claims receiving favorable treatment in PCT/EP2008/060520	Explanation regarding correspondence
30	30	Claim 30 of the US application is substantively identical to claim 30 of PCT/EP2008/060520.
31	31	Claim 31 of the US application is substantively identical to claim 31 of PCT/EP2008/060520.
32	32	Claim 32 of the US application is substantively identical to claim 32 of PCT/EP2008/060520.
33	33	Claim 33 of the US application is substantively identical to claim 33 of PCT/EP2008/060520.
34	34	Claim 34 of the US application is substantively identical to claim 34 of PCT/EP2008/060520.
35	35	Claim 35 of the US application is substantively identical to claim 35 of PCT/EP2008/060520.
36	36	Claim 36 of the US application is substantively identical to claim 36 of PCT/EP2008/060520.
37	37	Claim 37 of the US application is substantively identical to claim 37 of PCT/EP2008/060520.
38	38	Claim 38 of the US application is substantively identical to claim 38 of PCT/EP2008/060520.
39	39	Claim 39 of the US application is substantively identical to claim 39 of PCT/EP2008/060520.

Claims in US 12/674,552 as amended Feb. 22, 2010	Claims receiving favorable treatment in PCT/EP2008/060520	Explanation regarding correspondence
40	40	Claim 40 of the US application is substantively identical to claim 40 of PCT/EP2008/060520.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,552	04/05/2010	Sven Balk	354652USOPCT	7466

22850	7590	01/12/2011
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.		
1940 DUKE STREET		
ALEXANDRIA, VA 22314		

EXAMINER	
LENIHAN, JEFFREY S	

ART UNIT	PAPER NUMBER
1765	

NOTIFICATION DATE	DELIVERY MODE
01/12/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com



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Alexandria, VA 22313-1450  
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CT

January 11, 2011

In re application of	:	DECISION ON REQUEST TO
Sven Balk et al	:	PARTICIPATE IN PATENT
Serial No. 12/674,552	:	PROSECUTION HIGHWAY
Filed: April 5, 2010	:	PROGRAM AND
For: METHOD FOR PREPARATION OF	:	PETITION TO MAKE SPECIAL
PENTA-BLOCK COPOLYMERS	:	UNDER 37 CFR 1.102(a)
WITH OH-FUNCTIONALIZED BLOCKS	:	
BASED ON (METH)ACRYLATE	:	

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed September 29, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, USPTO or KIPO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) Applicant must submit a claims correspondence table in English and all the independent claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;

Application No. 12/674,552

(6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof if the latest international work product is not in the English language; and

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Christine Tierney/

---

Christine Tierney  
Quality Assurance Specialist  
Technology Center 1700

**Doc Code: PET.GREEN**

**Document Description: Petition for Green Tech Pilot**

PTO/SB/420 (11-10)

Approved for use through 01/31/2011. OMB 0651-0062

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM		
Attorney Docket Number:	100219	Application Number (if known): 12/674,565-Conf. #7514
Filing date: February 22, 2010		
First Named Inventor: Hajime Murata		
Title: MONOPOLE TOWER AND WIND TURBINE GENERATOR HAVING MONOPOLE TOWER		
<b>APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.</b>		
This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.		
1. By filing this petition:		
<b><u>Applicant is requesting early publication:</u> Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request.</b>		
2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirements for the Green Technology Pilot Program, if the Office determines that the claims are not obviously directed to a single invention. See Instruction Sheet.		
3. This request is accompanied by statements of special status for the eligibility requirement.		
4. The application contains no more than three (3) independent claims and twenty (20) total claims.		
5. The application does not contain any multiple dependent claims.		
6. Other attachments: REQUEST FOR EARLY PUBLICATION, STATEMENT OF SPECIAL STATUS, PRELIMINARY AMENDMENT		

Signature	/Bernadette K. McGann/	Date	March 31, 2011
Name (Print/Typed)	Bernadette K. McGann	Registration Number	65,127
<b>Note:</b> Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms if more than one signature, see below*.			
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.			



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,565	02/22/2010	Hajime Murata	100219	7514
38834 7590 09/30/2011 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER	
			ART UNIT 2839	PAPER NUMBER
			NOTIFICATION DATE 09/30/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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patentmail@whda.com



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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP  
1250 CONNECTICUT AVENUE, NW  
SUITE 700  
WASHINGTON DC 20036

SEP 30 2011

In re Application of	:	
Hajime MURATA	:	DECISION ON PETITION
Application No. 12/674565	:	TO MAKE SPECIAL UNDER
Filed: February 22, 2010	:	THE GREEN TECHNOLOGY
Attorney Docket No. 100219	:	PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed on March 31, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within ONE (1) MONTH OR THIRTY (30) DAYS from the mail date of this decision, whichever is longer. No extension of this time limit can be granted under 37 CFR 1.136(a) or (b). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications and be filed prior to the date of the notice, December 8, 2009.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to

make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The petition lacks item 4.

In regard to item 4, applicant's statement pertaining to how the materiality standard is met does not satisfy the requirements for this pilot. The petition alleges that the claimed invention contributes to the development of renewable energy resources or greenhouse gas emission reduction. The claims are generally directed to a tower. The recitation of the wind turbine generator in the claims is considered intended use. It is not readily apparent how tower contributes to development of renewable energy resources or greenhouse gas emission reduction. The materiality standard does not permit an applicant to speculate as to how a hypothetical end-user might specially apply the invention in a manner that could contribute to the development of renewable energy resources. Any argument that the claimed invention can be used with a wind turbine is considered speculate as to how a hypothetical end-user might specially apply the claimed invention.

Any reconsideration of this decision should be submitted through the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen.

Telephone inquiries concerning this decision should be directed to Colleen Dunn at 571-272-1170.

The application is being forwarded to the appropriate Technology Center Art Unit for action in its regular turn.

/Colleen Dunn/

---

Colleen Dunn  
Quality Assurance Specialist  
Technology Center 2800

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of: **Hajime MURATA**

Art Unit: **2839**

Application Number: **12/674,565**

Examiner: **To Be Assigned**

Filed: **February 22, 2010**

Confirmation No.: **7514**

For: **MONOPOLE TOWER AND WIND TURBINE GENERATOR HAVING  
MONOPOLE TOWER**

Attorney Docket Number: **100219**

Customer Number: **38834**

**REQUEST FOR RECONSIDERATION OF PETITION  
TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

October 27, 2011

Sir:

This paper is filed in response to the Decision mailed September 30, 2011. Applicants respectfully request reconsideration of the Decision.

Submitted herewith is a Second Preliminary Amendment. In the Second Preliminary Amendment, the pending claims are directed towards the presently claimed wind turbine generator.

The Statement of Special Status, filed on March 31, 2011, establishes reasons why the presently claimed wind turbine generator materially contributes to the development of renewable energy or energy conservation.

Applicant respectfully requests that the Request for Reconsideration of Petition to be made special under the Green Technology Pilot Program in the present application be granted. In the event that any additional information is required for a grantable petition, the petitions attorney is requested to telephone applicants' undersigned attorney. Furthermore, in the event that any fees

Application Number: 12/674,565

Request for Reconsideration of Petition  
Attorney Docket No. 100219

are due with respect to this paper, please charge our Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

/BERNADETTE K. MCGANN/

Bernadette K. McGann  
Attorney for Applicant  
Registration No. 65,127  
Telephone: (202) 822-1100  
Facsimile: (202) 822-1111

BKM/bam



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,565	02/22/2010	Hajime Murata	100219	7514
38834 7590 11/09/2011 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER	
			ART UNIT 2839	PAPER NUMBER
			NOTIFICATION DATE 11/09/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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patentmail@whda.com



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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP  
1250 CONNECTICUT AVENUE, NW  
SUITE 700  
WASHINGTON DC 20036

*Nov. 09, 2011*

In re Application of	:	
Murata	:	DECISION ON PETITION
Application No. 12/674,565	:	TO MAKE SPECIAL UNDER
Filed: 2/22/2010	:	THE GREEN TECHNOLOGY
Attorney Docket No. 100219	:	PILOT PROGRAM

This is a decision on the request for reconsideration, filed 10/27/2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth in 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a

request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded “special” status.

Telephone inquiries concerning this decision should be directed to Tom Dunn at 571-272-1171.

The application is being forwarded to the Technology Center Art Unit 2839 for action on the merits commensurate with this decision.

/Tom Dunn/

---

Tom Dunn  
Quality Assurance Specialist  
Technology Center 1700



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MAILED

FEB 08 2011

PCT LEGAL ADMINISTRATION

Baker Donelson Bearman, Caldwell & Berkowitz, PC  
920 Massachusetts Ave, NW  
Suite 900  
Washington DC 20001

In re Application of :  
OLENIK et al. :  
Application No.: 12/674,582 :  
Filed: February 22, 2010 :  
Attorney Docket No.: 2903925-228000 :  
For: THERMODYNAMICALLY STABLE :  
CRYSTAL MODIFICATION OF :  
2-({2-CHLORO-4-(METHYLSULFONYL)- :  
3-[(2,2,2-TRIFLUOROETHOXY)METHY :  
L :

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.78(a)(3), filed January 14, 2010, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed nonprovisional application set forth in the Supplemental Application Data Sheet (ADS) filed concurrently with the instant petition.

The petition under 37 CFR 1.78(a)(3) is DISMISSED.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

A petition for acceptance of a claim for late priority under 37 CFR §1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR § 1.78(a)(2)(ii). In addition, the petition under 37 CFR § 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. §120 and 37 CFR §1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §1.78(a)(2)(ii) and the date the claim was filed

was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

As to item (1), the petition does not comply with the requirements for a grantable petition under 37 CFR §§1.78(a)(3), in that, a proper reference to the prior-filed applications has not been included in an amendment to the first sentence of the specification following the title or in an executed supplemental Application Data Sheet, as provided by 37 CFR §§ 1.78(a)(2)(iii).


Applicant is advised that a supplemental application data sheet (ADS) must bear a proper signature as required by 37 CFR 1.33(b). The ADS submitted with the present petition does not bear a proper signature as required by 37 CFR 1.33(b). Form PTO/SB/14 contains an appropriate signature block and can be obtained at <http://www.uspto.gov/ebs/portal/efs/sb0014.fill.pdf>. Therefore, before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet (37 CFR 1.76(a)(5)) or a proper amendment (complying with the provisions of 37 CFR 1.121) to correct the above matters must be filed in the present application.

Additionally, the ADS filed with the present petition improperly claims benefit to the PCT application as a foreign priority claim, rather than a domestic benefit claim. Further, the application number of the foreign priority application is incorrectly identified as EP 0701660.1.

As to item (3), applicant has not provided a statement that the entire delay between the date the claim was due under 37 CFR §1.78(a)(2)(ii) and the date the claim was filed was unintentional.

Any questions concerning this matter may be directed to Anthony Smith at (571) 272-3298.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



Bryan Lin  
Legal Examiner  
PCT Legal Administration



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Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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Baker Donelson Bearman, Caldwell & Berkowitz, PC  
920 Massachusetts Ave, NW  
Suite 900  
Washington DC 20001

**MAILED**

**MAR 11 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of :  
OLENIK et al. :  
Application No.: 12/674,582 :  
Filed: February 22, 2010 : **DECISION ON PETITION**  
Attorney Docket No.: 2903925-228000 :  
For: THERMODYNAMICALLY STABLE :  
CRYSTAL MODIFICATION OF :  
2-({2-CHLORO-4-(METHYLSULFONYL)- :  
3-[(2,2,2-TRIFLUOROETHOXY)METHY :  
L :

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed February 17, 2011, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed nonprovisional application set forth in the Supplemental Application Data Sheet (ADS) filed concurrently with the instant petition.

The petition under 37 CFR 1.78(a)(3) is GRANTED.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed international application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those application filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the

claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional applications has been included in an application data sheet, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

*The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that any Filing Receipt includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.*

Any inquiries concerning this decision may be directed to Anthony Smith, Attorney Advisor, at (571) 272-3298. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to the appropriate Technology Center Art Unit for action on the amendment filed February 17, 2011, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application.



Bryan Lin  
PCT Legal Examiner  
Office of PCT Legal Administration



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**OLIFF & BERRIDGE, PLC**  
**P.O. BOX 320850**  
**ALEXANDRIA VA 22320-4850**

**MAILED**  
**APR 09 2012**  
**OFFICE OF PETITIONS**

In re Application of:  
Yuki Bisaiji  
Application No. 12/674,586  
Filed: March 3, 2010  
Attorney Docket No. 144551

: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed February 10, 2012, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PPH pilot program and petition to make special require:

1. The U.S. application is
  - a. a Paris Convention application which either
    - i. validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
  - b. a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
    - i. validly claims priority to an application filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
    - iii. contains no priority claim, or
  - c. a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
    - i. validly claims priority to an application filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
    - iii. contains no priority claim;

2. Applicant must submit a copy of:
  - a. The allowable/patentable claim(s) from the JPO application(s);
  - b. An English translation of the allowable/patentable claim(s) and
  - c. A statement that the English translation is accurate; (if the claims were published in a language other than English);
3. Applicant must:
  - a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s) and
  - b. Submit a claims correspondence table in English;
4. Examination of the U.S. application has not begun;
5. Applicant must submit:
  - a. A copy of all the office actions (which are relevant to patentability), excluding "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claim(s);
  - b. An English language translation of the JPO office action; and
  - c. A statement that the English translation is accurate (if the office actions are not in the English language);
6. Applicant must submit:
  - d. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
  - e. Copies of the documents cited in the JPO office action, except U.S. patents or U.S. patent application publications (unless already submitted in this application);

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Inquiries concerning this decision should be directed to Petitions Examiner Joan Olszewski at 571-272-7751.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

This application will be forwarded to the examiner for action on the merits commensurate with this decision once this application's formality reviews have been completed.

/dab/  
David Bucci  
Petitions Examiner  
Office of Petitions



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,591	02/22/2010	Takashi Ogawa	144525	7715
25944	7590	09/19/2011		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER CRONIN, STEPHEN K	
			ART UNIT 3747	PAPER NUMBER
			NOTIFICATION DATE 09/19/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com  
jarmstrong@oliff.com



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
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Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

OLIFF & BERRIDGE, PLC  
P.O. BOX 320850  
ALEXANDRIA VA 22320-4850

In re Application of	:	
<u>OGAWA, TAKASHI</u> , et al.	:	DECISION ON REQUEST TO
Application No. 12/674,591	:	PARTICIPATE IN PATENT
Filed: February 22, 2010	:	PCT/PROSECUTION HIGHWAY
Attorney Docket No. 144525	:	PROGRAM AND PETITION
For: CONTROL APPARTUS FOR INTERNAL	:	TO MAKE SPECIAL UNDER
COMBUSTION ENGINE	:	37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed August 24, 2011 to make the above-identified application special.

The request and petition are granted.

A grantable request to participate in the PPH pilot program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO/PCT application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions from each of the JPO/PCT application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

In light of the petition being properly submitted, the request to participate in the PPH program and the petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application. Upon completion of pre-examination processing, this application will be forwarded to an examiner for examination.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen at 571-272-4485. All other inquiries concerning the examination or status of the application should be directed to Stephen Cronin, SPE of Art Unit 3747, and 571-272-4536 for Class 701 and also accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

Petition is **granted**.

/Henry C. Yuen/

---

Henry C. Yuen, Special Programs Examiner  
Technology Center 3700 – Mechanical Engineering,  
Manufacturing and Products  
571-272-4856

Doc Code: PET.GREEN

Document Description: Petition for Green Tech Pilot

PTO/SB/420 (03-11)

## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket Number: **TMP-032** Application Number (if known): **12/674,687** Filing date: **May 15, 2010**

First Named Inventor: **Keita NAKASHIMA et al.**

Title: **GEAR BOX FOR WIND TURBINE GENERATOR AND WIND TURBINE GENERATOR**

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request.**

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirements for the Green Technology Pilot Program, if the Office determines that the claims are not obviously directed to a single invention. See Instruction Sheet.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: \_\_\_\_\_

Signature **/Kenneth M. Berner/** Date **November 16, 2011**

Name (Print/Typed) **Kenneth M. Berner** Registration Number **37,093**

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Instruction Sheet for  
Petition to Make Special Under the Green Technology Pilot Program**  
(Not to be Submitted to the USPTO)

***The following is a summary of the requirements (for more information see the notices (i) "Pilot Program for Green Technologies Including Greenhouse Gas Reduction," (ii) "Elimination of Classification Requirement in the Green Technology Pilot Program," and (iii) "Expansion and Extension of the Green Technology Pilot Program," available on the USPTO web site at [http://www.uspto.gov/patents/init\\_events/green\\_tech.jsp](http://www.uspto.gov/patents/init_events/green_tech.jsp)):***

- (1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371, irrespective of the filing date of the application. Reexamination proceedings are excluded from this pilot program.
- (2) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed.
- (3) The claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to: (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) green house gas emission reduction (see the eligibility requirements of sections II and III of the notice (i) cited above). The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview, and elect an invention that meets the eligibility requirements in section II or III of the notice (i) cited above.
- (4) The petition to make special must be timely filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen. Applicant should use form PTO/SB/420, which is available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site.
- (5) The petition to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.
- (6) The petition to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,687	05/15/2010	Keita Nakashima	TMP-032	8630
32628 7590 12/07/2011 KANESAKA BERNER AND PARTNERS LLP 1700 DIAGONAL RD SUITE 310 ALEXANDRIA, VA 22314-2848			EXAMINER	
			ART UNIT	PAPER NUMBER
			3745	
			MAIL DATE	DELIVERY MODE
			12/07/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

KANESAKA BERNER AND PARTNERS LLP  
1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA VA 22314-2848

In re Application of  
NAKASHIMA, KEITA et. al.  
Application No. 12/674,687  
Filed: May 15, 2010  
Attorney Docket No. TMP-032

:  
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:  
:  
DECISION ON PETITION  
TO MAKE SPECIAL UNDER  
THE GREEN TECHNOLOGY  
PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed November 16, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth in 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **granted**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within ONE (1) MONTH OR THIRTY (30) DAYS from the mail date of this decision, whichever is longer. No extension of this time limit can be granted under 37 CFR 1.136(a) or (b). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by

a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded “special” status.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen at 571-272-4856.

This application will be forwarded to the Technology Center Art Unit 3745 for action on the merits commensurate with this decision.

/Henry C. Yuen/

---

Henry C. Yuen  
Quality Assurance Specialist  
Technology Center TC 3700

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE KOREAN INTELLECTUAL PROPERTY OFFICE (KIPO) AND THE USPTO

Application No: 12/674,692 Filing date: February 23, 2010

First Named Inventor: Timothy D. Anderson

Title of the Invention: LED LIGHTING ASSEMBLY WITH LEDS HAVING DIFFERENT VIEWING ANGLES

THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EFSC/EFSC\\_HELP.HTML](http://www.uspto.gov/efsc/efs_help.html)

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

The corresponding PCT application number(s) is/are: PCT/US2008/079980

The international date of the corresponding PCT application(s) is/are: October 15, 2008

## I. List of Required Documents:

- a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)

☒ Is attached.

☐ Is not attached because the document is already in the U.S. application.

- b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).

☐ Is attached.

☒ Is not attached because the document is already in the U.S. application.

- c. English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

(continued)

Application No.:	12/674,692
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First Named inventor: Timothy D. Anderson

- d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

is attached



Has already been filed in the above-identified U.S. application on \_\_\_\_\_

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)



Are attached.

February 23, 2010

Have already been filed in the above-identified U.S. application on \_\_\_\_\_

## II. Claims Correspondence Table:

[illegible]

III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.

Signature

Name (Print/Typed) Aaron K. Nodolf

Date 2010/11/17

Registration Number 62,081

## PATENT COOPERATION TREATY

PCT/US2008/079980

From the INTERNATIONAL BUREAU

**PCT**NOTIFICATION CONCERNING  
TRANSMITTAL OF COPY OF INTERNATIONAL  
PRELIMINARY REPORT ON PATENTABILITY  
(CHAPTER I OF THE PATENT COOPERATION  
TREATY)(PCT Rule 44bis) Best & Friedrich LLP  
RECEIVED

To:

NODOLF, Aaron  
Michael Best & Friedrich LLP  
100 East Wisconsin Avenue, Suite 3300  
Milwaukee, WI 53202-4108  
ETATS-UNIS D'AMERIQUE

Date of mailing (day/month/year)

29 April 2010 (29.04.2010)

MAY 10 2010

Applicant's or agent's file reference

047177-9327

DOCKETING  
MILWAUKEE, WI

## IMPORTANT NOTICE

International application No.

PCT/US2008/079980

International filing date (day/month/year)

15 October 2008 (15.10.2008)

Priority date (day/month/year)

15 October 2007 (15.10.2007)

Applicant

HUSSMANN CORPORATION et al

The International Bureau transmits herewith a copy of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)

CITE REFERENCES ON  
RELATED APPLICATIONS?☒ Docketed on: 7-20-2010☐ No References CitedThe International Bureau of WIPO  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

Authorized officer

Nora Lindner

Facsimile No. +41 22 338 82 70

e-mail: pt11.pct@wipo.int

# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 047177-9327	<b>FOR FURTHER ACTION</b> See item 4 below	
International application No. PCT/US2008/079980	International filing date ( <i>day/month/year</i> ) 15 October 2008 (15.10.2008)	Priority date ( <i>day/month/year</i> ) 15 October 2007 (15.10.2007)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant HUSSMANN CORPORATION		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 4 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- |   |   |
|---|---|
| <input checked="" type="checkbox"/> Box No. I | Basis of the report   |
| <input type="checkbox"/> Box No. II           | Priority  |
| <input type="checkbox"/> Box No. III          | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability  |
| <input type="checkbox"/> Box No. IV           | Lack of unity of invention  |
| <input checked="" type="checkbox"/> Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> Box No. VI           | Certain documents cited   |
| <input type="checkbox"/> Box No. VII          | Certain defects in the international application  |
| <input type="checkbox"/> Box No. VIII         | Certain observations on the international application   |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland  Facsimile No. +41 22 338 82 70	Date of issuance of this report 20 April 2010 (20.04.2010)
	Authorized officer  <p style="text-align: center;">Nora Lindner</p> e-mail: pt11.pct@wipo.int

## PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:

NODOLF, Aaron

Michael Best & Friedrich LLP 100 East Wisconsin Avenue,  
Suite 3300 Milwaukee WIw 53202-4108 USA

PCT

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Date of mailing  
(day/month/year) **29 MAY 2009 (29.05.2009)**

Applicant's or agent's file reference  
047177-9327

## FOR FURTHER ACTION

See paragraph 2 below

International application No.

**PCT/US2008/079980**

International filing date (day/month/year)

**15 OCTOBER 2008 (15.10.2008)**

Priority date(day/month/year)

15 OCTOBER 2007 (15.10.2007)

International Patent Classification (IPC) or both national classification and IPC

**A47F 3/00(2006.01)i, H05B 33/00(2006.01)i**

Applicant

**Hussmann Corporation et al**

## 1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

## 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.  
For further options, see Form PCT/ISA/220.

## 3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/KR



Korean Intellectual Property Office  
Government Complex-Daejeon, 139  
Seonsa-ro, Seo-gu, Daejeon 302  
701 Republic of Korea  
Facsimile No. 82-42-472-7140

Date of completion of this opinion

27 MAY 2009 (27.05.2009)

Authorized officer

KWON, JANG SEOB

Telephone No.82-42-481-8178



**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

**PCT/US2008/079980**

**Box No. I Basis of this opinion**

1. With regard to the **language**, this opinion has been established on the basis of :
  - ☒ the international application in the language in which it was filed
  - ☐ a translation of the international application into \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b))
2. ☐ This opinion has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43bis.1(a))
3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material
    - ☐ a sequence listing
    - ☐ table(s) related to the sequence listing
  - b. format of material
    - ☐ on paper
    - ☐ in electronic form
  - c. time of filing/furnishing
    - ☐ contained in the international application as filed.
    - ☐ filed together with the international application in electronic form.
    - ☐ furnished subsequently to this Authority for the purposes of search.
4. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
5. Additional comments:

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
**PCT/US2008/079980**

**Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

**1. Statement**

Novelty (N)	Claims	1-25	YES
	Claims	none	NO
Inventive step (IS)	Claims	1-25	YES
	Claims	none	NO
Industrial applicability (IA)	Claims	1-25	YES
	Claims	none	NO

**2. Citations and explanations :**

Reference is made to the following documents:

D1: JP 2002-147945 A (Nakano Refrigerators, Inc.) 22 MAY 2002

D2: JP 2007-229352 A (GAC, Inc.) 13 SEP. 2007

D3: JP 2006-230896 A (TOYODA GOSEI CO. LTD.) 7 SEP. 2006

**1. Novelty and Inventive Step**

The subject matter of claim 1 differs from these prior art documents in that the light assembly includes a first LED having a first viewing angle and a second LED having a second viewing angle that is smaller than the first viewing angle. And it is not obvious to a person skilled in the art by the documents, taken alone or in combination. Therefore, claim 1 meets the requirements of PCT Article 33(2) and (3) with respect to novelty and inventive step.

Claims 2-11 are dependant on claim 1 and therefore meet the requirements of PCT Article 33(2) and (3).

The subject matter of claim 12 differs from these prior art documents in that the light assembly includes a first LED having a first viewing angle and a second LED having a second viewing angle that is different from the first viewing angle. And it is not obvious to a person skilled in the art by the documents, taken alone or in combination. Therefore, claim 12 meets the requirements of PCT Article 33(2) and (3) with respect to novelty and inventive step.

Claims 13-25 are dependant on claim 12 and therefore meet the requirements of PCT Article 33(2) and (3).

**2. Industrial Applicability**

1-

Claims 1-25 are industrially applicable under PC1-T Article 33(4).



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,692	02/23/2010	Timothy D. Anderson	047177-9327-01	8670
23409 7590 01/25/2011 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202			EXAMINER	
			ART UNIT	PAPER NUMBER
			2875	
			MAIL DATE	DELIVERY MODE
			01/25/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**MICHAEL BEST & FRIEDRICH LLP**  
**100 E WISCONSIN AVENUE**  
**Suite 3300**  
**MILWAUKEE WI 53202**

**In re Application of**  
**Timothy D. ANDERSON**  
**Application No.: 12/674,692**  
**Filed: 23 February 2010**  
**Attorney Docket No.: 047177-9327-01**  
**For: LED LIGHTING ASSEMBLY**  
**WITH LEDS HAVING DIFFERENT**  
**VIEWING ANGLES**

**: DECISION ON REQUEST TO**  
**: PARTICIPATE IN THE PATENT**  
**: PROSECUTION HIGHWAY**  
**: PROGRAM AND PETITION**  
**: TO MAKE SPECIAL UNDER**  
**: 37 CFR 1.102(a)**

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed 17 November 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, KIPO, or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;

(6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate if the latest international work product is not in the English language;

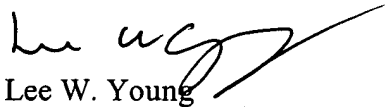
(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PCT-PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Lee W. Young at 571-272-4549.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

This application will be forwarded to the examiner for action on the merits commensurate with this decision once this application's formality reviews have been completed.



Lee W. Young  
TQAS Technology Center 2800 - Semiconductors,  
Electrical & Optical Systems & Components



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The Procter & Gamble Company  
Global Legal Department - IP  
Sycamore Building - 4th Floor  
299 East Sixth Street  
Cincinnati OH 45202

**MAILED**  
**DEC 03 2010**  
**PCT LEGAL ADMINISTRATION**

In re Application of :  
KLOPPPEL-RIECH et al. :  
Application No.: 12/674,732 :  
PCT No.: PCT/EP2008/006131 :  
Int. Filing Date: 25 July 2008 :  
Priority Date: 27 July 2007 :  
Attorney Docket No.: Z08079Q :  
For: HAIR CARE DEVICE WITH FUNCTION :  
HEAD :

**DECISION ON PETITION  
UNDER 37 CFR 1.137(b)**

The petition to revive under 37 CFR 1.137(b) filed 23 February 2010 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicants have submitted the basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3298  
Fax: (571) 273-0459

Doc Code: PET.GREEN

Document Description: Petition for Green Tech Pilot

PTO/SB/420 (03-11)

## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket Number: <b>TMP-035</b>	Application Number (if known): <b>12/674,758</b>	Filing date: <b>May 18, 2010</b>
--	--	----------------------------------

First Named Inventor: **Tohru MINAMI et al.**

Title: **HANDY TERMINAL FOR WIND TURBINE GENERATOR AND WIND TURBINE GENERATOR**

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request.**

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirements for the Green Technology Pilot Program, if the Office determines that the claims are not obviously directed to a single invention. See Instruction Sheet.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: \_\_\_\_\_

Signature <b>/Kenneth M. Berner/</b>	Date <b>November 16, 2011</b>
--------------------------------------	-------------------------------

Name (Print/Typed) <b>Kenneth M. Berner</b>	Registration Number <b>37,093</b>
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**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Instruction Sheet for  
Petition to Make Special Under the Green Technology Pilot Program**  
(Not to be Submitted to the USPTO)

***The following is a summary of the requirements (for more information see the notices (i) "Pilot Program for Green Technologies Including Greenhouse Gas Reduction," (ii) "Elimination of Classification Requirement in the Green Technology Pilot Program," and (iii) "Expansion and Extension of the Green Technology Pilot Program," available on the USPTO web site at [http://www.uspto.gov/patents/init\\_events/green\\_tech.jsp](http://www.uspto.gov/patents/init_events/green_tech.jsp)):***

- (1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371, irrespective of the filing date of the application. Reexamination proceedings are excluded from this pilot program.
- (2) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed.
- (3) The claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to: (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) green house gas emission reduction (see the eligibility requirements of sections II and III of the notice (i) cited above). The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview, and elect an invention that meets the eligibility requirements in section II or III of the notice (i) cited above.
- (4) The petition to make special must be timely filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen. Applicant should use form PTO/SB/420, which is available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site.
- (5) The petition to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.
- (6) The petition to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,758	05/18/2010	Tohru Minami	TMP-035	9110
<div>32628      7590      12/14/2011</div> <div>KANESAKA BERNER AND PARTNERS LLP</div> <div>1700 DIAGONAL RD</div> <div>SUITE 310</div> <div>ALEXANDRIA, VA 22314-2848</div>				
			<div>EXAMINER</div> <div>GONZALEZ, JULIO C</div>	
			<div>ART UNIT</div> <div>2839</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>12/14/2011</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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KANESAKA BERNER AND PARTNERS LLP  
1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA VA 22314-2848

DEC 14 2011

In re Application of	:	
MINAMI et al.	:	DECISION ON PETITION
Application No. 12/674,758	:	TO MAKE SPECIAL UNDER
Filed: May 18, 2010	:	THE GREEN TECHNOLOGY
Attorney Docket No. TMP-035	:	PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed on November 16, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded “special” status.

Telephone inquiries concerning this decision should be directed to Colleen Dunn at 571-272-1170.

The application is being forwarded to the appropriate Technology Center Art Unit for action on the merits commensurate with this decision.

/Colleen Dunn/

---

Colleen Dunn  
TQAS, TC 2800



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2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

**MAILED**  
**APR 09 2012**  
**OFFICE OF PETITIONS**

In re Application of	:
Akio Kumagai, et. al.	: DECISION ON REQUEST TO
Application No.: 12/674,788	: PARTICIPATE IN THE PATENT
Filed: February 23, 2010	: PROSECUTION HIGHWAY
Attorney Docket No.: Q117371	: PROGRAM AND PETITION
For: FUEL VISCOSITY DETECTION	: TO MAKE SPECIAL UNDER
APPARATUS	: 37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed October 24, 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PPH pilot program and petition to make special require:

1. The U.S. application is

- a. a Paris Convention application which either
  - i. validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO, or
  - ii. validly claims priority to a PCT application that contains no priority claims, or
- b. a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
  - i. validly claims priority to an application filed in the JPO, or
  - ii. validly claims priority to a PCT application that contains no priority claims, or
  - iii. contains no priority claim, or
- c. a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
  - i. validly claims priority to an application filed in the JPO, or

- ii. validly claims priority to a PCT application that contains no priority claims,  
or
  - iii. contains no priority claim;
- 2. Applicant must:
  - a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s) and
  - b. Submit a claims correspondence table in English;
- 3. Examination of the U.S. application has not begun;
- 4. Applicant must submit:
  - a. Documentation of prior office action:
    - i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claim(s) or
    - ii. if the allowable/patentable claims(s) are from a "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
    - iii. if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form;
  - b. An English language translation of the JPO Office action from (5)(a)(i)-(ii) above
- 5. Applicant must submit:
  - a. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
  - b. Copies of the documents except U.S. patents or U.S. patent application publications (unless already submitted in this application);

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-3226. All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

This application will be forwarded to the examiner for action on the merits commensurate with this decision.

/Andrea Smith/  
Andrea Smith  
Petitions Examiner  
Office of Petitions



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Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450

**MAILED**

**DEC 21 2011**

**OFFICE OF PETITIONS**

**KANESAKA BERNER AND PARTNERS LLP  
1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA VA 22314-2848**

In re Application of : DECISION ON REQUEST TO  
Shinji ARINAGA et al. : PARTICIPATE IN PPH PROGRAM  
Application No. 12/674,873 : AND PETITION TO MAKE SPECIAL  
Filed: March 23, 2010 : UNDER 37 CFR 1.102(a)  
Atty. Docket No.: OLI-116 :  
For: WIND-POWER GENERATION SYSTEM AND OPERATION CONTROL  
METHOD THEREOF

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed November 10, 2011 to make the above-identified application special.

The petition is **GRANTED**.

A grantable request to participate in the PPH (patent prosecution highway) program and petition to make special require:

(1) the U.S. application is a Paris Convention application which either validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO (Japanese Patent Office) or claims priority to a PCT application that contains no priority claims. Alternatively, it can be a national stage application under the PCT which validly claims priority to an application filed in the JPO or claims priority to a PCT application that contains no priority claims. It can also be a "bypass application" filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application validly claims priority to an application filed in the JPO or claims priority to a PCT application that contains no priority claims, or contains no priority claim;

(2) applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;

(3) all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);

(4) examination of the U.S. application has not begun;

(5) applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowability/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;

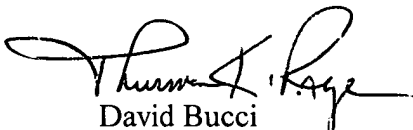
(6) applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Robert DeWitty, Petition Attorney, Office of Petitions at 571-272-8427.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

This application will be forwarded to Technology Center Art Unit 2121 for action on the merits commensurate with this decision once this application's formality reviews have been completed.

  
David Bucci  
Petitions Examiner  
Office of Petitions



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**AUG 31 2011**

**PCT LEGAL ADMINISTRATION**

FAEGRE & BENSON LLP  
PATENT DOCKETING - INTELLECTUAL PROPERTY  
2200 WELLS FARGO CENTER  
90 SOUTH SEVENTH STREET  
MINNEAPOLIS MN 55402-3901

In re Application of :  
John Krümme et al : DECISION ON RENEWED  
Application No: 12/674,891 :  
PCT No.: PCT/US2008/073807 :  
Int. Filing Date: 21 August 2008 : PETITION UNDER  
Priority Date: 24 August 2007 :  
Attorney's Docket No.: 25764 :  
For: BONE ANCHOR...ANCHOR IN BONE : 37 CFR 1.47(a)

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.47(a) and SUBMISSION OF SUPPLEMENTAL DECLARATION," filed on 20 June 2011 and 20 July 2011, respectively, which is being treated as a supplemental petition under 37 CF 1.47(a).

**BACKGROUND**

On 23 February 2010, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee. No executed oath or declaration from the inventors accompanied the Transmittal Letter at such time.

On 19 November 2010, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905).

On 20 June 2011, petitioner filed the petition under 37 CFR 1.47(a) accompanied, inter alia, an executed Declaration without the signature of co-inventor Mr. Dennis McDevitt.

On 20 July 2011, petitioner filed this supplemental petition accompanied, inter alia, an executed declaration that includes the signature of the previous non-signing co-inventor Dennis McDevitt

**DISCUSSION**

The renewed filing includes a declaration executed by the previously non-signing inventor Dennis McDevitt. As such the declaration is now signed by all the co-inventors.

Accordingly, the declaration complies with 37 CFR 1.497(a) and (b).

Accordingly, the declaration complies with 37 CFR 1.497(a) and (b).

**CONCLUSION**

The petition under 37 CFR 1.47(a) is **MOOT**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing consistent with this decision.



Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Telephone: (571) 272-3276  
Facsimile: (571) 273-0459

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE EUROPEAN PATENT OFFICE (EPO) AND THE USPTO

Application No:	12/674,908	Filing date:	May 23, 2011
First Named Inventor:	Valere Logel		
Title of the Invention:	VIAL		

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBS/DFS\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/EP2008/061219 (WO 2009/030616)

**The international filing date of the corresponding PCT application(s) is/are:** August 27, 2008

## I. List of Required Documents:

- a. **A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**

☐

Is attached

☒

Is not attached because the document is already in the U.S. application.

- b. **A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**

☐

Is attached.

☒

Is not attached because the document is already in the U.S. application.

- c. **English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM  
BETWEEN THE EPO AND THE USPTO**

(continued)

Application No.: 12/674,908

First Named Inventor: Valere Logel

- d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

☐

Is attached

☒

Has already been filed in the above-identified U.S. application on

February 26, 2010

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)

☐

Are attached.

☒

Have already been filed in the above-identified U.S. application on

February 26, 2010

**II. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
1	1	Substantially the same and sufficiently correspond
2	2	Substantially the same and sufficiently correspond
3	3	Substantially the same and sufficiently correspond
4	4	Substantially the same and sufficiently correspond
5	5	Substantially the same and sufficiently correspond
6	6	Substantially the same and sufficiently correspond
7	7	Substantially the same and sufficiently correspond
8	8	Substantially the same and sufficiently correspond
9	9	Substantially the same and sufficiently correspond
10	10	Substantially the same and sufficiently correspond
11	11	Substantially the same and sufficiently correspond
12	12	Substantially the same and sufficiently correspond
13	13	Substantially the same and sufficiently correspond
14	14	Substantially the same and sufficiently correspond
15	15	Substantially the same and sufficiently correspond
16	16	Substantially the same and sufficiently correspond
17	17	Substantially the same and sufficiently correspond
18	18	Substantially the same and sufficiently correspond
19	19	Substantially the same and sufficiently correspond

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature /Scott R. Cox/	Date June 30, 2011
Name (Print/Typed) Scott R. Cox	Registration Number 31,945

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant ( i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,908	05/23/2011	Valere Logel	P-1502	1459
68072 7590 07/12/2011				
SCOTT R. COX				
LYNCH, COX, GILMAN & MAHAN, P.S.C.				
500 WEST JEFFERSON STREET				
SUITE 2100				
LOUISVILLE, KY 40202				
EXAMINER				
ART UNIT PAPER NUMBER				
3728				
NOTIFICATION DATE DELIVERY MODE				
07/12/2011 ELECTRONIC				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SCOX@LCGANDM.COM  
HHART@LCGANDM.COM  
KWATKINS@LCGANDM.COM



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Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

SCOTT R. COX  
LYNCH, COX, GILMAN & MAHAN, P.S.C. 500 WEST JEFFERSON STREET  
SUITE 2100  
LOUISVILLE, KY 40202

*In re* Application of:  
Logel, Valerie.  
Serial No.: 12/674908  
Filed: May 23, 2011  
Attorney Docket No. : P-1502  
Title: VIAL

:  
: DECISION ON A REQUEST TO  
: PARTICIPATE IN PATENT  
: PCT/PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed June 30, 2011 to make the above-identified application special.

The request and petition are **granted**.

A grantable request to participate in the PPH pilot program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more PCT applications filed in the JPO, EPO, KIPO, or USPTO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the PCT application(s) latest international work product (the written opinion or the IPER) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the PCT application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of the latest international work product from the PCT application containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

In light of the petition being properly submitted, the request to participate in the PPH program and the petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application.

Response must be filed via EFS-Web. Telephone inquiries concerning this decision should be directed to Henry C. Yuen, at 571-272-4856.

Petition is **granted**.

/Henry C. Yuen/

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Henry C. Yuen  
Special Programs Examiner  
Technology Center 3700  
Tel: 571-272-4856



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GORDON & JACOBSON, P.C.  
60 LONG RIDGE ROAD  
SUITE 407  
STAMFORD CT 06902

**MAILED**

**AUG 16 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of  
EVANS, et al.  
U.S. Application No.: 12/674,917  
PCT No.: PCT/GB2008/002817  
Int. Filing Date: 20 August 2008  
Priority Date: 24 August 2007  
Attorney's Docket No.: UDL-170  
For: EXERCISE APPARATUS

DECISION ON PETITION  
UNDER 37 CFR 1.182

This decision is in response to applicant's correspondence filed 22 June 2011 in the United States Patent and Trademark Office (USPTO) requesting a corrected Official Filing Receipt and Notice of Acceptance. For the reasons discussed below the "CORRECTION OF TYPOGRAPHICAL ERROR IN INVENTOR'S NAME" filed 24 February 2010 is being treated as a petition under 37 CFR 1.182. As authorized, the \$400.00 petition fee will be charged to deposit account number 07-1732.

### **BACKGROUND**

On 23 February 2011, applicant was mailed a "Notice of Acceptance" (Form PCT/DO/EO/903) and Official Filing Receipt. Both documents listed the international application filing date as 20 July 2008.

On 22 June 2011, applicant filed a request for corrected filing receipt and notice of acceptance and a substitute declaration. A review of the application file resulted in the discovery of applicant's letter of 24 February 2010 regarding the correct name of the second listed inventor, Richard Jones. This letter is being treated as a petition under 37 CFR 1.182.

### **DISCUSSION**

§ 201.03 of the Manual of Patent Examining Procedure (MPEP) states that, "Where a typographical or transliteration error in the spelling of an inventor's name is discovered, the Office should simply be notified of the error. A new oath or declaration is not required. Reference to the notification will be made on the previously filed oath or declaration."

In the present case, the error (Richard Jones BASS versus Richard JONES) can not be classified as a mere typographical or transliteration error of the spelling of the inventor's name, as such, a petition under 37 CFR 1.182 to excuse the error is required. Applicant has provided a statement from counsel detailing the error and confirming that the true name of the inventor is

that which appears on the filed declaration. As such, it is proper to grant applicant's petition at this time.

Further to applicant's request for a corrected notice of acceptance, a review of the application file confirms that the international filing date of international application PCT/GB2008/002817 is 20 August 2008. Therefore, the issuance of a corrected Form PCT/DO/EO/903 is proper. It is noted that a corrected Official Filing Receipt was mailed 23 June 2011.

### **CONCLUSION**

The petition under 37 CFR 1.182 to change the inventor's name from Richard Jones BASS to Richard JONES is **GRANTED**.

The application has an international filing date of 20 August 2008 under 35 U.S.C. 363 and a date of **24 February 2010** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

The Form PCT/DO/EO/903 mailed 23 February 2011 indicating an international filing date of 20 July 2008 is hereby **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing; including the issuance of a new Form PCT/DO/EO/903 showing an international filing date of 20 August 2008.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,923	03/22/2010	Hiroshi Ugajin	IWI-19821	1530

7609 7590 01/20/2011

RANKIN, HILL & CLARK LLP  
23755 Lorain Road - Suite 200  
North Olmsted, OH 44070-2224

EXAMINER
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ART UNIT	PAPER NUMBER
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1736

MAIL DATE	DELIVERY MODE
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01/20/2011

PAPER

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The time period for reply, if any, is set in the attached communication.



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BC

January 20, 2011

In re application of	:	DECISION ON REQUEST TO
Hiroshi Ugajin et al.	:	PARTICIPATE IN PATENT
Serial No. 12/674,923	:	PROSECUTION HIGHWAY
Filed: February 24, 2010	:	PROGRAM AND
For: MOLECULE RECOGNIZING MATERIAL :	:	PETITION TO MAKE SPECIAL
AND PROCESS FOR PRODUCING THE	:	UNDER 37 CFR 1.102(a)
MOLECULE RECOGNIZING MATERIAL	:	

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed October 26, 2010, to make the above-identified application special.

The request and petition are **DISMISSED**.

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;
- (6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof if the latest international work

Application No. 12/674,923

product is not in the English language; and

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

Conditions (1) and (3-7) above are considered to have been met. However, the request to participate in the PPH pilot program and petition fails meet condition (2). Regarding the requirement of condition (2), the IPEA/409 contains a negative opinion under inventive step for all of the claims.

Applicant is given **ONE** opportunity within a time period of **ONE MONTH or THIRTY DAYS**, whichever is longer, from the mailing date of this decision to correct the deficiencies. **NO EXTENSION OF TIME UNDER 37 CFR 1.136 IS PERMITTED.** If the deficiencies are not corrected with the time period given, the application will await action in its regular turn.

Response must be filed via the Electronic Filing System (EFS). Any preliminary amendments and IDS submitted with the PPH documents must be separately indexed as a preliminary amendment and IDS, respectively.

Any inquiry regarding this decision should be directed to Blaine Copenheaver, Quality Assurance Specialist, at (571) 272-1156.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Blaine Copenheaver/

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Blaine Copenheaver  
Quality Assurance Specialist  
Technology Center 1700



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,923	03/22/2010	Hiroshi Ugajin	IWI-19821	1530
7609 7590 03/29/2011 RANKIN, HILL & CLARK LLP 23755 Lorain Road - Suite 200 North Olmsted, OH 44070-2224			EXAMINER	
			ART UNIT	PAPER NUMBER
			1736	
			MAIL DATE	DELIVERY MODE
			03/29/2011	PAPER

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The time period for reply, if any, is set in the attached communication.



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[www.uspto.gov](http://www.uspto.gov)

March 29, 2011

BC

In re application of	:	DECISION ON REQUEST TO
Hiroshi Ugajin et al.	:	PARTICIPATE IN PATENT
Serial No. 12/674,923	:	PROSECUTION HIGHWAY
Filed: February 24, 2010	:	PROGRAM AND
For: MOLECULE RECOGNIZING MATERIAL :	:	PETITION TO MAKE SPECIAL
AND PROCESS FOR PRODUCING THE	:	UNDER 37 CFR 1.102(a)
MOLECULE RECOGNIZING MATERIAL	:	

This is a decision on the request for reconsideration to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a) to make the above-identified application special filed February 21, 2011.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO, note where the JPO application with similar claims is not the same application from which the U.S. application claims priority that the applicant must identify the relationship between the JPO application with similar claims and the JPO priority application;

(2) Applicant must submit a copy of:

- a. The allowable/patentable claim(s) from the JPO application(s) or if a copy of the allowable/patentable claims is available via the Dossier Access System (DAS) applicant may request the USPTO to obtain a copy from DAS; however, if the USPTO is unable to obtain a copy from the DAS, the applicant will be required to submit a copy;
- b. An English translation of the allowable/ patentable claim(s), if applicable; and
- c. A statement that the English translation is accurate, if applicable;

(3) Applicant must:

- a. Ensure all the independent claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s); and
- b. Submit a claims correspondence table in English;

(4) Examination of the U.S. application has not begun;

(5) Applicant must submit:

Application No. 12/674,923

- a. Documentation of prior office action:
  - i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claims(s) or
  - ii. if the allowable/patentable claim(s) are from "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
  - iii. if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form;Further, if a copy of the documents from (i) or (ii) is available via the Dossier Access System (DAS), applicant may request the USPO obtain a copy from the DAS; however, if the USPTO is unable to obtain a copy of the DAS, the applicant will be required to submit a copy; and
- b. An English language translation of the JPO Office action from (5)(a)(i)-(ii) above if applicable; and

(6) Applicant must submit:

- a. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
- b. Copies of documents except U.S. patents or U.S. patent application publications (unless already submitted in this application).

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Blaine Copenheaver, Quality Assurance Specialist, at (571) 272-1156.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/eac/index.html>.

/Blaine Copenheaver/

---

Blaine Copenheaver  
Quality Assurance Specialist  
Technology Center 1700

Doc Code: PET.GREEN

Document Description: Petition for Green Tech Pilot

PTO/SB/420 (12-09)

Approved for use through 05/31/2010. OMB 0651-0062

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

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## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket  
Number: KUD-032

Application Number  
(if known): 12/674,924

Filing date: February 24, 2010

First Named  
Inventor: Yasuto FUJINO et al.

Title: WIND TURBINE GENERATOR AND NACELLE TURNING METHOD

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request. Applicant hereby rescinds under 37 CFR 1.213(b) any previous filed request that the above-identified application not be published under 35 U.S.C. 122(b).**

**If the application has been published, the petition must still be accompanied by the publication fee set forth in 37 CFR 1.18(d) and a statement that the application has been published.**

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirement and classification requirement set forth in the notice entitled "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" that was published in the Federal Register if the Office determines that the claims are not obviously directed to a single invention.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: \_\_\_\_\_

Signature /Kenneth M. Berner/

Date March 11, 2011

Name  
(Print/Typed) Kenneth M. Berner

Registration Number 37,093

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Instruction Sheet for  
Petition to Make Special Under the Green Technology Pilot Program**  
(Not to be Submitted to the USPTO)

***The following is a summary of the requirements (for more information see notice "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/oqsheet.html>):***

- (1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371. The application must be previously filed before the publication date of the notice cited above. Reexamination proceedings are excluded from this pilot program.
- (2) The application must be classified in one of the U.S. classifications listed in section VI of the notice cited above at the time of examination.
- (3) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed.
- (4) The claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to: (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) green house gas emission reduction (see the eligibility requirements of sections II and III of the notice cited above). The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview, and elect an invention that meets the eligibility requirements in section II or III of the notice cited above and is classified in one of the U.S. classifications listed in section VI of the notice cited above.
- (5) The petition to make special must be timely filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen. Applicant should use form PTO/SB/420, which will be available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site.
- (6) The petition to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.
- (7) The petition to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,924	08/21/2010	Yasuto Fujino	KUD-032	1531
32628 7590 10/26/2011 KANESAKA BERNER AND PARTNERS LLP 1700 DIAGONAL RD SUITE 310 ALEXANDRIA, VA 22314-2848			EXAMINER	
			ART UNIT	PAPER NUMBER
			2839	
			MAIL DATE	DELIVERY MODE
			10/26/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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KANESAKA BERNER AND PARTNERS LLP  
1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA VA 22314-2848

In re Application of	:	
Fujino et al.	:	DECISION ON PETITION
Application No. 12/674,924	:	TO MAKE SPECIAL UNDER
Filed: August 21, 2010	:	THE GREEN TECHNOLOGY
Attorney Docket No. KUD-032	:	PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed on March 11, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

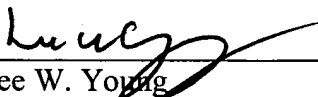
In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Lee W. Young at 571-272-4549.

The application is being forwarded to the Technology Center Art Unit 2839 for action on the merits commensurate with this decision.

  
\_\_\_\_\_  
Lee W. Young  
Quality Assurance Specialist  
Technology Center 2600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,942	02/24/2010	Takayuki Takahashi	HOK-0509	1680
74384	7590	05/11/2011	EXAMINER	
Cheng Law Group, PLLC 1100 17th Street, N.W. Suite 503 Washington, DC 20036			ART UNIT	PAPER NUMBER
			3656	
			MAIL DATE	DELIVERY MODE
			05/11/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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Cheng Law Group, PLLC  
1100 17th Street, N.W.  
Suite 503  
Washington DC 20036

In re application of  
Takahashi et al.  
Application No. 12/674,942  
Filed: February 24, 2010  
For: MODIFIED CROWN REDUCTION  
GEAR

: **DECISION ON REQUEST TO**  
: **PARTICIPATE IN PATENT**  
: **PROSECUTION HIGHWAY**  
: **PROGRAM AND PETITION**  
: **TO MAKE SPECIAL UNDER**  
: **37 CFR 1.102(a)**

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed February 25, 2011 to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications filed in the KIPO or USPTO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the PCT application(s) latest international work product (the written opinion or the IPER) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the PCT application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of the latest international work product from the PCT application containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
- (6) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

In light of the petition being properly submitted via EFS-Web as is required, the request to participate in the PPH program complies with the above requirements, the above-identified application has been accorded "special" status.

All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision as soon as any pre-exam processing has been completed.

Any inquiry regarding this decision should be directed to Mikado Buiz, Quality Assurance Specialist, at (571) 272-6578.

/ Mikado Buiz /

Mikado Buiz,  
Quality Assurance Specialist  
Technology Center 3600

MB/MB: 05/10/11

Doc code : PET.OP.AGE

Description : Petition to make special based on Age/Health

PTO/SB/130 (07-09)

Approved for use through 07/31/2012. OMB 0651- 0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number

PETITION TO MAKE SPECIAL BASED ON AGE FOR ADVANCEMENT OF EXAMINATION UNDER 37 CFR 1.102(c)(1)					
Application Information					
Application Number	12/674,948	Confirmation Number	1698	Filing Date	2010-02-24
Attorney Docket Number (optional)	105017	Art Unit	2858	Examiner	Johali Torres Ruiz
First Named Inventor	Chun-Kil JUNG				
Title of Invention	NON-CONTACT CHARGING STATION WITH POWER TRANSMISSION PLANAR SPIRAL CORE, NON-CONTACT POWER-RECEIVING APPARATUS, AND METHOD FOR CONTROLLING THE SAME				
<b>Attention: Office of Petitions</b> An application may be made special for advancement of examination upon filing of a petition showing that the applicant is 65 years of age, or more. No fee is required with such a petition. See 37 CFR 1.102(c)(1) and MPEP 708.02 (IV).  APPLICANT HEREBY PETITIONS TO MAKE SPECIAL FOR ADVANCEMENT OF EXAMINATION IN THIS APPLICATION UNDER 37 CFR 1.102(c)(1) and MPEP 708.02 (IV) ON THE BASIS OF THE APPLICANT'S AGE.  A grantable petition requires one of the following items: (1) Statement by one named inventor in the application that he/she is 65 years of age, or more; or (2) Certification by a registered attorney/agent having evidence such as a birth certificate, passport, driver's license, etc. showing one named inventor in the application is 65 years of age, or more.					
<b>Name of Inventor who is 65 years of age, or older</b>					
Given Name	Middle Name	Family Name	Suffix		
Chun-Kil		JUNG			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the format of the signature.  Select (1) or (2) :					
<input type="radio"/> (1) I am an inventor in this application and I am 65 years of age, or more.					
<input checked="" type="radio"/> (2) I am an attorney or agent registered to practice before the Patent and Trademark Office, and I certify that I am in possession of evidence, and will retain such in the application file record, showing that the inventor listed above is 65 years of age, or more.					
Signature	/K. Kevin Mun/		Date (YYYY-MM-DD)	2012-02-22	
Name	K. Kevin Mun		Registration Number	50585	

## Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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In re Application of  
Chun-Kil Jung

Application No. 12674948

Filed: February 24, 2010

Attorney Docket No. 105017

:  
:

:DECISION ON PETITION TO MAKE SPECIAL  
:UNDER 37 CFR 1.102(c)(1)  
:

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1), filed 22-FEB-2012 to make the above-identified application special based on applicant's age as set forth in MPEP § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1), MPEP § 708.02, Section IV: Applicant's Age must include a statement by applicant or a registered practitioner having evidence that applicant is at least 65 years of age. No fee is required.

Accordingly, the above-identified application has been accorded "special" status and will be taken up for action by the examiner upon the completion of all pre-examination processing.

Telephone inquiries concerning this electronic decision should be directed to the Electronic Business Center at 866-217-9197.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.



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DEC 13 2010

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PCT LEGAL ADMINISTRATION

RENNER OTTO BOISSELLE & SKLAR, LLP  
1621 EUCLID AVENUE  
NINETEENTH FLOOR  
CLEVELAND OH 44115

In re Application of	:	
GABRIELSEN et al.	:	
Application No.: 12/674,996	:	DECISION
PCT No.: PCT/US2008/074022	:	
Int. Filing Date: 22 August 2008	:	
Priority Date: 24 August 2007	:	
Attorney Docket No.: RANPP0398USA	:	
For: DUNNAGE CONVERSION SYSTEM AND	:	
METHOD WITH IMPROVED STOCK MATERIAL	:	
SPLICING	:	

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 24 February 2010 in the United States Patent and Trademark Office (USPTO). The petition is **DISMISSED** without prejudice.

### **BACKGROUND**

On 22 August 2008, applicants filed international application PCT/US2008/074022, which designated the United States and claimed a priority date of 24 August 2007. A copy of the international application was communicated from the International Bureau to the USPTO on 05 March 2009. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 February 2010.

On 24 February 2010, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, a copy of a declaration of inventors, and the instant petition under 37 CFR 1.47(a).

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or

cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee of \$200 has been charged to Deposit Account 180988.

Item (2) has not been met. The statement of facts by Samantha Price indicates that she spoke to William S. Chapnick on 21 August 2008 and Mr. Chapnick indicated that he did not want to sign until his attorney had an opportunity to review the application. The petition was filed 18 months later, however, no indication is given as to whether Mr. Chapnick was contacted again to determine whether his attorney had reviewed the application and/or whether Mr. Chapnick was now willing to sign.

Item (3) has been satisfied.

Item (4) has not been satisfied. The specification to which the declaration is directed has not been adequately identified. The declaration indicates that it is executing the specification of which "is attached hereto". However, a specification was not filed with the declaration. MPEP § 602, item VI, A. Additionally, the declaration appears to be a copy of the declaration filed in the international phase of PCT/US2008/074022. This declaration was also filed without an accompanying specification.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

### CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT

Application No.: 12/674,996

-3-

Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301



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PCT LEGAL ADMINISTRATION

RENNER OTTO BOISSELLE & SKLAR, LLP  
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CLEVELAND OH 44115

In re Application of  
GABRIELSEN et al.  
Application No.: 12/674,996  
PCT No.: PCT/US2008/074022  
Int. Filing Date: 22 August 2008  
Priority Date: 24 August 2007  
Attorney Docket No.: RANPP0398USA  
For: DUNNAGE CONVERSION SYSTEM AND  
METHOD WITH IMPROVED STOCK MATERIAL  
SPLICING

DECISION

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 13 July 2011 in the United States Patent and Trademark Office (USPTO). The petition is **GRANTED**.

**BACKGROUND**

On 22 August 2008, applicants filed international application PCT/US2008/074022, which designated the United States and claimed a priority date of 24 August 2007. A copy of the international application was communicated from the International Bureau to the USPTO on 05 March 2009. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 February 2010.

On 24 February 2010, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, a copy of a declaration of inventors, and a petition under 37 CFR 1.47(a).

On 13 December 2010, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.47(a).

On 13 July 2011, applicants filed the instant renewed petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a five-month extension of time and a second statement of facts by Samantha Price with documentation in support thereof.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As noted in the decision mailed 13 December 2010, items (1) and (3) have been met.

Item (2) has now been met. It has been established that non-signing inventor William S. Chapnick was presented with the application papers. Mr. Chapnick's conduct constitutes a refusal to sign.

Item (4) has now been satisfied as well.

### **CONCLUSION**

For the reasons set forth above, applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to each of the non-signing inventors at their respective last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date and a 35 U.S.C. 371 date of **13 July 2011**.

/Daniel Stemmer/

Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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MAILED

OCT 03 2011

PCT LEGAL ADMINISTRATION

William S. Chapnick  
6619 Angela Court  
Solon, OH 44139

In re Application of  
GABRIELSEN et al.  
Application No.: 12/674,996  
PCT No.: PCT/US2008/074022  
Int. Filing Date: 22 August 2008  
Priority Date: 24 August 2007  
Attorney Docket No.: RANPP0398USA  
For: DUNNAGE CONVERSION SYSTEM AND METHOD WITH IMPROVED STOCK  
MATERIAL SPLICING

Dear Mr. Chapnick:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/Daniel Stemmer/

Daniel Stemmer  
PCT Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301

RENNER OTTO BOISSELLE & SKLAR, LLP  
1621 EUCLID AVENUE  
NINETEENTH FLOOR  
CLEVELAND OH 44115

**Doc Code: PET.GREEN**

**Document Description: Petition for Green Tech Pilot**

PTO/SB/420 (05-10)

Approved for use through 05/31/2010. OMB 0651-0062

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket  
Number: VWS-34US

Application Number  
(if known): 12/674,997

Filing date: 02-24-2010

First Named  
Inventor: Hans Henrik Lausen

Title: METHOD FOR CONTROLLING AT LEAST ONE ADJUSTMENT MECHANISM OF A WIND TURBINE, A WIND TURBINE AND A WIND PARK

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request.**

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirements set forth in the notice titled "Pilot Program for Green Technologies Including Greenhouse Gas Reduction," as modified by the notice titled "Elimination of Classification Requirement in the Green Technology Pilot Program," each of which was published in the Federal Register, if the Office determines that the claims are not obviously directed to a single invention.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: STATEMENT OF SPECIAL STATUS FOR ELIGIBILITY UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Signature /William R. Allen/

Date 08-09-2010

Name  
(Print/Typed) William R. Allen

Registration Number 48389

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of 1 forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Instruction Sheet for**  
**Petition to Make Special Under the Green Technology Pilot Program**  
(Not to be Submitted to the USPTO)

***The following is a summary of the requirements (for more information see the notices (i) "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" and (ii) "Elimination of Classification Requirement in the Green Technology Pilot Program," available on the USPTO web site at [http://www.uspto.gov/patents/init\\_events/green\\_tech.jsp](http://www.uspto.gov/patents/init_events/green_tech.jsp)):***

- (1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371. The application must be previously filed before the publication date of the notice cited above. Reexamination proceedings are excluded from this pilot program.
- (2) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed.
- (3) The claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to: (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) green house gas emission reduction (see the eligibility requirements of sections II and III of the notice (i) cited above). The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview, and elect an invention that meets the eligibility requirements in section II or III of the notice (i) cited above.
- (4) The petition to make special must be timely filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen. Applicant should use form PTO/SB/420, which is available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site.
- (5) The petition to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.
- (6) The petition to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

**Certificate of Electronic Transmission**

I hereby certify that this correspondence is being electronically transmitted to the U.S. Patent and Trademark Office via EFS-WEB on August 9, 2010.

/William R. Allen/  
William R. Allen, Ph.D. Reg. No, 48,389

August 9, 2010  
Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Hans Henrik Lausen  
Serial No.: 12/674,997  
Filed: February 24, 2010  
Group Art Unit: Unknown  
Examiner: Unknown  
Confirmation No.: 1074  
Title: METHOD FOR CONTROLLING AT LEAST ONE ADJUSTMENT  
MECHANISM OF A WIND TURBINE, A WIND TURBINE AND A  
WIND PARK  
Attorney Docket: VWS-34US

Cincinnati, Ohio 45202

August 9, 2010

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**STATEMENT OF SPECIAL STATUS FOR ELIGIBILITY UNDER THE GREEN  
TECHNOLOGY PILOT PROGRAM**

Sir:

Applicant hereby submits a statement to support Applicant's petition for the Green Technology Pilot Program, which is filed on even date herewith. The Applicant seeks special status because the invention disclosed and claimed in the present application materially enhances the quality of the environment by contributing to the restoration or maintenance of the basic life-sustaining natural elements. The materiality standard is satisfied because the claimed invention materially enhances the quality of the environment by contributing to the restoration or

maintenance of one of the basic life-sustaining natural elements and/or the claimed invention materially contributes to development of renewable energy or energy conservation and greenhouse gas emission reduction. Specifically, the claimed invention relates to wind turbines that operate using a renewable natural resource (wind) rather than fossil fuels and, more specifically, to methods and systems for registering events in a wind power system having several data processors. Wind turbine operation without the consumption of fossil fuels enhances the quality of the environment, contributes to the development of renewable energy, and reduces greenhouse gas emission.

Early and favorable consideration of Applicant's petition and this claims contained in this application are respectfully requested.

Applicant does not believe any fees are due in connection with filing this communication other than the publication fee. If, however, any fees are necessary as a result of this communication, the Commissioner is hereby authorized to charge any under-payment or fees associated with this communication or credit any over-payment to Deposit Account No. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

/William R. Allen/  
William R. Allen, Ph.D.  
Reg. No, 48,389

2700 Carew Tower  
441 Vine Street  
Cincinnati, OH 45202  
(513) 241-2324 (voice)  
(513) 421-7269 (facsimile)  
wallen@whepatent.com



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/674,997	01/20/2011	Hans Henrik Lausen	VWS-34US	1074
26875	7590	03/08/2011	EXAMINER	
WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			ART UNIT	PAPER NUMBER
			2839	
			MAIL DATE	DELIVERY MODE
			03/08/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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WOOD, HERRON & EVANS, LLP  
2700 CAREW TOWER  
441 VINE STREET  
CINCINNATI OH 45202

In re Application of	:	
Hans Henrik LAUSEN	:	DECISION ON PETITION
Application No. 12/674,997	:	TO MAKE SPECIAL UNDER
Filed: January 20, 2011	:	THE GREEN TECHNOLOGY
Attorney Docket No. VWS-34US	:	PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed August 09, 2010, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

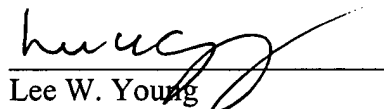
In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Lee W. Young at 571-272-4549.

The application is being forwarded to the Technology Center Art Unit 2839 for action in its regular turn.



---

Lee W. Young  
Quality Assurance Specialist  
Technology Center 2800

Doc Code: PET.GREEN

Document Description: Petition for Green Tech Pilot

PTO/SB/420 (12-09)

Approved for use through 05/31/2010. OMB 0651-0062

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket  
Number: TMP-033

Application Number  
(if known): 12/675,006

Filing date: February 24, 2010

First Named  
Inventor: Keiichirou KAWANO

Title: METHOD OF REPAIRING BEARING OF WIND TURBINE GENERATOR

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request. Applicant hereby rescinds under 37 CFR 1.213(b) any previous filed request that the above-identified application not be published under 35 U.S.C. 122(b).**

**If the application has been published, the petition must still be accompanied by the publication fee set forth in 37 CFR 1.18(d) and a statement that the application has been published.**

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirement and classification requirement set forth in the notice entitled "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" that was published in the Federal Register if the Office determines that the claims are not obviously directed to a single invention.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: \_\_\_\_\_

Signature /Manabu KANESAKA/

Date November 15, 2011

Name  
(Print/Typed) Manabu KANESAKA

Registration Number 31,467

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Instruction Sheet for  
Petition to Make Special Under the Green Technology Pilot Program**  
(Not to be Submitted to the USPTO)

***The following is a summary of the requirements (for more information see notice "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/oqsheet.html>):***

- (1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371. The application must be previously filed before the publication date of the notice cited above. Reexamination proceedings are excluded from this pilot program.
- (2) The application must be classified in one of the U.S. classifications listed in section VI of the notice cited above at the time of examination.
- (3) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed.
- (4) The claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to: (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) green house gas emission reduction (see the eligibility requirements of sections II and III of the notice cited above). The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview, and elect an invention that meets the eligibility requirements in section II or III of the notice cited above and is classified in one of the U.S. classifications listed in section VI of the notice cited above.
- (5) The petition to make special must be timely filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen. Applicant should use form PTO/SB/420, which will be available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site.
- (6) The petition to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.
- (7) The petition to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,006	05/11/2010	Keiichirou Kawano	TMP-033	1132

32628 7590 01/06/2012  
KANESAKA BERNER AND PARTNERS LLP  
1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA, VA 22314-2848

EXAMINER
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ART UNIT	PAPER NUMBER
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3726

MAIL DATE	DELIVERY MODE
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01/06/2012

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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KANESAKA BERNER AND PARTNERS LLP  
1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA VA 22314-2848

In re Application of  
KAWANO, KEIICHIROU et al  
Application No. 12/675006  
Filed: May 11, 2010  
Attorney Docket No. TMP-033

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:  
:  
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DECISION ON PETITION  
TO MAKE SPECIAL UNDER  
THE GREEN TECHNOLOGY  
PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed Nov. 15, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth in 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **granted**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within ONE (1) MONTH OR THIRTY (30) DAYS from the mail date of this decision, whichever is longer. No extension of this time limit can be granted under 37 CFR 1.136(a) or (b). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by

a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded “special” status.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen at 571-272-4856.

This application will be forwarded to the Technology Center Art Unit 3726 for action on the merits commensurate with this decision.

/Henry C. Yuen/

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Henry C. Yuen  
Quality Assurance Specialist  
Technology Center TC 3700



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

**MAILED**

DEC 01 2011

**OFFICE OF PETITIONS**

In re Application of Gesztesi et al. :  
Application No. 12/675,020 :  
Int'l Filing Date: September 3, 2008 :  
Attorney Docket No. 033794/385313 :  
Pub. No. US 2011/0135774 A1 :  
Pub. Date: June 9, 2011 :

Decision on Request

This is a decision on the request for a corrected patent application publication under 37 C.F.R. § 1.221(b) filed June 27, 2011.

The request is **dismissed**.

Applicants request the application be republished because eleven of the twelve inventors were not identified on the cover page of the patent application publication identified in the request.

37 C.F.R. § 1.221(b) states,

[Relief under 37 C.F.R. § 1.221 is warranted] only when the Office makes a material mistake which is apparent from Office records.... Any request for corrected publication or revised patent application publication other than provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable.

A mistake is only a "material" mistake if the mistake affects the public's ability to appreciate the technical disclosure of the patent application publication, determine the scope of the patent application publication, or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.<sup>1</sup>

The mistake identified in the instant request is not a material mistake as required under 37 C.F.R. § 1.221(b). Specifically, the mistake does not affect the public's ability to appreciate the

<sup>1</sup> See Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule, 65 Fed. Reg. 57023, 57038 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office 63, 75 (Oct. 10, 2000). See also Section 1130 of the Manual of Patent Examining Procedure (8th ed., Rev. 8, July 2010).

technical disclosure of the patent application publication, determine the scope of the patent application publication, or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. *See* MPEP § 1130(B). Therefore, relief under 37 C.F.R. § 1.221(b) is unwarranted and the request is dismissed.

Applicants are advised that a “request for republication of an application previously published” may be filed under 37 C.F.R. § 1.221(a). The request must include a copy of the application, which complies with the Office’s electronic filing system requirements set forth in 37 C.F.R. § 1.18(d), and the required processing fee set forth in 37 C.F.R. § 1.17(i).

If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in 37 C.F.R. § 1.18(d) will be refunded. However, the processing fee will be retained.

Guidance for filing a request for a Pre-Grant Publication, such as a request for republication, may be found at the links below:

<http://www.uspto.gov/patents/process/file/efs/guidance/index.jsp>

[http://www.uspto.gov/ebc/portal/efs/pgpub\\_quickstart.pdf](http://www.uspto.gov/ebc/portal/efs/pgpub_quickstart.pdf)

Any request for republication under 37 C.F.R. § 1.221(a), must be submitted via the EFS system as a “Pre-Grant Publication” and questions or any request for reconsideration of the instant decision should be addressed as follows:

By mail to:     Mail Stop PGPUB  
                    Commissioner for Patents  
                    P.O. Box 1450  
                    Alexandria, Va. 22313-1450

Telephone inquiries regarding this communication should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Christopher Bottorff  
Petitions Examiner  
Office of Petitions



UNITED STATES PATENT AND TRADEMARK OFFICE

24 AUG 2010

Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

BROOKS KUSHMAN P.C.  
1000 TOWN CENTER  
TWENTY-SECOND FLOOR  
SOUTHFIELD, MI 48075

In re Application of

ALLI

U.S. Application No.: 12/675,047

PCT No.: PCT/IB2009/051278

Int. Filing Date: 27 March 2009

Priority Date: 23 April 2008

Attorney Docket No.: 22045

For: MODULAR SHOES AND BOOTS

STORAGE AND ORGANISING SYSTEM

DECISION ON REQUEST  
FOR WITHDRAWAL AS  
ATTORNEY OF RECORD

This decision is in response to the "Request For Withdrawal As Attorney Or Agent Of Record And Change Of Correspondence Address" (Form PCT/SB/83) filed 12 May 2010.

The criteria for effecting a proper withdrawal of attorney are set forth in Section 402.06 of the Manual of Patent Examining Procedure (M.P.E.P.) which reads, in part, as follows:

In the event that a notice of withdrawal is filed by an attorney or agent of record, the file will be forwarded to the appropriate official for decision on the request. The **withdrawal is effective when approved** rather than when received.

To expedite the handling of requests for permission to withdraw as attorney, under 37 CFR 1.36, Form PTO/SB/83 may be used. Because the Office does not recognize law firms, each attorney of record must sign the notice of withdrawal, or the notice of withdrawal must contain a clear indication of one attorney signing on behalf of himself or herself and another. ...

The Director of the United States Patent and Trademark Office usually requires that there be at least 30 days between *approval* of the withdrawal and the latter of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a). This is so that the applicant will have sufficient time to obtain other representation or take other action.

Attorney John E. Nemazi has provided a clear indication that the request for withdrawal is being made on behalf of himself and all other attorneys/agents associated with Customer Number 22045.

Because all of the criteria delineated in Section 402.06 of the M.P.E.P. have been complied with, the request for withdrawal as attorney of record is appropriately **GRANTED**.

Application No.: 12/675,047

2

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision including updating the correspondence address as reflected below.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 271-3294

CC:

ANDREA ALLI  
123, WOLMER GARDENS  
EDGWARE HA8 8QF GB  
UNITED KINGDOM



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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

**OLIFF & BERRIDGE, PLC**  
**P.O. BOX 320850**  
**ALEXANDRIA VA 22320-4850**

**MAILED**

**APR 10 2012**

**OFFICE OF PETITIONS**

In re Application of  
Makoto MURATA  
Application No.: 12/675,061  
Filed: February 24, 2010  
Attorney Docket No.: 149765  
For: ROTARY INTERNAL COMBUSTION  
ENGINE

: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed March 16, 2012, to make the above-identified application special.

The request and petition are **GRANTED**.

**DISCUSSION**

A grantable request to participate in the PPH pilot program and petition to make special require:

1. The U.S. application is
  - a. a Paris Convention application which either
    - i. validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
  - b. a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
    - i. validly claims priority to an application filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
    - iii. contains no priority claim, or
  - c. a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
    - i. validly claims priority to an application filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
    - iii. contains no priority claim;

2. Applicant must:
  - a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s) and
  - b. Submit a claims correspondence table in English;
3. Examination of the U.S. application has not begun;
4. Applicant must submit:
  - a. Documentation of prior office action:
    - i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claim(s) or
    - ii. if the allowable/patentable claims(s) are from a "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
    - iii. if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form;
  - b. An English language translation of the JPO Office action from (5)(a)(i)-(ii) above
5. Applicant must submit:
  - a. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
  - b. Copies of the documents except U.S. patents or U.S. patent application publications (unless already submitted in this application);

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Michelle R. Eason at (571) 272-4231.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

This application will be forwarded to the examiner for action on the merits commensurate with this decision once this application's formality reviews have been completed.



Thurman K. Page  
Petitions Examiner  
Office of Petitions



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

**MAILED**

SEP 13 2010

**OFFICE OF PETITIONS**

**FLEIT GIBBONS GUTMAN BONGINI & BIANCO PL**  
**21355 EAST DIXIE HIGHWAY**  
**SUITE 115**  
**MIAMI, FL 33180**

In re Application of.	:	
Osman et al.	:	
Application No. 12/675,099	:	NOTICE
Filed: July 1, 2010	:	
Attorney Docket No. 7056-X10-049	:	

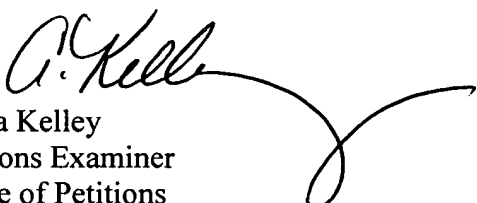
This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue patent under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This patent application is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-6059.

  
Alicia Kelley  
Petitions Examiner  
Office of Petitions

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE EUROPEAN PATENT OFFICE (EPO) AND THE USPTO

Application No:	12/675,109	Filing date:	February 24, 2010
First Named Inventor:	Yuantao Luan		
Title of the Invention:	ANTENNA DEVICE AND PORTABLE ELECTRONIC DEVICE COMPRISING SUCH AN ANTENNA DEVICE		
THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT <a href="http://www.uspto.gov/ebs/efs_help.html">HTTP://WWW.USPTO.GOV/EBS/EF5_HELP.HTML</a>			

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

The corresponding PCT application number(s) is/are: PCT/SE2009/050910

The international filing date of the corresponding PCT application(s) is/are: July 21, 2009

## I. List of Required Documents:

- a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)

☒

Is attached

☐

Is not attached because the document is already in the U.S. application.

- b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).

☒

Is attached.

☐

Is not attached because the document is already in the U.S. application.

- c. English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.

# REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM BETWEEN THE EPO AND THE USPTO

(continued)

Application No.:	12/675,109
First Named Inventor:	Yuantao Luan

- d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

☐

Is attached

☒Has already been filed in the above-identified U.S. application on February 25, 2010

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)

☐

Are attached.

☒Have already been filed in the above-identified U.S. application on February 25, 2010

## II. Claims Correspondence Table:

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
25	1	Identical (except US claim does not include reference numbers)
26	2	Identical (except US claim does not include reference numbers)
27	3	Identical (except US claim does not include multiple dependency or reference numbers)
28	4	Identical (except US claim does not include reference numbers)
29	5	Identical (except US claim does not include reference numbers)
30	6	Identical (except US claim does not include reference numbers)
31	7	Identical (except US claim does not include multiple dependency or reference numbers)
32	8	Identical (except US claim does not include reference numbers)
33	9	Identical (except US claim does not include multiple dependency or reference numbers)
34	10	Identical (except US claim does not include multiple dependency or reference numbers)
35	11	Identical (except US claim does not include multiple dependency or reference numbers)
36	12	Identical (except US claim does not include multiple dependency or reference numbers)
37	13	Identical (except US claim does not include reference numbers)
38	14	Identical (except US claim does not include reference numbers)
39	15	Identical (except US claim does not include multiple dependency or reference numbers)
40	16	Identical (except US claim does not include reference numbers)
41	X	US claim 41 depends from patentable US claim 25
42	X	US claim 41 depends from patentable US claim 25
43	17	Similar in scope (US claim does not include multiple dependency or reference numbers)

III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.

Signature <u>/Anthony G. Fussner/</u>	Date <u>03/16/2011</u>
Name (Print/Typed) <u>Anthony G. Fussner</u>	Registration Number <u>47,582</u>

(continued)

Application No.:	12/675,109
First Named Inventor:	Yuantao Luan

- ☐ **WORKSHEET, WORKSHEET**  
Is attached

Has already been filed in the above-identified U.S. application on February 25, 2010

- ☐ Are attached.

Have already been filed in the above-identified U.S. application on February 25, 2010

[illegible]

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature <b>/Anthony G. Fussner/</b>	Date <b>03/16/2011</b>
Name (Print/Typed) <b>Anthony G. Fussner</b>	Registration Number <b>47,582</b>

## Acknowledgement of receipt

We hereby acknowledge receipt of your request for the processing of an international application according to the Patent Cooperation Treaty as follows:

Submission number	1000005236	
PCT application number	PCT/SE2009/050910	
Date of receipt	21 July 2009	
Receiving Office	Swedish Patent and Registration Office	
Your reference	08325PC/CD	
Applicant	LAIRD TECHNOLOGIES AB	
Number of applicants	2	
Country	SE	
Title	ANTENNA DEVICE AND PORTABLE ELECTRONIC DEVICE COMPRISING SUCH AN ANTENNA DEVICE	
Documents submitted	eolf-pkda.xml eolf-appb.xml eolf-vlog.xml eolf-othd-000001.pdf (23 p.) eolf-appb-P000001.pdf (3 p.) pct101u.gml	eolf-requ.xml eolf-fees.xml pct101.GML eolf-abst.txt pct101.1WO referenc.inf
Submitted by	CN=C. Dahnér 15543,O=Kransell & Wennborg KB,C=SE	
Method of submission	Online	
Date and time receipt generated	21 July 2009, 10:32:08 (CEST)	
Digest	B2:4E:F8:A2:B1:F1:47:D4:71:FE:0D:29:41:84:E3:2A:AB:CF:D7:A4	

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/Swedish Patent and Registration Office/

**PCT (ANNEX - FEE CALCULATION SHEET)**

Print Out (Original in Electronic Form)

(This sheet is not part of and does not count as a sheet of the international application)

<b>0</b>	<b>For receiving Office use only</b>		
0-1	International Application No.		
0-2	Date stamp of the receiving Office		
<b>0-4</b>	<b>Form PCT/RO/101 (Annex)</b>		
0-4-1	Prepared Using	<b>PCT Online Filing</b> <b>Version 3.5.000.204 MT/FOP</b> <b>20020701/0.20.5.9</b>	
<b>0-9</b>	<b>Applicant's or agent's file reference</b>	<b>08325PC/CD</b>	
<b>2</b>	<b>Applicant</b>	<b>LAIRD TECHNOLOGIES AB</b>	
<b>12</b>	<b>Calculation of prescribed fees</b>	fee amount/multiplier	Total amounts (SEK)
12-1	Transmittal fee <b>T</b>	⇒	<b>1200</b>
12-2-1	Search fee <b>S</b>	⇒	<b>18280</b>
12-2-2	International search to be carried out by <b>SE</b>		
12-3	International filing fee (first 30 sheets) <b>i1</b>	<b>9780</b>	
12-4	Remaining sheets <b>0</b>		
12-5	Additional amount <b>(X) 0</b>		
12-6	Total additional amount <b>i2 0</b>		
12-7	i1 + i2 = <b>i 9780</b>		
12-12	Electronic Filing reduction (Image) <b>R -1470</b>		
12-13	Total International filing fee (i-R) <b>I</b>	⇒	<b>8310</b>
12-14	Fee for priority document		
	Number of priority documents requested <b>0</b>		
12-15	Fee per document <b>(X) 0</b>		
12-16	Total priority document fee: <b>P</b>	⇒	
12-17	Fee for restoration of priority rights <b>RP</b>		
	Number of requests for restoration of priority rights <b>0</b>		
	Total amount of fees for restoration of priority rights		
<b>12-19</b>	<b>TOTAL FEES PAYABLE (T+S+I+P+RP)</b>	⇒	<b>27790</b>

**PCT (ANNEX - FEE CALCULATION SHEET)**

Print Out (Original in Electronic Form)

(This sheet is not part of and does not count as a sheet of the international application)

<b>12-21</b>	<b>Mode of payment</b>	<b>authorization to charge deposit account</b>
<b>12-22</b>	<b>Deposit account instructions</b>	
	The receiving Office	<b>Swedish Patent and Registration Office (RO/SE)</b>
12-22-1	Authorization to charge the total fees indicated above	✓
12-22-2	Authorization to charge any deficiency or credit any overpayment in the total fees indicated above	✓
12-22-3	Authorization to charge the fee for priority document	✓
<b>12-23</b>	<b>Deposit account No.</b>	<b>1421</b>
<b>12-24</b>	<b>Date</b>	<b>21 July 2009 (21.07.2009)</b>
<b>12-25</b>	<b>Name and signature</b>	<b>BENGT ROMEDAHL,</b>
		<b>/Bengt Romedahl/</b>

**PCT REQUEST**

Print Out (Original in Electronic Form)

<b>0</b>	<b>For receiving Office use only</b>	
<b>0-1</b>	International Application No.	
<b>0-2</b>	International Filing Date	
<b>0-3</b>	Name of receiving Office and "PCT International Application"	
<b>0-4</b>	<b>Form PCT/RO/101 PCT Request</b>	
<b>0-4-1</b>	Prepared Using	<b>PCT Online Filing Version 3.5.000.204 MT/FOP 20020701/0.20.5.9</b>
<b>0-5</b>	<b>Petition</b> The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty	
<b>0-6</b>	<b>Receiving Office (specified by the applicant)</b>	<b>Swedish Patent and Registration Office (RO/SE)</b>
<b>0-7</b>	<b>Applicant's or agent's file reference</b>	<b>08325PC/CD</b>
<b>I</b>	<b>Title of Invention</b>	<b>ANTENNA DEVICE AND PORTABLE ELECTRONIC DEVICE COMPRISING SUCH AN ANTENNA DEVICE</b>
<b>II</b>	<b>Applicant</b>	
<b>II-1</b>	This person is	<b>applicant only</b>
<b>II-2</b>	Applicant for	<b>all designated States except US</b>
<b>II-4</b>	Name	<b>LAIRD TECHNOLOGIES AB</b>
<b>II-5</b>	Address	<b>Box 1146 SE-164 22 KISTA Sweden</b>
<b>II-6</b>	State of nationality	<b>SE</b>
<b>II-7</b>	State of residence	<b>SE</b>
<b>III-1</b>	<b>Applicant and/or inventor</b>	
<b>III-1-1</b>	This person is	<b>applicant and inventor</b>
<b>III-1-2</b>	Applicant for	<b>US only</b>
<b>III-1-4</b>	Name (LAST, First)	<b>LUAN, Aton</b>
<b>III-1-5</b>	Address	<b>Room 502, Gate 6, Build 4, Gui Yuan Bei Li Wu Qu Yi Zhuang, Da Xing District, 100176 BEIJING China</b>
<b>III-1-6</b>	State of nationality	<b>CN</b>
<b>III-1-7</b>	State of residence	<b>CN</b>

**PCT REQUEST**

Print Out (Original in Electronic Form)

<b>IV-1</b>	<b>Agent or common representative; or address for correspondence</b> The person identified below is hereby/ has been appointed to act on behalf of the applicant(s) before the competent International Authorities as:	<b>agent</b>
IV-1-1	Name (LAST, First)	<b>DAHNER, Christer</b>
IV-1-2	Address	<b>Kransell &amp; Wennborg KB P.O. Box 27834 11593 STOCKHOLM Sweden</b>
IV-1-3	Telephone No.	<b>+46 8 6612155</b>
IV-1-4	Facsimile No.	<b>+46 8 6612119</b>
IV-1-5	e-mail	<b>info@kransell-wennborg.se</b>
<b>IV-2</b>	<b>Additional agent(s)</b>	<b>additional agent(s) with same address as first named agent</b>
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<b>V</b>	<b>DESIGNATIONS</b>	
<b>V-1</b>	<b>The filing of this request constitutes under Rule 4.9(a), the designation of all Contracting States bound by the PCT on the international filing date, for the grant of every kind of protection available and, where applicable, for the grant of both regional and national patents.</b>	
<b>VI-1</b>	<b>Priority claim of earlier regional application</b>	
VI-1-1	Filing date	<b>21 July 2008 (21.07.2008)</b>
VI-1-2	Number	<b>08160811.9</b>
VI-1-3	Regional Office	<b>EP</b>
<b>VI-2</b>	<b>Incorporation by reference :</b> where an element of the international application referred to in Article 11(1)(iii)(d) or (e) or a part of the description, claims or drawings referred to in Rule 20.5(a) is not otherwise contained in this international application but is completely contained in an earlier application whose priority is claimed on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, that element or part is, subject to confirmation under Rule 20.6, incorporated by reference in this international application for the purposes of Rule 20.6.	

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<b>VII-1</b>	<b>International Searching Authority Chosen</b>	<b>Swedish Patent and Registration Office (ISA/SE)</b>	
<b>VIII</b>	<b>Declarations</b>	Number of declarations	
VIII-1	Declaration as to the identity of the inventor	—	
VIII-2	Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent	—	
VIII-3	Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application	—	
VIII-4	Declaration of inventorship (only for the purposes of the designation of the United States of America)	—	
VIII-5	Declaration as to non-prejudicial disclosures or exceptions to lack of novelty	—	
<b>IX</b>	<b>Check list</b>	number of sheets	electronic file(s) attached
IX-1	Request (including declaration sheets)	<b>4</b>	✓
IX-2	Description	<b>17</b>	✓
IX-3	Claims	<b>5</b>	✓
IX-4	Abstract	<b>1</b>	✓
IX-5	Drawings	<b>3</b>	✓
IX-7	TOTAL	<b>30</b>	
	<b>Accompanying Items</b>	paper document(s) attached	electronic file(s) attached
IX-8	Fee calculation sheet	—	✓
IX-18	PCT-SAFE physical media	—	—
<b>IX-20</b>	<b>Figure of the drawings which should accompany the abstract</b>	<b>3</b>	
<b>IX-21</b>	<b>Language of filing of the international application</b>	<b>English</b>	
<b>X-1</b>	<b>Signature of applicant, agent or common representative</b>	<b>(PKCS7 Digital Signature)</b>	
<b>X-1-1</b>	Name (LAST, First)	<b>DAHNER, Christer</b>	
<b>X-1-2</b>	Name of signatory	<b>SE, Kransell &amp; Wennborg KB, C. Dahnér 15543</b>	
<b>X-1-3</b>	Capacity	<b>(Representative)</b>	

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10-2	Drawings:	
10-2-1	Received	
10-2-2	Not received	
10-3	Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application	
10-4	Date of timely receipt of the required corrections under PCT Article 11(2)	
10-5	International Searching Authority	<b>ISA/SE</b>
10-6	Transmittal of search copy delayed until search fee is paid	

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Patent och Registreringsverket

Tel: 08-7822500

Org nr. 202100-2072

www.prv.se

Kvittokopia

Datum: 2009-07-22  
Bet datum: 2009-07-21  
Löpnr: 594821  
Ärendenr: SE2009/050910 ( )  
Avser: PCT NYHETSGRANSKNING  
Belopp: \*18280.00  
(Varav moms:) .00  
(Ref:) 08325PC/CD

Patent och Registreringsverket

Tel: 08-7822500

Org nr. 202100-2072

www.prv.se

Kvittokopia

Datum: 2009-07-22  
Bet datum: 2009-07-21  
Löpnr: 594819  
Ärendenr: SE2009/050910 ( )  
Avser: PCT VIDAREBEFÖRDRINGSAVG  
Belopp: \*\*1200.00  
(Varav moms:) .00  
(Ref:) 08325PC/CD

Patent och Registreringsverket

Tel: 08-7822500

Org nr. 202100-2072

www.prv.se

Kvittokopia

Datum: 2009-07-22  
Bet datum: 2009-07-21  
Löpnr: 594820  
Ärendenr: SE2009/050910 ( )  
Avser: SALDOKVITTO  
Belopp: \*27790.00  
(Varav moms:) .00

Patent och Registreringsverket

Tel: 08-7822500

Org nr. 202100-2072

www.prv.se

Kvittokopia

Datum: 2009-07-22  
Bet datum: 2009-07-21  
Löpnr: 594820  
Ärendenr: SE2009/050910 ( )  
Avser: PCT GRUNDAVGIFT  
Belopp: \*\*8310.00  
(Varav moms:) .00  
(Ref:) 08325PC/CD

ANTENNA DEVICE AND PORTABLE ELECTRONIC  
DEVICE COMPRISING SUCH AN ANTENNA DEVICE

5    FIELD OF INVENTION

The present invention relates generally to antenna devices and more particularly to an antenna device for use in a portable electronic device, such as a mobile phone, which is adapted for radio signals having a relatively low frequency, such as radio signals in the FM band.

BACKGROUND

Internal antennas have been used for some time in portable radio communication devices. There are a number of advantages connected with using internal antennas, of which can be mentioned that they are small and light, making them suitable for applications wherein size and weight are of importance, such as in mobile phones.

However, the application of internal antennas in a mobile phone puts some constraints on the configuration of the antenna element. In particular, in a portable radio communication device the space for an internal antenna arrangement is limited. These constraints may make it difficult to find a configuration of the antenna that provides for a wide operating band. This is especially true for antennas intended for use with radio signals of relatively low frequencies as the desired physical length of such antennas are large compared to antennas operating with relatively high frequencies.

One specific application operating in a relatively low frequency band is the FM radio application. The FM band

is defined as frequencies between 88-108 MHz in Europe and USA or between 76 - 90 MHz in Japan, i.e. 76 - 108 MHz worldwide. Prior art conventional antenna configurations, such as loop antennas or monopole antennas, fitted within the casing of a portable radio communication device will result in unsatisfactory operation in that the antenna either has too bad performance over a sufficiently wide frequency band or sufficient performance over a too narrow frequency band.

Instead, a conventional FM antenna for portable radio communication devices is provided in the headset wire connected to the communication device. This configuration with a relatively long wire permits an antenna length that is sufficient also for low frequency applications. However, if no external antenna is permitted this solution is obviously not feasible.

Another problem is that in case a second antenna, such as a GSM antenna, is provided in the same communication device as the FM antenna, this second antenna interferes with the operation of the FM antenna.

#### SUMMARY OF THE INVENTION

An object of the present invention is to provide an internal antenna device for use in a portable electronic device, which operates with sufficient performance throughout a frequency band having a relatively low frequency, such as the FM radio band.

The invention is based on the realization that an active internal antenna can be configured as a monopole antenna.

According to the present invention there is provided an antenna device for receiving radio signals in at least one operating frequency band and for being provided in the interior of a portable electronic device, said  
5 antenna device comprising a monopole radiating and/or radiation receiving element including a feeding portion adapted to be connected to an antenna connection point, where an inductor is connectable between the antenna connection point and ground and the input of an  
10 amplifier stage is also connectable to said antenna connection point, where an output of the amplifier stage is connectable to a radio circuit, all to be provided in the interior of the portable electronic device.

15 A portable electronic device comprising a ground plane, an antenna connection point, an inductor connected between said antenna connection point and ground, an amplifier stage with an input connected to the antenna connection point, a radio circuit connected to an  
20 output of the amplifier stage, and such an antenna device is also provided.

The antenna device according to the invention provides operation with sufficient performance throughout a frequency band having a relatively low frequency, such  
25 as the FM radio band. By using a monopole antenna, it has been found that the sensitivity is improved across the entire operating frequency range, giving good signal to noise ratio despite having a resonant frequency behavior in terms of gain. There is therefore  
30 no need for any frequency tuning. The inductor connected between the monopole element and ground

increases source resistance seen by the amplifier stage, thus matching noise and increasing stability.

In a preferred embodiment, the monopole element is a top-loaded monopole element that is co-designed with  
5 the inductor and amplifier stage.

Further preferred embodiments are defined in the dependent claims.

#### BRIEF DESCRIPTION OF DRAWINGS

The invention is now described, by way of example, with  
10 reference to the accompanying drawings, in which:

Fig. 1 shows a front view of a portable electronic device according to the present invention;

Fig. 2 shows a sectional view of the portable electronic device according to the present invention;

15 Fig. 3 shows a schematic diagram of an antenna device according to the invention connected to a radio circuit,

FIG. 4 shows a schematic side view of a monopole element of the antenna device provided above a ground  
20 plane;

FIG. 5 is a circuit diagram of the antenna device of the present invention, where corresponding electrical circuit elements of the monopole element are included;

FIG. 6 is a schematic perspective view of a monopole  
25 element configuration in relation to a ground plane according to a first embodiment of the present invention;

Fig. 7 shows curves of the gain and SNR for an antenna device using a monopole element having the configuration of fig. 6 compared with a curve of the gain and SNR of an antenna with the same monopole element and using conventional passive conjugate impedance matching, and

FIG. 8 is a schematic perspective view of a monopole element configuration in relation to a ground plane according to a second embodiment of the present invention.

#### DETAILED DESCRIPTION OF THE INVENTION

In the following, a detailed description of a preferred embodiment of an antenna and portable electronic device according to the invention will be given. In the description, for purposes of explanation and not limitation, specific details are set forth, in order to provide a thorough understanding of the present invention. However, it will be apparent to one skilled in the art that the present invention may be utilized in other embodiments that depart from these specific details. In other instances, detailed descriptions of well-known units, entities and circuits are omitted so as not to obscure the description of the present invention with unnecessary details.

Fig. 1 shows a front view of a portable electronic device 10, such as a mobile phone. The portable electronic device can however be another type of device, such as a lap top computer, a palm top computer, an electronic organizer such as a personal digital assistant (PDA), a game console, a small clock, such as a travel alarm clock, a TV receiver, an FM

radio receiver or a media player such as an MP3 or a CD player. The device 10 is, as an example, provided with a display 12 placed close to an upper end of the device and a keypad 14 placed close to a lower end of the device. These are here provided on the casing of the device 10. It should however be realized that the device may just as well be provided without a display and/or without a keypad. The device 10 is also provided with at least one antenna. However, all antennas are provided inside the device, i.e. in the interior of the device.

Fig. 2 shows a schematic side view of the device 10, which is a cross section through the casing 16. In order to clarify the description of the present invention only elements that are necessary for understanding the present invention are included. Thus a number of units in the device have here been omitted, like for instance the display and the keypad shown in fig. 1. The device 10 here includes a circuit board 20 on which an antenna device 18 according to the present invention is mounted. On the board 20 there is furthermore a radio circuit 22, here in the form of an FM receiver circuit, which may for instance be used to demodulate radio signals received by the antenna device. The circuit board 20, which may be a multi-layer PCB (printed circuit board), furthermore includes a ground plane (not shown), which is used together with the antenna device 18 of the present invention.

With reference to FIG. 3, the general configuration of an antenna device 18 according to a first embodiment of the present invention being connected to the radio circuit 22 is shown. The antenna device 18 here

includes a radiating and/or radiation receiving element 20, which may be provided in the form of a non-resonant piece of electrically conductive material. It may be provided in the form of a metal wire or as a conductive trace on a flex film. The element is furthermore a  
5 monopole element, the details of which will be described in more detail below.

The monopole element 20 is connected to an antenna connection point 23, which leads to a shunt inductor 24  
10 being connected between the antenna connection point 23 and ground. This shunt inductor may be physically connected relatively close to the antenna connection point. There is furthermore an amplifier stage 26 in the antenna device 18, the input of which is also  
15 connected to the antenna connection point 23 and the output of which is connected to the FM receiver circuit 22, which could be a conventional circuit manufactured by Philips Semiconductors and sold under the name HVQFN40. The amplifier stage 26 amplifies signals  
20 received by the monopole element 20 and provides them to the FM receiver circuit 22.

Fig. 4 schematically shows a side view of the monopole element 20 according to the first embodiment being provided adjacent the ground plane 34 provided in the  
25 circuit board. As can be seen the monopole element 20 is a top loaded elongated monopole element. The monopole element 20 here includes a first section 28, which at a first end provides a feeding portion 32 for connection to the antenna connection point and is at a  
30 second opposite end joined to a first end of a second section 30. The second end of the second section 30 is in this embodiment free, i.e. it is not connected to

any further sections or other elements, but is here provided at a distance  $h$  from the ground plane 34. The second section 30 is furthermore at least partly aligned with the ground plane 34 and when the monopole element 20 is placed adjacent said ground plane 34 preferably more than half of the second section 30 is aligned with the ground plane 34. Here the whole of the second section 30 is aligned with the ground plane 34, which means that all of it is placed above the ground plane 34.

The first section 28 has an extension  $h$  in a first dimension away from the feeding portion 32, which first dimension is here a dimension that is perpendicular to the ground plane 34. In this embodiment the first section does only have an extension in this dimension. It should however be realized that it may as an alternative also have an extension in a second and/or a third dimension, which second and third dimensions are both perpendicular to the first dimension and to each other. The first section 28 does thus have an extension  $h$  in the first dimension. The second section 30 extends in a plane provided in the second and third dimensions. This means that the whole second section 30 is provided in a plane that is parallel with and distanced a distance  $h$  from the ground plane 34. The second section 30, which in this embodiment is a straight section, does furthermore have a length  $l$  that is the electrical length of the monopole element 20.

Fig. 5 schematically shows a circuit diagram of the antenna device 18 according to the first embodiment of the present invention, where corresponding electrical circuit elements according to a model of the monopole

element 20 are included. The monopole element 20 is  
 thus here represented by an electrical circuit  
 including a voltage source  $V_s$  connected between ground  
 and a series circuit made up of a radiator capacitance  
 5  $C_r$  and a radiator resistance  $R_r$ . The radiator  
 resistance  $R_r$  is furthermore connected to the input of  
 the amplifier stage 26 as is the inductor 24. The  
 inductor 24 is here shown as having an inductance  $L$ ,  
 which may be about 1  $\mu\text{H}$ . There is furthermore here a  
 10 parasitic capacitance  $C_p$  provided between the input of  
 the amplifier stage 26 and ground. The input of the  
 amplifier stage 26 is shown as having an input  
 impedance  $Z_{in}$ . The amplifier stage 26 here comprises a  
 field effect transistor (FET) 36 with the gate  
 15 connected to the shunt inductor 24, the source  
 connected directly to ground and the drain connectable  
 to the input of the FM receiver circuit (not shown).  
 There is also a load resistor 38 connected between the  
 drain of the transistor 36 and a feed voltage  $V_{dd}$ . The  
 20 amplifier stage 26 is here a GaAs amplifier stage,  
 which means that the FET transistor 36 is here a GaAs  
 FET transistor, which may be a GaAs pHEMT transistor.  
 The parasitic capacitance  $C_p$  occurs because of the non-  
 ideal properties of wires, connection points and the  
 25 gate-source connection of the transistor 36 in the  
 amplifier stage 26.

The monopole element 20 and the inductor 24 are here  
 co-designed with the amplifier stage 26. This means  
 that none of them are adapted to the 50  $\Omega$  impedance  
 30 normally used when connecting various elements. The  
 reason for this is that it is very hard to adapt the  
 impedance of a small monopole element to this type of

impedance. Therefore the amplifier stage 26 is designed to have a high input impedance  $Z_{in}$ , which is typically ten times or more higher than  $50\ \Omega$ .

The monopole element 20 and inductor 24 are here thus adapted to match the input impedance  $Z_{in}$  of the amplifier stage 26. These are thus selected to provide, perhaps together with the parasitic capacitance  $C_p$ , an impedance at the antenna connection point 23 that matches the input impedance  $Z_{in}$  of the amplifier stage 26.

This is essentially done through selecting dimensions of the monopole element 20 for obtaining an antenna capacitance, which antenna capacitance is here only made up of the radiator capacitance  $C_r$ , so that the antenna capacitance together with the inductance  $L$  of the inductor 24 and the parasitic capacitance  $C_p$  match the input impedance  $Z_{in}$ . This matching may also involve selection of the radiator resistance  $R_r$ .

With the antenna structure in fig. 4, the radiator capacitance

$$C_r \propto l/h,$$

while the radiator resistance

$$R_r \propto h^2,$$

The wavelengths of the frequency band are here ten times or more longer than the electrical length  $l$  of the monopole element. This means that the electrical length of the monopole element is here far too short for providing resonance. Through selecting length and

height of the monopole element together with a corresponding selected value of the inductor, typically around 1  $\mu\text{H}$ , it is therefore possible to provide matching to the amplifier stage. The inductor increases the source impedance seen by the transistor of the amplifier stage, thus matching noise and increasing stability.

The ground plane may extend over an area that is limited by a number of corners. It may typically be rectangular in shape and thus have four corners. The antenna connection point may here be provided adjacent one of these corners of the ground plane. With such a placing the first section of the monopole element may therefore be provided at a corner of the ground plane 34, with the second section stretching out across the ground plane, as is shown in fig. 6. The second section may here stretch along a short side of the ground plane 34 that is provided at the upper or lower end of the portable electronic device. With this type of placing of the monopole element 20, it is possible to let the ground plane 34 of the circuit board enhance the performance of the antenna device.

The antenna device according to the described embodiment receives radio signals that are here FM radio signals. The antenna device is thus provided for operating in a frequency band, which frequency band is here the FM frequency band. In the case of operation in the FM band, the pass band is between 88-108 MHz in Europe and USA or between 76 - 90 MHz in Japan.

Through the use of a monopole element being matched to an amplifier stage using an inductor there is obtained

an antenna that has a good isolation in relation to magnetic interference, especially as compared with magnetic dipole antennas. This is important if the portable electronic device is a cellular phone where  
5 there may exist a number of different antennas, such as GSM antennas, Bluetooth antennas and GPS antennas. In this way the induced noise and interference coupled to the monopole element is minimized.

The antenna device including monopole element, inductor  
10 and amplifier stage is here a so-called active antenna. Fig. 7 shows the SNR (Signal to Noise Ratio) 40 at the input of the receiver circuit (in dB) for the antenna device of the described embodiment compared to a lossless reference dipole antenna (at 0 dB), together  
15 with the gain 42 of the antenna device of the described embodiment and the gain 43 and SNR 44 at the input of the receiver circuit for a monopole element of the described embodiment using conventional passive conjugate impedance matching (i.e. without  
20 amplification). As can be seen in Fig. 7, the SNR 40 at the receiver circuit input with the antenna device according the first embodiment is both significantly higher and has less variation over the whole frequency range as compared with the SNR 44 of the monopole  
25 element that uses conventional matching. The antenna device of the described embodiment is therefore suitable for operating in the entire worldwide FM radio frequency range, without any need of frequency tuning using e.g. a varactor, despite having a resonant  
30 frequency behavior in terms of gain.

The antenna device furthermore provides ESD protection, effectively blocking the major part of the ESD pulse

spectrum. This also eliminates or at least reduces interference from electro magnetic interference (EMI) and possibly signals from other antennas provided in the same radio communication device, such as cellular  
5 GSM antennas operating at frequencies well above the FM antenna.

It is preferred that the shunt inductor 24 and amplifier stage 26 are provided relatively close to the monopole element 20 in order to minimize parasitic  
10 effects and interference from external sources.

In order for the antenna device to operate, the transistor of the amplifier stage may preferably have a minimum noise figure below 1 dB and a gain above 15 dB in the operating frequency band. Also, it is preferred  
15 that the transistor has a noise resistance  $R_n$  of less than 10 Ohms in order to achieve highest possible signal reception quality for arbitrary antenna configurations. A further preferred characteristic of the transistor is that the input capacitance is low,  
20 preferably less than 3 pF, in order to obtain high input impedance.

Furthermore, the amplifier stage can in a variation of the present invention also be a so-called cascode amplifier stage. Such a cascode amplifier stage  
25 comprises a first field effect transistor with the gate connected to the monopole element and shunt inductor, the source connected directly to ground and the drain connected to the source of a second field effect transistor. The gate of the second transistor is  
30 connected to ground via a capacitor. The drain of the second transistor is then connectable to the input of

the FM receiver circuit 40. There is here also a load resistor connected between the drain of the second transistor and the feed voltage Vdd.

Here an FM transmitter circuit can furthermore be  
5 connected to the monopole element via a switch. This switch is necessary if the input impedance of the transmitter circuit is much lower, such as ten times lower than the input impedance  $Z_{in}$  of the amplifier in front of the FM receiver circuit. However, this switch  
10 can be omitted if the input impedance of the transmitter circuit is in the same order as the input impedance  $Z_{in}$  of the amplifier.

By providing a transmitter circuit connected to the monopole element, this monopole element can be shared  
15 and thus function for both transmission and reception. The transmitter circuit should preferably be connected to the monopole element approximately at the antenna connection point.

It should here be realised that there are a number of  
20 further variations that can be made to the present invention. The second section of the monopole element may for instance, according to a second embodiment of the present invention, not be a straight section, but may include two straight parts, for instance two  
25 straight parts joined to each other at an angle of 90 degrees as is shown in fig. 8. These two parts will however both run in the plane that is parallel with the ground plane. It is furthermore possible to provide the second section with a periodic shape, like a meandering  
30 shape or a sinus curve shape in said plane. Such a shape may provide a radiator inductance in series with

the radiator capacitance and radiator resistance of the monopole element model, which radiator inductance may thus also be selected to influence the impedance matching, by suitable selection of the structure of the second section. The second end of the second section need furthermore not be free, but may be connected to ground using a capacitor. The capacitance of this capacitor together with the radiator capacitance then makes up the antenna capacitance. This capacitor therefore also helps in the matching to the amplifier stage. It is furthermore possible that the second section of the monopole element stretches out beyond the edge of the ground plane. In this case the radiator resistance in the monopole element model is influenced in that the resistance is proportional to the height above the ground plane plus the distance that the second section stretches out beyond the ground plane.

The antenna device was above being described as including the monopole element, the inductor and the amplifier stage. It is possible that the antenna device does not include the amplifier stage, in which case it would thus only include the monopole element and the inductor. It is furthermore possible that the antenna device only includes the monopole element. In these variations of the present invention, the elements that are not a part of the antenna device will however be required in the portable electronic device in which the antenna device is to be placed.

Preferred embodiments of an antenna device according to the invention have been described. However, the person skilled in the art realizes that these can be varied

within the scope of the appended claims without departing from the inventive idea.

It is realized that the shape and size of the antenna device according to the invention can be varied within  
5 the scope defined by the appended claims. Thus, the exact antenna configurations can be varied so as to correspond to the shape of the portable electronic device, desired performance etc.

The above-described embodiments of an antenna device  
10 according to the invention have been described as antenna devices adapted for reception of radio signals in the FM frequency band. However, other applications are also possible, such as use for digital video broadcasting (DVB) signals in the frequency range of about  
15 400-800 MHz.

A FET has been described as the preferred transistor type. It will be realized that other types of transistors, such as hetero-junction bipolar transistors (HBT), can be used as well.

20 It will be appreciated that the transmitter circuit can be implemented also in the first embodiment shown in Fig. 3 and 5.

The monopole element may finally be provided in a holding unit, such as an antenna carrier or a middle  
25 deck holding the monopole element. This holding unit may then be of a plastic material, which is easily mounted in the interior of the portable electronic device in relation to the circuit board.

## CLAIMS

1. An antenna device (18) for receiving radio  
5 signals in at least one operating frequency band and  
for being provided in the interior of a portable  
electronic device (10), said antenna device (18)  
comprising
  - a monopole radiating and/or radiation receiving  
10 element (20) including a feeding portion (32)  
adapted to be connected to an antenna connection  
point (23),
  - where an inductor (24) is connectable between the  
antenna connection point (23) and ground and the  
15 input of an amplifier stage (26) is also connectable  
to said antenna connection point (23), where an  
output of the amplifier stage (26) is connectable to  
a radio circuit (22), all to be provided in the  
interior of the portable electronic device (10).
- 20 2. The antenna device (18) according to claim 1,  
wherein the monopole element (20) is an elongated  
element.
3. The antenna device (18) according to claim 1 or  
2, wherein the monopole element (20) is co-designed  
25 with the amplifier stage (26) and inductor (24).
4. The antenna device (18) according to claim 3,  
wherein the monopole element (20) has a first section  
(28), which at a first end provides said feeding  
portion (32) and at a second opposite end is joined to  
30 a first end of a second section (30), said first

section (28) having an extension (h) in a first dimension from the feeding portion (32) and the second section (30) is arranged in a plane provided in a second and third dimension perpendicular to the first dimension.

5. The antenna device (18) according to claim 4, wherein the length (l) of the second section (30) and the extension (h) of the first section (28) in the first dimension are selected for providing an antenna capacitance ( $C_r$ ), which antenna capacitance together with the inductance (L) of the inductor (24) is matched to the input impedance ( $Z_{in}$ ) of the amplifier stage (26).

6. The antenna device (18) according to claim 5, further comprising a capacitor for connection between a second end of the second section and ground, which capacitor also contributes to the antenna capacitance.

7. The antenna device (18) according to any of claims 4 - 6, wherein the feeding portion (32) is adapted for being placed adjacent a ground plane (34) of the portable electronic device (10), said extension (h) of the first section (28) in the first dimension is perpendicular to the ground plane (34), the plane the second section (30) is provided in is parallel with the ground plane (34) and the second section (30) is at least partly aligned with the ground plane (34) when the monopole element (20) is placed adjacent said ground plane (34).

8. The antenna device (18) according to claim 7, wherein more than half of the second section (30) is

aligned with the ground plane (34) when the monopole element (20) is placed adjacent said ground plane.

9. The antenna device (18) according to any of claims 1 - 3, wherein the monopole element (20) is adapted for being placed adjacent a ground plane (34) of the portable electronic device (10).

10. The antenna device (18) according to any previous claim, wherein the wavelengths of the operating frequency band are ten times or more longer than the electrical length of the monopole element (20).

11. The antenna device (18) according to any previous claim, wherein the operating frequency band is the FM band.

12. The antenna device (18) according to any previous claim, further comprising the antenna connection point (23) and the inductor (24), the inductance ( $L$ ) of which has been selected together with an antenna capacitance ( $C_r$ ) of the monopole element (20) to match the input impedance ( $Z_{in}$ ) of the amplifier stage (26).

13. The antenna device (18) according to claim 12, further comprising the amplifier stage (26).

14. The antenna device (18) according to claim 13, wherein the amplifier stage (26) has an input impedance ( $Z_{in}$ ) that is ten times or more higher than 50  $\Omega$ .

15. The antenna device (18) according to claim 13 or 14, wherein the amplifier stage (26) includes one or more GaAs FET transistors (36).

16. The antenna device (18) according to claim 15, wherein said GaAS FET transistors (36) include one or more GaAS pHEMT transistors.

17. A portable electronic device (10) comprising  
5 in its interior

- a ground plane (34), an antenna connection point (23), an inductor (24) connected between said antenna connection point and ground, an amplifier stage (26) with an input connected to the antenna  
10 connection point, a radio circuit (22) connected to an output of the amplifier stage, and
- an antenna device (20) according to any of claims 1 - 9 for receiving radio signals in at least a first operating frequency band and being connected to the  
15 antenna connection point (23).

18. A portable electronic device (10) according to claim 17, wherein the inductance ( $L$ ) of the inductor (24) has been selected together with an antenna capacitance ( $C_r$ ) of the antenna device to match the  
20 input impedance ( $Z_{in}$ ) of the amplifier stage (26).

19. A portable electronic device (10) according to claim 17 or 18, wherein the amplifier stage (26) has an input impedance ( $Z_{in}$ ) that is ten times or more higher than 50  $\Omega$ .

20. A portable electronic device (10) according to claim 19, wherein the amplifier stage includes one or more GaAS FET transistors (36).

21. A portable electronic device (300) according to claim 20, wherein said GaAS FET transistors (36) include one or more GaAS pHEMT transistors.

22. The portable electronic device according to  
5 any of claims 17 - 21, wherein the ground plane (34) extends over an area that is limited by a number of corners and said antenna connection point (23) is provided adjacent one of these corners of the ground plane.

## ABSTRACT

An antenna device (18) for a portable electronic device, preferably for the FM frequency range,  
5 comprises a monopole radiating and/or radiation receiving element (20) including a feeding portion adapted to be connected to an antenna connection point (23), where an inductor (24) is connectable between the antenna connection point (23) and ground and the input  
10 of an amplifier stage (26) is also connectable to said antenna connection point (23), where an output of the amplifier stage (26) is connectable to a radio circuit (22), all provided in the interior of the portable electronic device.

15

(FIG. 3)

1/3

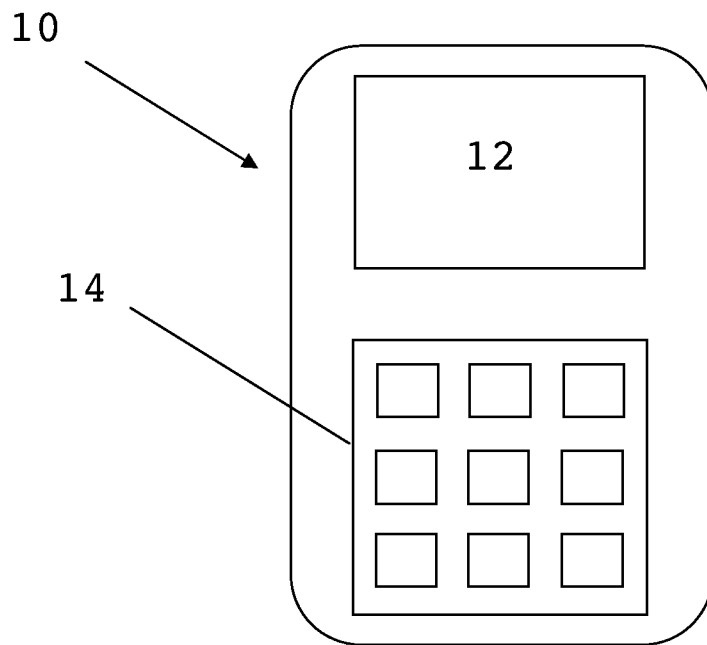


FIG. 1

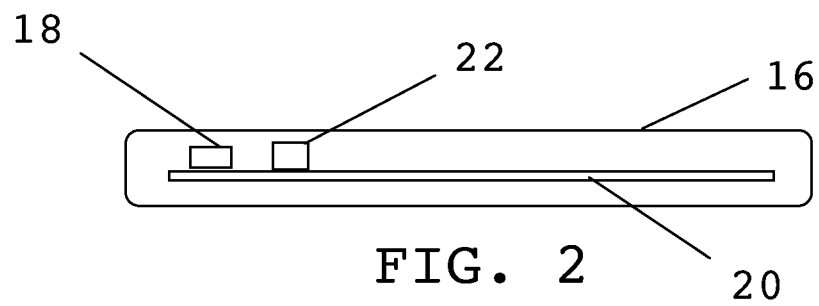


FIG. 2

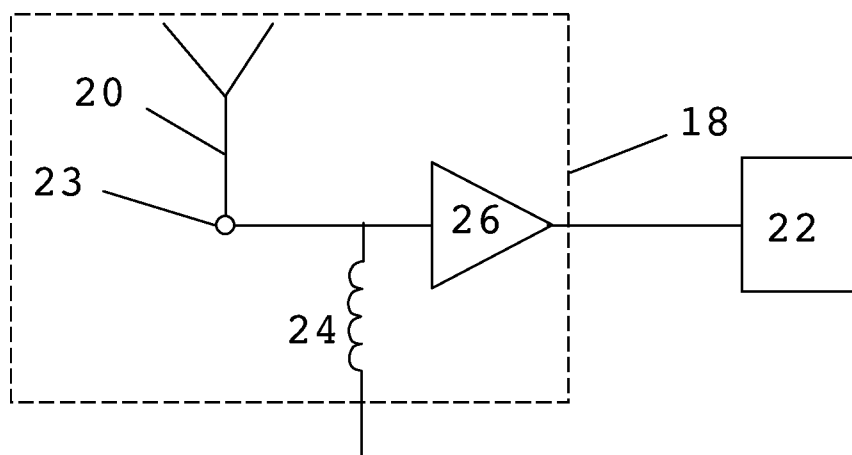


FIG. 3

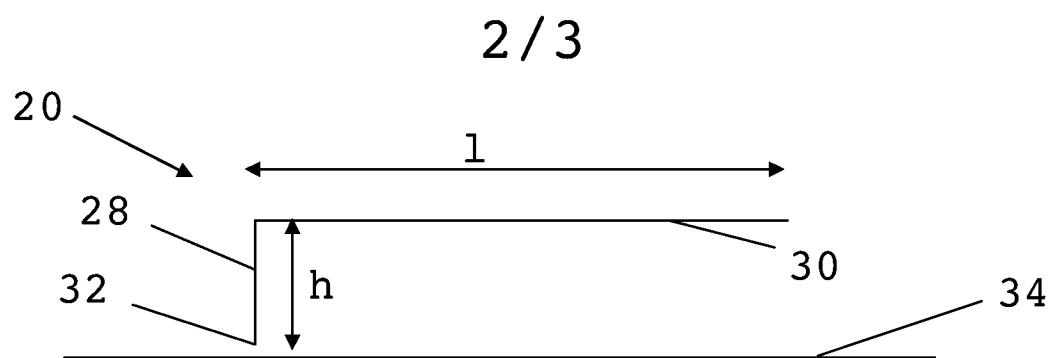


FIG. 4

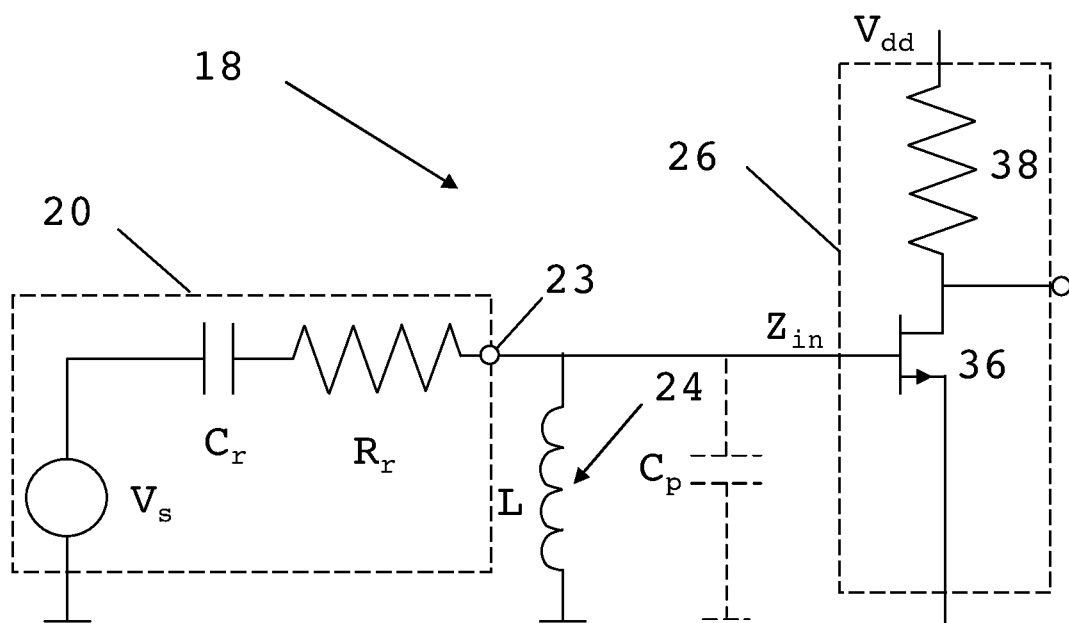


FIG. 5

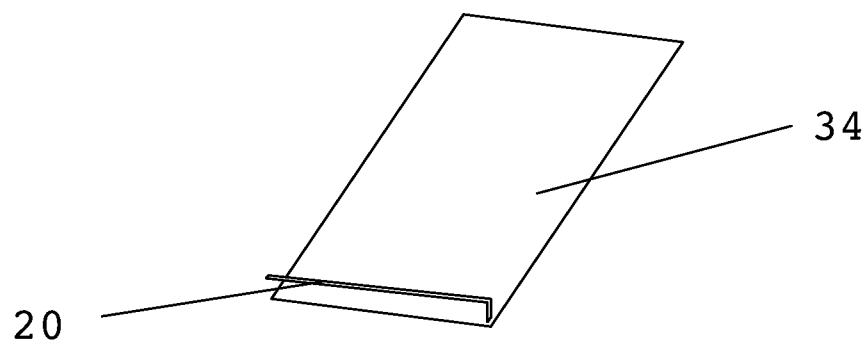


FIG. 6

3/3

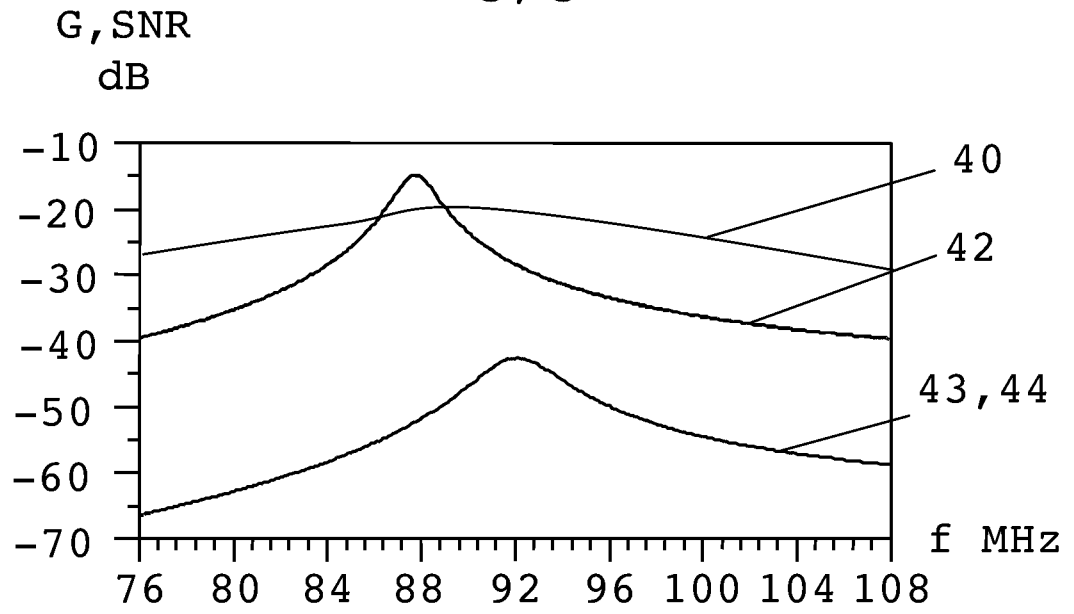


FIG. 7

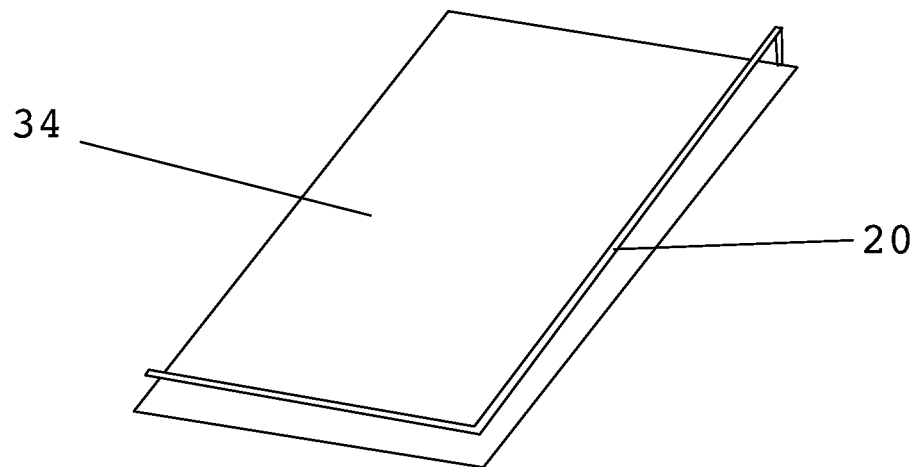


FIG. 8

## PATENT COOPERATION TREATY

PCT/SE2009/050910

From the INTERNATIONAL BUREAU

**PCT**

NOTIFICATION CONCERNING  
TRANSMITTAL OF COPY OF INTERNATIONAL  
PRELIMINARY REPORT ON PATENTABILITY  
(CHAPTER I OF THE PATENT COOPERATION  
TREATY)  
(PCT Rule 44bis.1(c))

To:

DAHNER, Christer  
Kransell & Wennborg KB  
P.O. Box 27834  
S-115 93 Stockholm  
SUEDE

Date of mailing (day/month/year) 03 February 2011 (03.02.2011)		
Applicant's or agent's file reference 08325PC/CD		IMPORTANT NOTICE
International application No. PCT/SE2009/050910	International filing date (day/month/year) 21 July 2009 (21.07.2009)	Priority date (day/month/year) 21 July 2008 (21.07.2008)
Applicant LAIRD TECHNOLOGIES AB et al		

The International Bureau transmits herewith a copy of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Authorized officer  Nora Lindner
Facsimile No. +41 22 338 82 70	e-mail: <a href="mailto:pt11.pct@wipo.int">pt11.pct@wipo.int</a>

# PATENT COOPERATION TREATY

# PCT

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 08325PC/CD	<b>FOR FURTHER ACTION</b>	See item 4 below
International application No. PCT/SE2009/050910	International filing date ( <i>day/month/year</i> ) 21 July 2009 (21.07.2009)	Priority date ( <i>day/month/year</i> ) 21 July 2008 (21.07.2008)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant LAIRD TECHNOLOGIES AB		

1.	This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 <i>bis</i> .1(a).																								
2.	<p>This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p>In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.</p>																								
3.	<p>This report contains indications relating to the following items:</p> <table style="width: 100%; border: none;"> <tr> <td style="width: 5%; text-align: center;"><input checked="" type="checkbox"/></td> <td style="width: 25%;">Box No. I</td> <td style="width: 70%;">Basis of the report</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. II</td> <td>Priority</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td style="text-align: center;"><input checked="" type="checkbox"/></td> <td>Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table>	<input checked="" type="checkbox"/>	Box No. I	Basis of the report	<input type="checkbox"/>	Box No. II	Priority	<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input type="checkbox"/>	Box No. IV	Lack of unity of invention	<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement	<input type="checkbox"/>	Box No. VI	Certain documents cited	<input type="checkbox"/>	Box No. VII	Certain defects in the international application	<input type="checkbox"/>	Box No. VIII	Certain observations on the international application
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<input type="checkbox"/>	Box No. II	Priority																							
<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability																							
<input type="checkbox"/>	Box No. IV	Lack of unity of invention																							
<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement																							
<input type="checkbox"/>	Box No. VI	Certain documents cited																							
<input type="checkbox"/>	Box No. VII	Certain defects in the international application																							
<input type="checkbox"/>	Box No. VIII	Certain observations on the international application																							
4.	The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).																								

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland  Facsimile No. +41 22 338 82 70	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 100%;">Date of issuance of this report 25 January 2011 (25.01.2011)</td> </tr> <tr> <td>Authorized officer  <div style="text-align: center; font-weight: bold;">Nora Lindner</div></td> </tr> <tr> <td>e-mail: pt11.pct@wipo.int</td> </tr> </table>	Date of issuance of this report 25 January 2011 (25.01.2011)	Authorized officer  <div style="text-align: center; font-weight: bold;">Nora Lindner</div>	e-mail: pt11.pct@wipo.int
Date of issuance of this report 25 January 2011 (25.01.2011)				
Authorized officer  <div style="text-align: center; font-weight: bold;">Nora Lindner</div>				
e-mail: pt11.pct@wipo.int				

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:  
DAHNÉR, Christer  
Kransell & Wennborg KB  
P.O. Box 27834  
115 93 STOCKHOLM  
Sverige

## PCT

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Date of mailing  
(day/month/year) **05 -11- 2009**

Applicant's or agent's file reference  
**08325PC/CD**

**FOR FURTHER ACTION**  
See paragraph 2 below

International application No.  
**PCT/SE2009/050910**

International filing date (day/month/year)  
**21-07-2009**

Priority date (day/month/year)  
**21-07-2008**

International Patent Classification (IPC) or both national classification and IPC  
**See Supplemental Box**

Applicant  
**LAIRD TECHNOLOGIES AB et al**

**1. This opinion contains indications relating to the following items:**

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

**2. FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further opinions, see Form PCT/ISA/220.

**3. For further details, see notes to Form PCT/ISA/220.**

Name and mailing address of the ISA/SE  
Patent- och registreringsverket  
Box 5055  
S-102 42 STOCKHOLM

Authorized officer

Rune Bengtsson / JA A

Facsimile No. +46 8 667 72 88

Telephone No. +46 8 782 25 00

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/SE2009/050910

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

Continuation of: Cover sheet

International patent classification (IPC)

H01Q 1/24 (2006.01)

H01Q 1/38 (2006.01)

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/SE2009/050910

Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of:  
☒ the international application in the language in which it was filed  
☐ a translation of the international application into \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).
2. ☐ This opinion has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43bis.1(a)).
3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material  
☐ a sequence listing  
☐ table(s) related to the sequence listing
  - b. format of material  
☐ on paper  
☐ in electronic form
  - c. time of filing/furnishing  
☐ contained in the international application as filed.  
☐ filed together with the international application in electronic form.  
☐ furnished subsequently to this Authority for the purposes of search.
4. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
5. Additional comments:

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/SE2009/050910

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1-22	YES
	Claims		NO
Inventive step (IS)	Claims	1-22	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-22	YES
	Claims		NO

2. Citations and explanations:

Documents cited in the International Search Report:

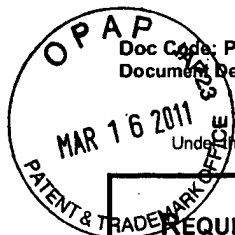
D1: EP 1542313 A1  
D2: WO2008126724 A1  
D3: US 6526263 B1

The cited documents represent the general state of the art.

The invention defined in claims 1-22 is not disclosed by any of these documents.

The cited prior art does not give any indication that would lead a person skilled in the art to the claimed antenna device or portable electronic device. Therefore, the claimed invention is not obvious to a person skilled in the art.

Accordingly, the invention defined in claims 1-22 is novel and is considered to involve an inventive step. The invention is industrially applicable.



Doc Code: PPH.PCT.652

Document Description: Petition to make special under PCT-Patent Pros Hwy

PTO/SB/20PCT-EP (05-10)

Approved for use through 01/31/2012. OMB 0651-0058

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION  
HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE EUROPEAN PATENT OFFICE (EPO) AND  
THE USPTO**

Application No:	12/675,109	Filing date:	February 24, 2010
First Named Inventor:	Yuantao Luan		
Title of the Invention:	ANTENNA DEVICE AND PORTABLE ELECTRONIC DEVICE COMPRISING SUCH AN ANTENNA DEVICE		

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE  
SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT  
[HTTP://WWW.USPTO.GOV/EBS/EFIS\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE  
ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT  
application number(s) is/are:** PCT/SE2009/050910

**The international filing date of the corresponding  
PCT application(s) is/are:** July 21, 2009

**I. List of Required Documents:**

**a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified  
corresponding PCT application(s)**

☒ Is attached

☐ Is not attached because the document is already in the U.S. application.

**b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the  
above-identified corresponding PCT application(s).**

☒ Is attached.

☐ Is not attached because the document is already in the U.S. application.

**c. English translations of the documents in a. and b. above are attached (if the documents are not in the English  
language). A statement that the English translation is accurate is attached for the document in b. above.**

[Page 1 of 2]

This collection of information is required by 35 U.S.C. 119, 37 CFR 1.55, and 37 CFR 1.102(d). The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

**MAIL**

**APR 15 2011**

**DIRECTOR'S OFFICE  
TECHNOLOGY CENTER 2600**

HARNESS, DICKEY, & PIERCE, P.L.C.  
7700 Bonhomme, Suite 400  
ST. LOUIS MO 63105

In re Application of	:	
LUAN, YUANTAO	:	DECISION ON REQUEST TO
Application No. 12/675,109	:	PARTICIPATE IN PATENT
Filed: February 24, 2010	:	PROSECUTION HIGHWAY
Attorney Docket No. 9062E-000450/US/NP:	:	PROGRAM AND PETITION
	:	TO MAKE SPECIAL UNDER
	:	37 CFR 1.102(a)

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PPH) pilot program and the petition under 37 CFR 1.102(a), filed March 16, 2011 to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application be (a) a national stage entry of the corresponding PCT application, or (b) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (c) a national stage application that claims domestic/foreign priority to the corresponding PCT application, (d) a national application which forms the basis for the priority claim in the corresponding PCT application, or (e) a continuation application of the U.S. application which satisfies one of the above (a) to (d) scenarios.
- (2) A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the corresponding PCT application(s) which indicates at least one claim in the PCT application has novelty, inventive step, and industrial applicability.
- (3) A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the corresponding PCT application(s).
- (4) English translations of the documents in (2) and (3) (if the documents are not in the English language).
- (5) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claims which were indicated as having novelty, inventive step, and industrial applicability in the corresponding PCT application(s).
- (6) Examination of the U.S. application has not begun; and
- (7) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application(s).

The request to participate in the PCT-PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Ken Wieder at 571-272-2986.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

/Kenneth A. Wieder/

---

Kenneth A. Wieder  
Quality Assurance Specialist  
Technology Center 2600  
Communications



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

DESIGN IP, P.C.  
5100 W. TILGHMAN STREET  
SUITE 205  
ALLENTOWN PA 18104

**MAILED**  
**DEC 19 2011**

**OFFICE OF PETITIONS**

In re Application:  
Bacanovic et al.  
Application No. 12/675,150  
Filed: February 25, 2010  
Attorney Docket No. PCL-P0001

:  
:  
:  
:  
:

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed November 8, 2011.

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

/Joan Olszewski/  
Joan Olszewski  
Petitions Examiner  
Office of Petitions



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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**MAILED**

MAY 02 2011

PCT LEGAL ADMINISTRATION

NIXON & VANDERHYE, PC  
901 NORTH GLEBE ROAD, 11TH FLOOR  
ARLINGTON VA 22203

In re Application of	:	
MATTELMAKI et al.	:	DECISION ON
Application No.: 12/675,249	:	
PCT No.: PCT/FI2008/000094	:	PAPERS
Int. Filing Date: 20 August 2008	:	
Priority Date: 03 September 2007	:	UNDER 37 CFR 1.42
Attorney's Docket No.: JHN-30-608	:	
For: METHOD IN THE TREATMENT OF ODOROUS	:	
GASES OF A CHEMICAL PULP MILL	:	

This is a decision on the submission filed by applicants on 31 January 2011, which was accompanied by, *inter alia*, a declaration of the inventors. The indication in the declaration that inventor Kari SAVIHARJU is deceased has been treated as a request for status under 37 CFR 1.42.

### **BACKGROUND**

On 20 August 2008, applicants filed international application PCT/FI2008/000094, which designated the U.S. and claimed a priority date of 03 September 2007. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 12 March 2009. The thirty-month period for paying the basic national fee in the United States expires at midnight on 03 March 2010.

On 25 February 2010, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee.

On 31 August 2010, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS (Form PCT/DO/EO/905) indicating, *inter alia*, that a declaration of inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 31 January 2010, applicants filed a submission which included a declaration of inventors. The indication in the declaration that inventor Kari SAVIHARJU is deceased has been treated as a request for status under 37 CFR 1.42.

### **DISCUSSION**

The "DECLARATION OF DECEASED INVENTOR KARI SAVIHARJU" filed 31 January 2011 is not sufficient because it contains non-initialed alterations: the names of each of the heirs; the address of each of the heirs; and the citizenship of each of the heirs. "Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will require a new oath or declaration if the alterations are not initialed and dated." MPEP § 605.04(a). Item I.

If a new "DECLARATION OF DECEASED INVENTOR KARI SAVIHARJU" is submitted, it must be attached to an otherwise complete declaration. This otherwise complete declaration would not need to be signed by joint inventor Esko Mattelmaki.

The submission of the declaration executed by all the heirs is hereby construed as an indication that no legal representative of the deceased's estate has been appointed and that no legal representative is required by the applicable law to be appointed and thus all the heirs are signing as the legal representative of the estate. If this interpretation is incorrect applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

### **CONCLUSION**

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicant is required to submit a proper declaration within a time period of **TWO (2) MONTHS** from the mail date of this Decision. A proper declaration is described above. **THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.** Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/  
Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs

Application No.: 12/675,249

-3-

Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301



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AUG 01 2011

PCT LEGAL ADMINISTRATION

NIXON & VANDERHYE, PC  
901 NORTH GLEBE ROAD, 11TH FLOOR  
ARLINGTON VA 22203

In re Application of	:	
MATTELMAKI et al.	:	DECISION ON
Application No.: 12/675,249	:	
PCT No.: PCT/FI2008/000094	:	PAPERS
Int. Filing Date: 20 August 2008	:	
Priority Date: 03 September 2007	:	UNDER 37 CFR 1.42
Attorney's Docket No.: JHN-30-608	:	
For: METHOD IN THE TREATMENT OF ODOROUS	:	
GASES OF A CHEMICAL PULP MILL	:	

This is a decision on applicants' renewed submission under 37 CFR 1.42 filed in the United States Patent and Trademark Office (USPTO) on 12 May 2011.

**BACKGROUND**

On 20 August 2008, applicants filed international application PCT/FI2008/000094, which designated the U.S. and claimed a priority date of 03 September 2007. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 12 March 2009. The thirty-month period for paying the basic national fee in the United States expires at midnight on 03 March 2010.

On 25 February 2010, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee.

On 31 August 2010, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS (Form PCT/DO/EO/905) indicating, *inter alia*, that a declaration of inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 31 January 2010, applicants filed a submission which included a declaration of inventors. The indication in the declaration that inventor Kari SAVIHARJU is deceased was properly treated as a request for status under 37 CFR 1.42.

On 02 May 2011, a decision was issued refusing applicants' request for status under 37 CFR 1.42.

On 12 May 2011, applicants filed the instant renewed petition under 37 CFR 1.42.

### **DISCUSSION**

The decision issued 12 May 2011 indicated that the "DECLARATION OF DECEASED INVENTOR KARI SAVIHARJU" filed 31 January 2011 was not sufficient because it contains non-initialed alterations: the names of each of the heirs; the address of each of the heirs, and the citizenship of each of the heirs. Upon further review, and as noted in the renewed petition, the hand-written information are not alterations but rather only information supplied by the heirs in the blank lines provided for that information.

Accordingly, the submission filed 12 May 2011 is in compliance with 37 CFR 1.42. The declarations filed 12 May 2011 are in compliance with 37 CFR 1.497(a)-(b).

### **CONCLUSION**

For the above reasons, the request for status under 37 CFR 1.42 is **ACCEPTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application in accordance with this decision.

/Daniel Stemmer/

Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301



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United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

EDWARDS ANGELL PALMER & DODGE LLP  
P.O. BOX 55874  
BOSTON MA 02205

**MAILED**

**APR 29 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of  
KELLER, et al.  
U.S. Application No.: 12/675,257  
PCT No.: PCT/EP2008/007090  
International Filing Date: 29 August 2008  
Priority Date: 31 August 2007  
Attorney's Docket No.: 85463 (45107)  
For: AEROSOLS FOR SINUNASAL DRUG  
DELIVERY

**DECISION**

This decision is in response to applicant's "SECOND REQUEST FOR REFUND" filed 14 February 2011 and "STATUS INQUIRY" filed 04 April 2011 in the United States Patent and Trademark Office (USPTO). Applicant seeks a refunding of \$3822.00 in fees charged on 07 September 2010 to applicant's deposit account.

**BACKGROUND**

On 29 August 2008, applicant filed international application PCT/EP2008/007090 which claimed priority to an earlier application filed 31 August 2007. A copy of the international application was communicated from the International Bureau (IB) to the United States on 05 March 2009. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 February 2010.

On 25 February 2010, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1), an application data sheet and a preliminary amendment. Applicant also authorized the charging of all additional fees to deposit account number 04-1105.

On 07 September 2010, applicant's deposit account was charged \$3432.00 for total claims over twenty and \$390.00 for multiple dependent claims.

On 20 January 2011, applicant filed a request for refund of these fees.

On 28 January 2011, applicant was mailed a communication informing applicant that the request for refund had been denied. Specifically, the office noted that claims 48-53 of the preliminary amendment of 25 February 2011 were dependent of claims 1-12 resulting in 72 additional claims and a multiple dependency charge.

On 14 February 2011, applicant filed the second request for refund discussed herein accompanied by a second preliminary amendment amending claim 48 to remove multiple dependency.

### **DISCUSSION**

The Manual of Patent Examining Procedure (MPEP) section 1893.01 (c) explains that:

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that \*>is effective to cancel< claims and/or \*>eliminate< multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492(d)-(e) and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492(f). A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608.

In the present case, applicant authorized the charging of all necessary fees upon entering the U.S. national stage. Therefore, the fees were properly charged. As shown above, it is not possible to refund previously paid fees based on a subsequently filed preliminary amendment and as such, it is not possible to grant applicant's request for refund and the request is **DISMISSED**.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration or electronically filed utilizing the USPTO's EFS-Web electronic filing system.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: 571-272-3294

Doc Code: PET.GREEN

Document Description: Petition for Green Tech Pilot

PTO/SB/420 (12-09)

Approved for use through 05/31/2010. OMB 0651-0062

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket  
Number: TMP-037

Application Number  
(if known): 12/675,258

Filing date: February 25, 2010

First Named  
Inventor: Tohru MINAMI et al.

Title: WIND TURBINE GENERATOR AND SOUNDNESS DIAGNOSIS METHOD THEREOF

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request. Applicant hereby rescinds under 37 CFR 1.213(b) any previous filed request that the above-identified application not be published under 35 U.S.C. 122(b).**

**If the application has been published, the petition must still be accompanied by the publication fee set forth in 37 CFR 1.18(d) and a statement that the application has been published.**

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirement and classification requirement set forth in the notice entitled "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" that was published in the Federal Register if the Office determines that the claims are not obviously directed to a single invention.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: \_\_\_\_\_

Signature /Benjamin J. Hauptman/

Date November 17, 2011

Name  
(Print/Typed) Benjamin J. Hauptman

Registration Number 29,310

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Instruction Sheet for  
Petition to Make Special Under the Green Technology Pilot Program**  
(Not to be Submitted to the USPTO)

***The following is a summary of the requirements (for more information see notice "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/oqsheet.html>):***

- (1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371. The application must be previously filed before the publication date of the notice cited above. Reexamination proceedings are excluded from this pilot program.
- (2) The application must be classified in one of the U.S. classifications listed in section VI of the notice cited above at the time of examination.
- (3) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed.
- (4) The claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to: (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) green house gas emission reduction (see the eligibility requirements of sections II and III of the notice cited above). The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview, and elect an invention that meets the eligibility requirements in section II or III of the notice cited above and is classified in one of the U.S. classifications listed in section VI of the notice cited above.
- (5) The petition to make special must be timely filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen. Applicant should use form PTO/SB/420, which will be available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site.
- (6) The petition to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.
- (7) The petition to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Docket No.: TMP-037

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of :  
Tohru MINAMI et al. : Confirmation No. 3064  
U.S. Patent Application No.: 12/675,258 :  
Filed: February 25, 2010 :

For: WIND TURBINE GENERATOR AND SOUNDNESS DIAGNOSIS METHOD  
THEREOF

**STATEMENT OF SPECIAL STATUS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Statement of Special Status is filed in conjunction with a Petition to Make Special Under the Green Technology Pilot Program.

The above-referenced application pertains to environmental quality, i.e. development of wind turbine generator. Special status is sought, because the invention materially contributes to the discovery or development of renewable energy resources.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 11-0219 and please credit any excess fees to such deposit account.

Respectfully submitted,

**KANESAKA BERNER & PARTNERS**

  
Benjamin J. Hauptman  
Registration No. 29,310

1700 Diagonal Road, Suite 300  
Alexandria, Virginia 22314  
(703) 519-9785  
Facsimile: (703) 519-7769  
Date: November 17, 2011  
BJH/tal



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,258	08/02/2010	Tohru Minami	TMP-037	3064
<div>32628      7590      12/21/2011</div> <div>KANESAKA BERNER AND PARTNERS LLP</div> <div>1700 DIAGONAL RD</div> <div>SUITE 310</div> <div>ALEXANDRIA, VA 22314-2848</div>				
			EXAMINER	
			TA, THO DAC	
			ART UNIT	PAPER NUMBER
			2839	
			MAIL DATE	DELIVERY MODE
			12/21/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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KANESAKA BERNER AND PARTNERS LLP  
1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA VA 22314-2848

DEC 21 2011

In re Application of	:	
MINAMI et al.	:	DECISION ON PETITION
Application No. 12/675,258	:	TO MAKE SPECIAL UNDER
Filed: August 2, 2010	:	THE GREEN TECHNOLOGY
Attorney Docket No. TMP-037	:	PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed on November 17, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded “special” status.

Telephone inquiries concerning this decision should be directed to Colleen Dunn at 571-272-1170.

The application is being forwarded to the appropriate Technology Center Art Unit for action on the merits commensurate with this decision.

/Colleen Dunn/

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Colleen Dunn  
TQAS, TC 2800

Doc Code: PET.GREEN

Document Description: Petition for Green Tech Pilot

PTO/SB/420 (12-09)

Approved for use through 05/31/2010. OMB 0651-0062

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket Number: <b>TMP-031</b>	Application Number (if known): <b>12/675,271</b>	Filing date: <b>June 9, 2010</b>
--	--	----------------------------------

First Named Inventor: **Tohru MINAMI**

Title: **WIND TURBINE GENERATOR AND METHOD OF CONTROLLING THE SAME**

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request. Applicant hereby rescinds under 37 CFR 1.213(b) any previous filed request that the above-identified application not be published under 35 U.S.C. 122(b).**

**If the application has been published, the petition must still be accompanied by the publication fee set forth in 37 CFR 1.18(d) and a statement that the application has been published.**

- By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirement and classification requirement set forth in the notice entitled "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" that was published in the Federal Register if the Office determines that the claims are not obviously directed to a single invention.
- This request is accompanied by statements of special status for the eligibility requirement.
- The application contains no more than three (3) independent claims and twenty (20) total claims.
- The application does not contain any multiple dependent claims.
- Other attachments: \_\_\_\_\_

Signature **/Benjamin J. Hauptman/**

Date **November 16, 2011**

Name (Print/Typed) **Benjamin J. Hauptman**

Registration Number **29,310**

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Instruction Sheet for  
Petition to Make Special Under the Green Technology Pilot Program**  
(Not to be Submitted to the USPTO)

***The following is a summary of the requirements (for more information see notice "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/oqsheet.html>):***

- (1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371. The application must be previously filed before the publication date of the notice cited above. Reexamination proceedings are excluded from this pilot program.
- (2) The application must be classified in one of the U.S. classifications listed in section VI of the notice cited above at the time of examination.
- (3) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed.
- (4) The claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to: (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) green house gas emission reduction (see the eligibility requirements of sections II and III of the notice cited above). The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview, and elect an invention that meets the eligibility requirements in section II or III of the notice cited above and is classified in one of the U.S. classifications listed in section VI of the notice cited above.
- (5) The petition to make special must be timely filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen. Applicant should use form PTO/SB/420, which will be available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site.
- (6) The petition to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.
- (7) The petition to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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Address: COMMISSIONER FOR PATENTS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,271	06/09/2010	Tohru Minami	TMP-031	3143
32628 7590 12/07/2011 KANESAKA BERNER AND PARTNERS LLP 1700 DIAGONAL RD SUITE 310 ALEXANDRIA, VA 22314-2848			EXAMINER LOOK, EDWARD K	
			ART UNIT	PAPER NUMBER
			3745	
			MAIL DATE	DELIVERY MODE
			12/07/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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KANESAKA BERNER AND PARTNERS LLP  
1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA VA 22314-2848

In re Application of  
MINAMI, TOHRU et. al.  
Application No. 12/675,271  
Filed: June 9, 2010  
Attorney Docket No. TMP-031

DECISION ON PETITION  
TO MAKE SPECIAL UNDER  
THE GREEN TECHNOLOGY  
PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed November 16, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth in 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **granted**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within ONE (1) MONTH OR THIRTY (30) DAYS from the mail date of this decision, whichever is longer. No extension of this time limit can be granted under 37 CFR 1.136(a) or (b). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by

a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded “special” status.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen at 571-272-4856.

This application will be forwarded to the Technology Center Art Unit 3745 for action on the merits commensurate with this decision.

/Henry C. Yuen/

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Henry C. Yuen  
Quality Assurance Specialist  
Technology Center TC 3700

Doc Code: PET.GREEN

Document Description: Petition for Green Tech Pilot

PTO/SB/420 (12-09)

Approved for use through 05/31/2010. OMB 0651-0062

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket  
Number: TMP-034

Application Number  
(if known): 12/675,294

Filing date: February 25, 2010

First Named  
Inventor: Nobuhiko YOSHIDA et al.

Title: LINK PIN EXCHANGING DEVICE FOR WIND TURBINE GENERATOR AND LINK PIN EXCHANGING METHOD

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request. Applicant hereby rescinds under 37 CFR 1.213(b) any previous filed request that the above-identified application not be published under 35 U.S.C. 122(b).**

**If the application has been published, the petition must still be accompanied by the publication fee set forth in 37 CFR 1.18(d) and a statement that the application has been published.**

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirement and classification requirement set forth in the notice entitled "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" that was published in the Federal Register if the Office determines that the claims are not obviously directed to a single invention.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: \_\_\_\_\_

Signature /Benjamin J. Hauptman/

Date February 26, 2011

Name  
(Print/Typed) Benjamin J. Hauptman

Registration Number 29,310

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Instruction Sheet for  
Petition to Make Special Under the Green Technology Pilot Program**  
(Not to be Submitted to the USPTO)

***The following is a summary of the requirements (for more information see notice "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/oqsheet.html>):***

- (1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371. The application must be previously filed before the publication date of the notice cited above. Reexamination proceedings are excluded from this pilot program.
- (2) The application must be classified in one of the U.S. classifications listed in section VI of the notice cited above at the time of examination.
- (3) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed.
- (4) The claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to: (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) green house gas emission reduction (see the eligibility requirements of sections II and III of the notice cited above). The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview, and elect an invention that meets the eligibility requirements in section II or III of the notice cited above and is classified in one of the U.S. classifications listed in section VI of the notice cited above.
- (5) The petition to make special must be timely filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen. Applicant should use form PTO/SB/420, which will be available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site.
- (6) The petition to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.
- (7) The petition to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Docket No.: TMP-034

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

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:  
:  
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Confirmation No. 3266

Nobuhiko YOSHIDA et al.

U.S. Patent Application No.: 12/675,294

Filed: February 25, 2010

For: LINK PIN EXCHANGING DEVICE FOR WIND TURBINE GENERATOR AND  
LINK PIN EXCHANGING METHOD

**STATEMENT OF SPECIAL STATUS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Statement of Special Status is filed in conjunction with a Petition to Make Special Under the Green Technology Pilot Program.

The above-referenced application pertains to environmental quality, i.e. development of wind turbine generator. Special status is sought, because the invention materially contributes to the discovery or development of renewable energy resources.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 11-0219 and please credit any excess fees to such deposit account.

Respectfully submitted,

**KANESAKA BERNER & PARTNERS**

  
Benjamin J. Hauptman  
Registration No. 29,310

1700 Diagonal Road, Suite 300  
Alexandria, Virginia 22314  
(703) 519-9785  
Facsimile: (703) 519-7769  
Date: February 26, 2011  
BJH/tal



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,294	06/09/2010	Nobuhiko Yoshida	TMP-034	3266
32628 7590 11/02/2011 KANESAKA BERNER AND PARTNERS LLP 1700 DIAGONAL RD SUITE 310 ALEXANDRIA, VA 22314-2848			EXAMINER	
			ART UNIT	PAPER NUMBER
			3745	
			MAIL DATE	DELIVERY MODE
			11/02/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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KANESAKA BERNER AND PARTNERS LLP  
1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA VA 22314-2848

In re Application of  
YOSHIDA, NOBUHIKO et al  
Application No. 12/675,294  
Filed: Feb. 25, 2010  
Attorney Docket No. TMP-034

:

: DECISION ON PETITION  
: TO MAKE SPECIAL UNDER  
: THE GREEN TECHNOLOGY  
: PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed Feb. 26, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth in 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **granted**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within ONE (1) MONTH OR THIRTY (30) DAYS from the mail date of this decision, whichever is longer. No extension of this time limit can be granted under 37 CFR 1.136(a) or (b). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by

a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded “special” status.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen at 571-272-4856.

This application will be forwarded to the Technology Center Art Unit 3745 for action on the merits commensurate with this decision.

/Henry C. Yuen/

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Henry C. Yuen  
Quality Assurance Specialist  
Technology Center TC 3700

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE EUROPEAN PATENT OFFICE (EPO) AND THE USPTO

Application No:	12/675,297	Filing date:	2010-02-25
First Named Inventor:	Hanns Wochner		

Title of the  
Invention: **METHOD FOR PURIFYING POLYCRYSTALLINE SILICON**

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBS/EF5\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/EP2008/060425

**The international filing date of the corresponding PCT application(s) is/are:** August 8, 2008

## I. List of Required Documents:

- a. **A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**

☒

Is attached

☐

Is not attached because the document is already in the U.S. application.

- b. **A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**

☐

Is attached.

☒

Is not attached because the document is already in the U.S. application.

- c. **English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM  
BETWEEN THE EPO AND THE USPTO**

(continued)

Application No.:	12/675,297
First Named Inventor:	Hanns Wochner

- d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

☐

Is attached

☒

Has already been filed in the above-identified U.S. application on

March 22, 2010

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)

☐

Are attached.

☒

Have already been filed in the above-identified U.S. application on

March 22, 2010

**II. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
10	1	Rewritten in U.S. format
11	2	Rewritten in U.S. format
12	3	Rewritten in U.S. format
13	4	Rewritten in U.S. format
14	5	Rewritten in U.S. format
15	6	Rewritten in U.S. format
16	7	Rewritten in U.S. format
17	8	Rewritten in U.S. format and to remove multiple dependencies
18	9	Rewritten in U.S. format

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature /William G. Conger/	Date March 9, 2011
Name (Print/Typed) William G. Conger	Registration Number 31209

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant ( i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,297	02/25/2010	Hanns Wochner	WAS1054PUSA	3277
22045	7590	04/18/2011		
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			EXAMINER COLEMAN, RYAN L	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 04/18/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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EL

April 18, 2011

In re application of	:	DECISION ON REQUEST TO
Wochner, et al.	:	PARTICIPATE IN PATENT
Serial No. 12/675,297	:	PROSECUTION HIGHWAY
Filed: February 25, 2010	:	PROGRAM AND
For: <b>METHOD FOR PURIFYING</b>	:	PETITION TO MAKE SPECIAL
<b>POLYCRYSTALLINE SILICON</b>	:	UNDER 37 CFR 1.102(a)

This is a decision on the request for reconsideration to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed March 09, 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

(1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, or USPTO;

(2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;

(3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;

(4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);

(5) Examination of the U.S. application has not begun;

(6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof if the latest international work product is not in the English language; and

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Emily M. Le, Supervisory Patent Examiner, at (571) 272-0903.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Emily M. Le/

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Emily M. Le  
Supervisory Patent Examiner  
Technology Center 1700

Doc Code: PET.GREEN

Document Description: Petition for Green Tech Pilot

PTO/SB/420 (12-09)

Approved for use through 05/31/2010. OMB 0651-0062

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

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## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket  
Number: TMP-039

Application Number  
(if known): 12/675,310

Filing date: February 25, 2010

First Named  
Inventor: Tohru MINAMI et al

Title: MAINTENANCE OPERATION METHOD FOR WIND TURBINE GENERATOR AND WIND TURBINE GENERATOR

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request. Applicant hereby rescinds under 37 CFR 1.213(b) any previous filed request that the above-identified application not be published under 35 U.S.C. 122(b).**

**If the application has been published, the petition must still be accompanied by the publication fee set forth in 37 CFR 1.18(d) and a statement that the application has been published.**

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirement and classification requirement set forth in the notice entitled "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" that was published in the Federal Register if the Office determines that the claims are not obviously directed to a single invention.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: \_\_\_\_\_

Signature /Manabu KANESAKA/

Date February 25, 2011

Name  
(Print/Typed) Manabu KANESAKA

Registration Number 31,467

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Instruction Sheet for  
Petition to Make Special Under the Green Technology Pilot Program**  
(Not to be Submitted to the USPTO)

***The following is a summary of the requirements (for more information see notice "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/oqsheet.html>):***

- (1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371. The application must be previously filed before the publication date of the notice cited above. Reexamination proceedings are excluded from this pilot program.
- (2) The application must be classified in one of the U.S. classifications listed in section VI of the notice cited above at the time of examination.
- (3) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed.
- (4) The claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to: (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) green house gas emission reduction (see the eligibility requirements of sections II and III of the notice cited above). The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview, and elect an invention that meets the eligibility requirements in section II or III of the notice cited above and is classified in one of the U.S. classifications listed in section VI of the notice cited above.
- (5) The petition to make special must be timely filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen. Applicant should use form PTO/SB/420, which will be available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site.
- (6) The petition to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.
- (7) The petition to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,310	04/05/2011	Tohru Minami	TMP-039	3387
32628 7590 05/25/2011 KANESAKA BERNER AND PARTNERS LLP 1700 DIAGONAL RD SUITE 310 ALEXANDRIA, VA 22314-2848			EXAMINER	
			ART UNIT	PAPER NUMBER
			2839	
			MAIL DATE	DELIVERY MODE
			05/25/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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KANESAKA BERNER AND PARTNERS LLP  
1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA VA 22314-2848

In re Application of	:	
MINAMI et al.	:	DECISION ON PETITION
Application No. 12/675,310	:	TO MAKE SPECIAL UNDER
Filed: April 05, 2011	:	THE GREEN TECHNOLOGY
Attorney Docket No. TMP-039	:	PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed on February 25, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

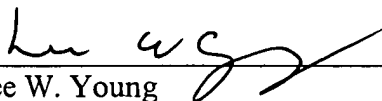
In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Lee W. Young at 571-272-4549.

The application is being forwarded to the Technology Center Art Unit 2839 for action on the merits commensurate with this decision.

  
\_\_\_\_\_  
Lee W. Young  
Quality Assurance Specialist  
Technology Center 2800

Doc Code: PET.GREEN

Document Description: Petition for Green Tech Pilot

PTO/SB/420 (12-09)

Approved for use through 05/31/2010. OMB 0651-0062

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

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## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket  
Number: TMP-040

Application Number  
(if known): 12/675,312

Filing date: February 25, 2010

First Named  
Inventor: Tohru MINAMI et al.

Title: HANDY TERMINAL FOR WIND TURBINE GENERATOR, WIND TURBINE GENERATOR AND WIND POWER SITE

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request. Applicant hereby rescinds under 37 CFR 1.213(b) any previous filed request that the above-identified application not be published under 35 U.S.C. 122(b).**

**If the application has been published, the petition must still be accompanied by the publication fee set forth in 37 CFR 1.18(d) and a statement that the application has been published.**

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirement and classification requirement set forth in the notice entitled "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" that was published in the Federal Register if the Office determines that the claims are not obviously directed to a single invention.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: \_\_\_\_\_

Signature /Benjamin J. Hauptman/

Date November 16, 2011

Name  
(Print/Typed) Benjamin J. Hauptman

Registration Number 29,310

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Instruction Sheet for  
Petition to Make Special Under the Green Technology Pilot Program**  
(Not to be Submitted to the USPTO)

***The following is a summary of the requirements (for more information see notice "Pilot Program for Green Technologies Including Greenhouse Gas Reduction" available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/oqsheet.html>):***

- (1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371. The application must be previously filed before the publication date of the notice cited above. Reexamination proceedings are excluded from this pilot program.
- (2) The application must be classified in one of the U.S. classifications listed in section VI of the notice cited above at the time of examination.
- (3) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed.
- (4) The claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to: (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) green house gas emission reduction (see the eligibility requirements of sections II and III of the notice cited above). The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview, and elect an invention that meets the eligibility requirements in section II or III of the notice cited above and is classified in one of the U.S. classifications listed in section VI of the notice cited above.
- (5) The petition to make special must be timely filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen. Applicant should use form PTO/SB/420, which will be available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site.
- (6) The petition to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.
- (7) The petition to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,312	07/15/2010	Tohru Minami	TMP-040 (10-016US)	3402
32628 7590 12/21/2011 KANESAKA BERNER AND PARTNERS LLP 1700 DIAGONAL RD SUITE 310 ALEXANDRIA, VA 22314-2848			EXAMINER CHANG, SUNRAY	
			ART UNIT 2121	PAPER NUMBER
			MAIL DATE 12/21/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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KANESAKA BERNER AND PARTNERS LLP  
1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA VA 22314-2848

In re Application of:

MINAMI, Tohru et al.

Application No.: 12/675,312

Filed: July 15, 2010

**For: HANDY TERMINAL FOR WIND  
TURBINE GENERATOR, WIND TURBINE  
GENERATOR AND WIND POWER SITE**

DECISION ON PETITION  
TO MAKE SPECIAL UNDER  
THE GREEN TECHNOLOGY  
PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed November 16, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth in 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications and be filed prior to the date of the notice, December 8, 2009.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition

must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the Technology Center Art Unit 2121 for action on the merits commensurate with this decision.

Telephone inquiries concerning this decision should be directed to Eddie C. Lee at 571-272-1732.

/Eddie C. Lee/

Quality Assurance Specialist  
Technology Center 2100



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United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,312	07/15/2010	Tohru Minami	TMP-040 (10-016US)	3402
32628 7590 12/21/2011 KANESAKA BERNER AND PARTNERS LLP 1700 DIAGONAL RD SUITE 310 ALEXANDRIA, VA 22314-2848			EXAMINER CHANG, SUNRAY	
			ART UNIT 2121	PAPER NUMBER
			MAIL DATE 12/21/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA VA 22314-2848

DEC 21 2011

In re Application of	:	
MINAMI et al.	:	DECISION ON PETITION
Application No. 12/675,312	:	TO MAKE SPECIAL UNDER
Filed: February 25, 2010	:	THE GREEN TECHNOLOGY
Attorney Docket No. TMP-040 (10-016US)	:	PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed on November 16, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded “special” status.

Telephone inquiries concerning this decision should be directed to Colleen Dunn at 571-272-1170.

The application is being forwarded to the appropriate Technology Center Art Unit for action on the merits commensurate with this decision.

/Colleen Dunn/

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Colleen Dunn  
TQAS, TC-2800



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KLARQUIST SPARKMAN, LLP  
121 SW SALMON STREET  
SUITE 1600  
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JUL 19 2011

PCT LEGAL ADMINISTRATION

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In re Application of	:	
Goranov	:	
Application No.: 12/675,336	:	DECISION
PCT No.: PCT/CA2008/001550	:	
Int. Filing Date: 29 August 2008	:	ON
Priority Date: 31 August 2007	:	
Attorney Docket No.: 3435-84671-01	:	PETITION
For: Antimicrobial Compositions And	:	
Fibers Incorporating The Same	:	

This is in response to the petition under 37 CFR 1.47(b) filed on 20 December 2010.

### **BACKGROUND**

This international application was filed on 29 August 2008, claimed an earlier priority date of 31 August 2007, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 05 March 2009. The 30 month time period for paying the basic national fee in the United States expired at midnight on 28 February 2010. Applicants filed *inter alia* the basic national fee on 25 February 2010.

On 25 August 2010, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration compliant with 37 CFR 1.497(a) and (b), and a surcharge under 37 CFR 1.492(h).

### **DISCUSSION**

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known addresses of the inventors, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Regarding requirement (1), petitioner has paid \$130.00 toward the \$200.00 petition fee. The \$70.00 balance is being charged to Deposit Account No. 02-4550, per the authorization included in the Transmittal Letter filed on 25 February 2010.

Regarding requirement (2), petitioner has provided a statement by Valerie Leroux, who describes her efforts to obtain Mr. Goranov's execution of the application. She indicates that she emailed a copy the application and a declaration to Mr. Goranov, but there is no positive showing of record that he actually received these transmissions, nor is there a showing that said documents were physically mailed to his last known address. Ms. Leroux has attached a copy of

an email dated 30 March 2010 which refers to the transmission of the declaration, but not a copy of the email accompanying the transmission of the application itself. Petitioner should provide further direct evidence as to whether Mr. Goranov received a copy of the application, and as to the nature of his alleged refusal.

Regarding requirement (3), the petition includes an explicit statement of the inventor's last known address.

Concerning requirement (4), the petition is accompanied by a declaration which satisfies this requirement.

Regarding requirement (5), Valerie Leroux refers to an assignment of a priority application, but this does not automatically entail assignment of the instant invention. She further refers to an agreement to assign (as part of the Consulting Agreement), but it has not been shown clearly that any conditions for that assignment have been satisfied (was the invention made "while providing the Services?"). In addition, Ms. Leroux's statement does not appear to constitute a "Legal Memorandum as described at MPEP 409.03(f). Therefore, requirement (5) has not been satisfied at this time.

Regarding requirement (6), the petition includes a statement that according the application status under 37 CFR 1.47(b) is necessary to preserve the rights of the parties or to prevent irreparable damage.

#### **DECISION**

The petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283



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**MAILED**

**NOV 09 2011**

In re Application of  
Goranov  
Application No.: 12/675,336  
PCT No.: PCT/CA2008/001550  
Int. Filing Date: 29 August 2008  
Priority Date: 31 August 2007  
Attorney Docket No.: 3435-84671-01  
For: Antimicrobial Compositions And  
Fibers Incorporating The Same

DECISION

ON

PETITION

PCT LEGAL ADMINISTRATION

This is in response to the renewed petition under 37 CFR 1.47(b) filed on 02 September 2011.

**DISCUSSION**

As a preliminary matter, the Notification of Abandonment mailed on 22 July 2011 was issued in error (since the period for response had not expired), and it is hereby **VACATED**. The holding of abandonment is **WITHDRAWN**.

In a Decision mailed on 19 July 2011, the petition under 37 CFR 1.47(b) filed on 20 December 2010 was dismissed, without prejudice, because requirements (2) and (5) had not been satisfied.

Regarding requirement (1), petitioner has paid \$130.00 toward the \$200.00 petition fee. The \$70.00 balance is being charged to Deposit Account No. 02-4550, per the authorization included in the Transmittal Letter filed on 25 February 2010. This was discussed in the previous Decision, but the fee transaction did not actually occur at that time.

Regarding requirement (2), petitioner has provided a "Supplemental Statement" by Valerie Leroux, accompanied by supporting documentation. It is noted that certain of the submitted documents have been redacted. It is presumed that the redacted material is not germane to the issue of Dr. Goranov's refusal to execute the application; if this interpretation is not accurate, counsel is required to promptly notify this Office. In view of the totality of the evidence now of record, it would be appropriate to conclude that Dr. Goranov has refused to execute the application after having been presented with a copy of the application and an oath or declaration.

Regarding requirement (5), counsel cites language in a recorded assignment. Petitioner's attention is drawn respectfully to MPEP 409.03(f), which explains (in part) that "An assignment of an application and any 'reissue, division, or continuation of said application' does not itself establish an assignment of a continuation-in-part application. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)." With regard to the agreement to assign (Consulting Agreement), it still is not adequately clear that any conditions for assignment have been satisfied. Petitioner also has not, in the alternative, provided a "Legal Memorandum" as described at MPEP 409.03(f). Therefore, requirement (5) has not been satisfied at this time.

**DECISION**

The petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283



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Konstantin Goranov  
36 Meditation Lane  
P.O. Box 392  
Atkinson, NH 03811

**MAILED**

DEC 19 2011

PCT LEGAL ADMINISTRATION

In re Application of  
Goranov  
Application No.: 12/675,336  
PCT No.: PCT/CA2008/001550  
Int. Filing Date: 29 August 2008  
Priority Date: 31 August 2007  
Attorney Docket No.: 3435-84671-01  
For: Antimicrobial Compositions And  
Fibers Incorporating The Same

Dear Mr. Goranov:

You are named as the sole inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As the named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3283. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Requests for information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1(800) 972-6382 (outside the Washington D.C. area).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283

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In re Application of	:	
Goranov	:	
Application No.: 12/675,336	:	DECISION
PCT No.: PCT/CA2008/001550	:	
Int. Filing Date: 29 August 2008	:	ON
Priority Date: 31 August 2007	:	
Attorney Docket No.: 3435-84671-01	:	PETITION
For: Antimicrobial Compositions And	:	
Fibers Incorporating The Same	:	

This is in response to the renewed petition under 37 CFR 1.47(b) filed on 08 December 2011.

**DISCUSSION**

In a Decision mailed on 09 November 2011, the renewed petition under 37 CFR 1.47(b) filed on 02 September 2011 was dismissed, without prejudice, because requirement (5) had not been satisfied.

In response, counsel has provided "Valerie Leroux's Second Supplemental Statement" which clarifies that the subject matter of the instant application is disclosed in the "corresponding PCT and Provisional application and is covered by the Assignment." In view of the totality of the evidence now of record, it would be appropriate to conclude that requirement (5) has been satisfied. Consequently, all of the requirements for relief under 37 CFR 1.47(b) now have been provided.

**DECISION**

The petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the Office of Patent Application Processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **20 December 2010**.

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283



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**APR 01 2011**  
**OFFICE OF PETITIONS**

In re Application of :  
Stefan Poeschel, et al. :  
Application No. 12/675,374 : **DECISION ON PETITION**  
Filed: February 25, 2010 :  
Attorney Docket No. HANNKE KNS01-061 :

This is a decision on the petition under 37 CFR 1.182, filed, December 8, 2010, to change the name of inventor "Stefan Poeschel" to – Stefan Poeschl --.

The petition is **DISMISSED**.

The request cannot be granted because the petitioner has not provided a copy of the procedure whereby the change of name was effected nor has he provided proof of his actual given name.

In view of the above, the petition under § 1.182 cannot be granted at this time to change the inventor's name.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

By hand: Customer Service Window  
Mail Stop Petitions  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

By fax: (571) 273-8300  
ATTN: Office of Petitions

Telephone inquiries concerning this matter may be directed to April M. Wise at (571) 272-1642.

/Carl Friedman/  
Carl Friedman  
Petitions Examiner  
Office of Petitions

Doc Code: PET.GREEN

Document Description: Petition for Green Tech Pilot

PTO/SB/420 (03-11)

## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket Number: **TMP-038** Application Number (if known): **12/675,417** Filing date: **May 18, 2010**

First Named Inventor: **Tohru MINAMI et al.**

Title: **HANDY TERMINAL FOR WIND TURBINE GENERATOR**

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request.**

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirements for the Green Technology Pilot Program, if the Office determines that the claims are not obviously directed to a single invention. See Instruction Sheet.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: \_\_\_\_\_

Signature **/Kenneth M. Berner/** Date **November 16, 2011**

Name (Print/Typed) **Kenneth M. Berner** Registration Number **37,093**

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**Instruction Sheet for  
Petition to Make Special Under the Green Technology Pilot Program**  
(Not to be Submitted to the USPTO)

***The following is a summary of the requirements (for more information see the notices (i) "Pilot Program for Green Technologies Including Greenhouse Gas Reduction," (ii) "Elimination of Classification Requirement in the Green Technology Pilot Program," and (iii) "Expansion and Extension of the Green Technology Pilot Program," available on the USPTO web site at [http://www.uspto.gov/patents/init\\_events/green\\_tech.jsp](http://www.uspto.gov/patents/init_events/green_tech.jsp)):***

- (1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371, irrespective of the filing date of the application. Reexamination proceedings are excluded from this pilot program.
- (2) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed.
- (3) The claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to: (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) green house gas emission reduction (see the eligibility requirements of sections II and III of the notice (i) cited above). The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview, and elect an invention that meets the eligibility requirements in section II or III of the notice (i) cited above.
- (4) The petition to make special must be timely filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen. Applicant should use form PTO/SB/420, which is available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site.
- (5) The petition to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.
- (6) The petition to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,417	05/18/2010	Tohru Minami	TMP-038	4305

32628 7590 12/14/2011  
KANESAKA BERNER AND PARTNERS LLP  
1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA, VA 22314-2848

EXAMINER
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TA, THO DAC

ART UNIT	PAPER NUMBER
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2839

MAIL DATE	DELIVERY MODE
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12/14/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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1700 DIAGONAL RD  
SUITE 310  
ALEXANDRIA VA 22314-2848

DEC 14 2011

In re Application of	:	
MINAMI et al.	:	DECISION ON PETITION
Application No. 12/675,417	:	TO MAKE SPECIAL UNDER
Filed: February 26, 2010	:	THE GREEN TECHNOLOGY
Attorney Docket No. TMP-038	:	PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed on November 16, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded “special” status.

Telephone inquiries concerning this decision should be directed to Colleen Dunn at 571-272-1170.

The application is being forwarded to the appropriate Technology Center Art Unit for action on the merits commensurate with this decision.

/Colleen Dunn/

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Colleen Dunn  
TQAS, TC 2800



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United States Patent and Trademark Office  
Washington, D.C. 20231  
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MAR 08 2011

PCT LEGAL ADMINISTRATION

BSH HOME APPLIANCES CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
100 BOSCH BOULEVARD  
NEW BERN NC 28562

In re Application of	:	
KARAMATIC et al.	:	DECISION ON
Serial No.: 12/675,513	:	
PCT No.: PCT/EP2008/061143	:	PETITION
Int. Filing Date: 26 August 2008	:	
Priority Date: 29 August 2007	:	UNDER 37 CFR 1.47(a)
Atty Docket No.: 2007P00938WOUS	:	
For: OPERATOR CONTROL FOR A	:	
DOMESTIC APPLIANCE .....	:	

This decision is in response to applicant's Petition under 37 CFR 1.47(a) filed 20 October 2010 in the United States Patent and Trademark Office (USPTO) requesting acceptance of the application without the signature of nonsigning inventor Christian Karamatic. This is also responsive to applicant's request for status filed on 20 January 2011.

#### **BACKGROUND**

On 26 August 2008, applicant filed international application PCT/EP2008/061143. The application claimed a priority date of 29 August 2007 and designated the United States. On 05 March 2009, the International Bureau (IB) communicated a copy of the international application to the United States Patent & Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 29 February 2010.

On 26 February 2010, a Transmittal Letter for entry into the national stage in the United States was filed accompanied by, among other materials, payment of the basic national fee.

On 27 August 2010, a Notification Of Missing Requirements (Form PCT/DO/EO/905) was issued indicating that an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 20 October 2010, a response to the Notification Of Missing Requirements was filed. The response included payment of the required surcharge and the "Petition Under 37 CFR §1.47(a)" considered herein. The petition requests acceptance of the application without the

signature of inventor of record Christian Karamatic, whom petitioner asserts has refused to execute the application.

### **DISCUSSION**

A petition under 37 CFR §1.47(a) must be accompanied by (1) the requisite petition fee, (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Applicant paid the \$200 petition fee for a petition under 37 CFR 1.47(a). Item (1) is satisfied.

Regarding item (2), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute the application papers, “[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.” The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, Petitioner submitted a statement from Michael Lang, with supporting documents, providing firsthand confirmation that a request for signature accompanied by a copy of the application was forwarded to the non-signing inventor at his last known address. Further, on 23 February 2010, Mr. Lang contacted Mr. Karamatic regarding executing the declaration. Mr. Karamatic indicated that “he had received the Declaration and the Application .... along with a request to execute the Declaration. Mr. Christian Karamatic stated that he would not sign the Declaration” without additional compensation. Thereafter, in March 2010, he contacted Mr. Karamatic again to inform him that no additional compensation would be made. Mr. Karamatic continued “to refuse to sign the required Declaration.” This is sufficient evidence to support the conclusion that the nonsigning inventor refuses to sign the application papers. Item (2) is therefore satisfied.

Regarding item (3), the petition includes an express statement of the last known address of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), the petition was accompanied by a declaration signed on behalf of the nonsigning inventor by the joint inventors. Item (4) is therefore satisfied.

In sum, Items (1)-(4) are satisfied. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

**CONCLUSION**

The petition under 37 CFR 1.47(a) is **GRANTED**.

The U.S. Designated/Elected Office has accepted the application as a 37 CFR 1.47(a) application using the declaration filed 20 October 2010. The application has an international filing date of 26 August 2008 under 35 U.S.C. 363, and a date of 20 October 2010 under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his respective last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

/Cynthia M. Kratz/  
Cynthia M. Kratz  
Attorney Advisor  
PCT Legal Office  
Office of PCT Legal Administration

Tel: 571-272-3286  
Fax: 571-273-0459

Doc Code: PET.AUTO Document Description: Petition automatically granted by EFS-Web		PTO/SB/140 U.S. Patent and Trademark Office Department of Commerce
Electronic Petition Request	<b>PETITION TO WITHDRAW AN APPLICATION FROM ISSUE AFTER PAYMENT OF THE ISSUE FEE UNDER 37 CFR 1.313(c)</b>	
Application Number	12675557	
Filing Date	26-Feb-2010	
First Named Inventor	Toshihiko Sakai	
Art Unit	2627	
Examiner Name	PAUL HUBER	
Attorney Docket Number	85719(70904)	
Title	SUPER-RESOLUTION OPTICAL RECORDING MEDIUM ON WHICH INFORMATION IS RECORDED USING TRAIN OF PREPITS, OPTICAL RECORDING MEDIUM REPRODUCTION DEVICE, AND CONTROL METHOD	
<p>An application may be withdrawn from issue for further action upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary.</p> <p>APPLICANT HEREBY PETITIONS TO WITHDRAW THIS APPLICATION FROM ISSUE UNDER 37 CFR 1.313(c).</p> <p>A grantable petition requires the following items:</p> <p>(1) Petition fee; and</p> <p>(2) One of the following reasons:</p> <p>(a) Unpatentability of one or more claims, which must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;</p> <p>(b) Consideration of a request for continued examination in compliance with § 1.114 (for a utility or plant application only); or</p> <p>(c) Express abandonment of the application. Such express abandonment may be in favor of a continuing application, but not a CPA under 37 CFR 1.53(d).</p>		
<p>Petition Fee</p> <p><input type="checkbox"/> Applicant claims SMALL ENTITY status. See 37 CFR 1.27.</p> <p><input type="checkbox"/> Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).</p> <p><input type="checkbox"/> Applicant(s) status remains as SMALL ENTITY.</p> <p><input checked="" type="checkbox"/> Applicant(s) status remains as other than SMALL ENTITY</p>		
Reason for withdrawal from issue		

- ☐ One or more claims are unpatentable
- ☒ Consideration of a request for continued examination (RCE) (List of Required Documents and Fees)
- ☐ Applicant hereby expressly abandons the instant application (any attorney/agent signing for this reason must have power of attorney pursuant to 37 CFR 1.32(b)).

RCE request, submission, and fee.

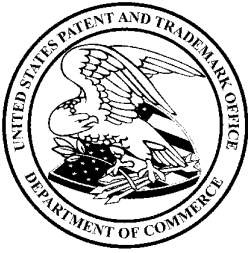
- ☐ I certify, in accordance with 37 CFR 1.4(d)(4) that:
- ☐ The RCE request, submission, and fee have already been filed in the above-identified application on
- ☒ Are attached.

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

I certify, in accordance with 37 CFR 1.4(d)(4) that I am:

- ☒ An attorney or agent registered to practice before the Patent and Trademark Office who has been given power of attorney in this application.
- ☐ An attorney or agent registered to practice before the Patent and Trademark Office, acting in a representative capacity.
- ☐ A sole inventor
- ☐ A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors
- ☐ A joint inventor; all of whom are signing this e-petition
- ☐ The assignee of record of the entire interest that has properly made itself of record pursuant to 37 CFR 3.71

Signature	/Steven M. Jensen/
Name	Steven M. Jensen
Registration Number	42693



## UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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Decision Date : December 16, 2011

In re Application of :

Toshihiko Sakai

### DECISION ON PETITION

UNDER CFR 1.313(c)(2)

Application No : 12675557

Filed : 26-Feb-2010

Attorney Docket No : 85719(70904)

This is an electronic decision on the petition under 37 CFR 1.313(c)(2), filed December 16, 2011, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid in this application cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

This application file is being referred to Technology Center AU 2627 for processing of the request for continuing examination under 37 CFR 1.114.

Office of Petitions

Doc Code: PET.AUTO Document Description: Petition automatically granted by EFS-Web		PTO/SB/140 U.S. Patent and Trademark Office Department of Commerce
Electronic Petition Request	<b>PETITION TO WITHDRAW AN APPLICATION FROM ISSUE AFTER PAYMENT OF THE ISSUE FEE UNDER 37 CFR 1.313(c)</b>	
Application Number	12675557	
Filing Date	26-Feb-2010	
First Named Inventor	Toshihiko Sakai	
Art Unit	2627	
Examiner Name	PAUL HUBER	
Attorney Docket Number	85719(70904)	
Title	SUPER-RESOLUTION OPTICAL RECORDING MEDIUM ON WHICH INFORMATION IS RECORDED USING TRAIN OF PREPITS, OPTICAL RECORDING MEDIUM REPRODUCTION DEVICE, AND CONTROL METHOD	
<p>An application may be withdrawn from issue for further action upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary.</p> <p>APPLICANT HEREBY PETITIONS TO WITHDRAW THIS APPLICATION FROM ISSUE UNDER 37 CFR 1.313(c).</p> <p>A grantable petition requires the following items:</p> <p>(1) Petition fee; and</p> <p>(2) One of the following reasons:</p> <p>(a) Unpatentability of one or more claims, which must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;</p> <p>(b) Consideration of a request for continued examination in compliance with § 1.114 (for a utility or plant application only); or</p> <p>(c) Express abandonment of the application. Such express abandonment may be in favor of a continuing application, but not a CPA under 37 CFR 1.53(d).</p>		
<p>Petition Fee</p> <p><input type="checkbox"/> Applicant claims SMALL ENTITY status. See 37 CFR 1.27.</p> <p><input type="checkbox"/> Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).</p> <p><input type="checkbox"/> Applicant(s) status remains as SMALL ENTITY.</p> <p><input checked="" type="checkbox"/> Applicant(s) status remains as other than SMALL ENTITY</p>		
Reason for withdrawal from issue		

- ☐ One or more claims are unpatentable
- ☒ Consideration of a request for continued examination (RCE) (List of Required Documents and Fees)
- ☐ Applicant hereby expressly abandons the instant application (any attorney/agent signing for this reason must have power of attorney pursuant to 37 CFR 1.32(b)).

RCE request, submission, and fee.

- ☐ I certify, in accordance with 37 CFR 1.4(d)(4) that:
- ☐ The RCE request, submission, and fee have already been filed in the above-identified application on
- ☒ Are attached.

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

I certify, in accordance with 37 CFR 1.4(d)(4) that I am:

- ☒ An attorney or agent registered to practice before the Patent and Trademark Office who has been given power of attorney in this application.
- ☐ An attorney or agent registered to practice before the Patent and Trademark Office, acting in a representative capacity.
- ☐ A sole inventor
- ☐ A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors
- ☐ A joint inventor; all of whom are signing this e-petition
- ☐ The assignee of record of the entire interest that has properly made itself of record pursuant to 37 CFR 3.71

Signature	/Steven M. Jensen/
Name	Steven M. Jensen
Registration Number	42693



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Decision Date : April 20, 2012

In re Application of :

Toshihiko Sakai

DECISION ON PETITION

UNDER CFR 1.313(c)(2)

Application No : 12675557

Filed : 26-Feb-2010

Attorney Docket No : 85719(70904)

This is an electronic decision on the petition under 37 CFR 1.313(c)(2), filed April 20, 2012 , to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid in this application cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

This application file is being referred to Technology Center AU 2627 for processing of the request for continuing examination under 37 CFR 1.114 .

Office of Petitions



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AKRON OH 44308-1412

**MAILED**

**18 NOV 2010**

**PCT LEGAL ADMINISTRATION**

In re Application of:	:	
HUBLER, Arved, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 12/675,564	:	37 CFR 1.47(a)
PCT No.: PCT/EP2008/057567	:	
International Filing Date: 16 June 2008	:	
Priority Date: 31 August 2007	:	
Attorney's Docket No.: TEZ.P.US0008	:	
For: MULTIMEDIA SYSTEM	:	

This decision is issued in response to applicants' "Petition Under 37 CFR § 1.47(a)" filed 22 October 2010. Applicants have paid the required \$200 petition fee.

**BACKGROUND**

On 16 June 2008, applicants filed international application PCT/EP2008/05767. The international application claimed a priority date of 31 August 2007, and it designated the United States. On 12 March 2009, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 28 February 2010.

On 26 February 2010, applicants' filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, an English translation of the international application, an unexecuted declaration, and payment of the basic national fee.

On 24 August 2010, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 22 October 2010, applicants filed a response to the Notification Of Missing Requirements that included payment of the required surcharge, a partially executed declaration, and the petition under 37 CFR 1.47(a) considered herein. The petition requests acceptance of the application without the signature of co-inventor Sten MEINHOLD, whom applicants assert has refused to execute the application.

### **DISCUSSION**

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have provided the required petition fee, and the petition includes an express statement of the inventor's last known address. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed declarations executed by three of the four inventors of record, and the declarations include an unsigned signature block for the non-signing inventor, Sten MEINHOLD. However, the declaration executed by inventor Thoralt FRANZ contains an unacceptable non-dated, non-initialed hand-written alteration with respect to the inventor's address (see 37 CFR 1.52(c)). Any changes made in ink in the application or declaration prior to signing should be initiated and dated by the applicants prior to execution of the declaration. The Office will not consider whether non-initialed and/or non-dated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration (see MPEP 605.04(a)). Therefore, the declaration executed by inventor Thoralt FRANZ is not acceptable as filed. Applicants must submit a newly executed declaration from this inventor which contains all required information (including an unsigned signature block for the non-signing inventor) and which does not include any unacceptable handwritten alterations. Until such a declaration is provided, item (3) of a grantable petition under 37 CFR 1.47(a) is not satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute the application papers, "[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, the petition includes a statement from Dr. Kirsten Lotte and Stefanie Bockelkamp, with supporting documents, indicating that a number of signature requests were forwarded to the non-signing inventor, including at least one that included a copy of the complete application, and that the inventor has not provided the signed declaration in response to such requests. However,

the documents provided by applicants in support of the statement (i.e., copies of letters to the inventor and delivery confirmation receipts) are not in English, and an English translation of these materials has not been provided, as required. Applicants must provide an English translation of the correspondence with the non-signing inventor, and of the delivery receipts, before it can be concluded that the non-signing inventor has refused to execute the present application. Until such materials are provided, item (4) of a grantable petition under 37 CFR 1.47(a) is not satisfied.

### **CONCLUSION**

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy items (3) and (4) of a grantable petition, as discussed above and in the MPEP. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296  
Facsimile: (571) 273-0459



UNITED STATES PATENT AND TRADEMARK OFFICE

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FIRST NATIONAL TOWER, SUITE 400  
106 SOUTH MAIN STREET  
AKRON OH 44308-1412

In re Application of:	:	
HUBLER, Arved, et al.	:	DECISION
U.S. Application No.: 12/675,564	:	(37 CFR 1.47(a))
PCT No.: PCT/EP2008/057567	:	
International Filing Date: 16 June 2008	:	
Priority Date: 31 August 2007	:	
Attorney's Docket No.: TEZ.P.US0008	:	
For: MULTIMEDIA SYSTEM	:	

In a decision mailed by this Office on 18 November 2010, applicants' petition under 37 CFR 1.47(a) for acceptance of the application without the signature of co-inventor Sten MEINHOLD was dismissed without prejudice based on applicants' failure to satisfy the requirements of a grantable petition. The decision also noted that the declaration executed by co-inventor Thoralt FRANZ was not acceptable as filed because it included a non-dated, non-initialed hand-written alteration.

On 11 January 2011, applicants filed the "Renewed Petition Under 37 CFR § 1.47(a)" considered herein. The renewed petition was accompanied by a declaration executed by the previously non-signing inventor, Sten MEINHOLD. The renewed petition was also accompanied by a newly-executed declaration from co-inventor Thoralt FRANZ, resolving the hand-written alteration defect discussed in the earlier decision.

In view of applicants' submission of acceptable declarations executed by all of the inventors of record, including the previously non-signing inventor (Sten MEINHOLD) who was the subject of the petition under 37 CFR 1.47(a), applicants' petition under 37 CFR 1.47(a) is appropriately **DISMISSED AS MOOT**.

This application is being forwarded to the National Stage Processing Branch of the PCT Operations Division for further processing in accord with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 11 January 2011.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296



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**MAY 23 2011**

**PCT LEGAL ADMINISTRATION**

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. BOX 2938  
MINNEAPOLIS MN 55402

In re Application of BRUZZONE et al. :  
Application No.: 12/675,603 : DECISION ON PETITION  
PCT Appl No.: PCT/IB08/02222 :  
Int'l Filing Date: 28 August 2008 : UNDER 37 CFR 1.47(a)  
Priority Date: 29 August 2007 :  
Attorney Docket No.: 3081.013US1 :  
For: ROAD VEHICLE FRONT AIRBAG :

This is a decision on applicant's petition under 37 CFR 1.47(a), and filed in the United States Patent and Trademark Office (USPTO) on 22 February 2011, to accept the application without the signature of joint inventor MICHELA BRUZZONE. Applicant's request for a four month extension of time is granted.

**BACKGROUND**

On 26 February 2010, applicant filed a transmittal letter requesting U.S. national stage entry of international application PCT/IB08/02222.

On 08 September 2010, a Notification to Missing Requirements was mailed to applicant indicating, *inter alia*, that an oath or declaration, in accordance with 37 CFR 1.497(a) and (b), was required.

On 22 February 2011, applicant filed the instant petition along with a declaration, executed by the joint inventor on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a), in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), requested the acceptance of the application without the signature of inventor MICHAELA BRUZZONE alleging that the inventor refuses to sign the application papers.

**DISCUSSION**

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his

or her own behalf and on behalf of the non-signing joint inventor(s).

Petitioner satisfied Item (1) with the payment of the petition fee. Item (3) is satisfied because the last known address for the non-signing inventor was provided. Item (4) is satisfied with the submission of the declaration executed in compliance with 37 CFR 1.497(a) and (b).

With respect to Item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal<sup>1</sup>, states, in pertinent part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. *A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956)*

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

*Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.* When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is

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<sup>1</sup> MPEP Section 409.03(d) also provides guidance where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47. A statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having first-hand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

(Emphasis added.)

Here, Petitioner provides the declarations of Sabina Fasciolo, Head of Legal Affairs for Ferrari (assignee) and Matteo Maccagnan, patent attorney at Studio Torta regarding the refusal of the nonsigning inventor Bruzzone. Ms. Fasciolo states that between 01 March and 30 April 2010, she sent an email to the nonsigning inventor along with a declaration and assignment for her signature. Thereafter, between 01 September 2010 and 21 September 2010, Ms. Fasciolo states that the nonsigning inventor told her by phone that she did not intend to sign the assignment and the declaration/Power of Attorney. On 21 September 2010, Ms. Fasciolo received an email from Mrs. Bruzzone reiterating her refusal.

Mr. Maccagnan's declaration states that between 01 September 2010 and 21 September 2010, he also phoned Mrs. Bruzzone, asking her to sign and that Ms. Bruzzone told him that she "did not intend to sign" the Assignment and the Declaration/Power of Attorney.

However, Petitioner has not presented any evidence that a *bona fide* attempt was made to present a complete copy of the application papers, that is, specification, including claims, drawings, and oath or declaration, to the nonsigning inventor for signature, and the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent. As stated above, the nonsigning inventor's refusal to sign an oath or declaration when the inventor has not been presented with the application papers *does not itself suggest* that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. *A copy of the application papers should be sent to the last known address of the nonsigning inventor*; to ensure that the inventor is apprised of the application to which the oath or declaration is directed.

Petitioner must present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for her signature at her last known address. Proof of the delivery must accompany any renewed petition along with a first hand statement of facts. The circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

As set forth above, Petitioner does not provide a first hand statement of facts under 37 CFR 1.47(a) which indicate that a complete copy of the application papers were should be submitted to describe the inventor's refusal or the efforts to locate the nonsigning inventor. Therefore, it cannot be concluded at this time that the nonsigning inventor refuses or is unavailable to sign the application. Petitioner has not satisfied Item (2). Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

### CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed

within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Cynthia M .Kratz/

Cynthia M. Kratz

Attorney Advisor

PCT Legal Office

Office of PCT Legal Administration

Telephone: (571) 272-3286

Facsimile (571) 272-0459



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SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. BOX 2938  
MINNEAPOLIS MN 55402

**MAILED**

**AUG 12 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of BRUZZONE et al. :  
Application No.: 12/675,603 : DECISION ON PETITION  
PCT Appl No.: PCT/IB08/02222 :  
Int'l Filing Date: 28 August 2008 : UNDER 37 CFR 1.47(a)  
Priority Date: 29 August 2007 :  
Attorney Docket No.: 3081.013US1 :  
For: ROAD VEHICLE FRONT AIRBAG :

This is a decision on applicant's petition under 37 CFR 1.47(a), and filed in the United States Patent and Trademark Office (USPTO) on 08 August 2011, to accept the application without the signature of joint inventor MICHELA BRUZZONE. Applicant's request for a one month extension of time is granted.

**BACKGROUND**

On 26 February 2010, applicant filed a transmittal letter requesting U.S. national stage entry of international application PCT/IB08/02222.

On 08 September 2010, a Notification to Missing Requirements was mailed to applicant indicating, *inter alia*, that an oath or declaration, in accordance with 37 CFR 1.497(a) and (b), was required.

On 22 February 2011, applicant filed a petition under 37 CFR 1.47(a) along with a declaration, executed by the joint inventor on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a), in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), requested the acceptance of the application without the signature of inventor MICHAELA BRUZZONE alleging that the inventor refuses to sign the application papers. On 23 May 2011, a decision dismissing the petition was mailed.

**DISCUSSION**

Petitioner has now presented the declaration signed by inventor MICHAELA BRUZZONE. A review of the declaration reveals that the declaration identifies all the inventors named in the international application and is executed by the previously non-signing inventor. The declaration also states the residency, citizenship and mailing address of each inventor. The

declaration executed by inventor BRUZZONE is acceptable under 37 CFR 1.497(a) and (b).

The petition under 37 CFR 1.47(a) is considered moot as a declaration executed by the previously unavailable inventor has now been submitted. The declarations are acceptable under 37 CFR 1.497(a) and (b).

### **CONCLUSION**

For the above reasons, the renewed petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**. The declarations executed by the joint inventors and submitted on 09 August 2011 are in compliance with 37 CFR 1.497(a) and (b) and are acceptable.

This application is being forwarded to United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is 09 August 2011.

/Cynthia M. Kratz/

Cynthia M. Kratz

Attorney Advisor

PCT Legal Office

Office of PCT Legal Administration

Telephone: (571) 272-3286

Facsimile (571) 272-0459



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,612	04/12/2010	Robert Clifford Yuille	I-51706	5470
4859 7590 05/24/2011 MACMILLAN SOBANSKI & TODD, LLC ONE MARITIME PLAZA FIFTH FLOOR 720 WATER STREET TOLEDO, OH 43604-1619				
			EXAMINER	
			ART UNIT	PAPER NUMBER
			3728	
			MAIL DATE	DELIVERY MODE
			05/24/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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MACMILLAN SOBANSKI & TODD, LLC  
ONE MARITIME PLAZA FIFTH FLOOR  
720 WATER STREET  
TOLEDO OH 43604-1619

In re Application of:  
YUILLE, ROBERT CLIFFORD  
Serial No. 12/675,612  
Filed: Feb. 26, 2010  
Docket: SHAP.13159

Title:           SANITARY TOOTHBRUSH  
                  STORAGE APPARATUS

:  
:  
:   DECISION ON REQUEST TO  
:  
:   PARTICIPATE IN PATENT  
:  
:   PROSECUTION HIGHWAY  
:  
:   PILOT PROGRAM AND  
:  
:   PETITION TO MAKE  
:   SPECIAL UNDER 37 CFR  
:   1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) pilot program and the petition under 37 CFR 1.102(a), filed May 23, 2011 to make the above-identified application special.

The request and petition are granted.

A grantable request to participate in the PPH pilot program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the CIPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the CIPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the CIPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions from each of the CIPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the CIPO examiner in the CIPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen, at 571-272-4856.

All other inquiries concerning the examination or status of the application should be directed to Mickey Yu, SPE of Art Unit 3728, 571-272-4562.

The application will be forwarded to the examiner for action on the merits commensurate with this decision.

/Henry C. Yuen/

---

Henry C. Yuen, Special Programs Examiner  
Technology Center 3700 – Mechanical Engineering,  
Manufacturing and Products  
571-272-4856



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,622	02/26/2010	Rentaro Kuroki	14393/7	5534
23838	7590	09/22/2011	EXAMINER	
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER
			3747	
			MAIL DATE	DELIVERY MODE
			09/22/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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KENYON & KENYON LLP  
1500 K STREET N.W.  
SUITE 700  
WASHINGTON DC 20005

In re Application of	:	
<u>KUROKI, RENTARO</u> , et al	:	DECISION ON REQUEST TO
Application No. 12/675,622	:	PARTICIPATE IN PATENT
Filed: February 26, 2010	:	PCT/PROSECUTION HIGHWAY
Attorney Docket No. <b>144453</b>	:	PROGRAM AND PETITION
For: WORKING GAS CIRCULATION ENGINE	:	TO MAKE SPECIAL UNDER
	:	37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed September 14, 2011 to make the above-identified application special.

The request and petition are granted.

A grantable request to participate in the PPH pilot program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO/PCT application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions from each of the JPO/PCT application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

In light of the petition being properly submitted, the request to participate in the PPH program and the petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application. Upon completion of pre-examination processing, this application will be forwarded to an examiner for examination.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen at 571-272-4485. All other inquiries concerning the examination or status of the application should be directed to Steven Cronin, SPE of Art Unit 3747, and 571-272-6785 for Class 123 and also accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

Petition is **granted**.

/Henry C. Yuen/

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Henry C. Yuen, Special Programs Examiner  
Technology Center 3700 – Mechanical Engineering,  
Manufacturing and Products  
571-272-4856

Doc Code: PET.GREEN

Document Description: Petition for Green Tech Pilot

PTO/SB/420 (03-11)

## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket Number: FER-18596.02 Application Number (if known): 12/675623 Filing date: 1/24/2011

First Named Inventor: Hong Jiang

Title: Electrically Conductive Polymeric Compositions, Contacts, Assemblies, and Methods

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication:** Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request.

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirements for the Green Technology Pilot Program, if the Office determines that the claims are not obviously directed to a single invention. See Instruction Sheet.

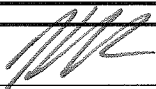
3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: \_\_\_\_\_

Signature



Date

8/22/11

Name  
(Print/Typed)

Kenneth A. Clark

Registration Number

32119

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below\*.



\*Total of \_\_\_\_\_ forms are submitted.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	12/675623	Confirmation No.	5541
Applicant	:	Hong Jiang et al.		
Filed	:	January 24, 2011		
TC/A.U.	:	N/A		
Examiner	:	N/A		
Title	:	Electrically Conductive Polymeric Compositions, Contacts, Assemblies, and Methods		
Docket No.	:	FER-18596.02		
Customer No.	:	007609		

Statement of Special Status Regarding Entry into Green Technology Pilot Program

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The present application relates to green technologies as defined by the USPTO. Particularly, independent claim 46 recites a photovoltaic device. Thus, the present application involves alternative energy production, and more specifically, solar cells. Further, the present application materially contributes to the development of renewable energy resources. Further still, the present application only includes two independent claims and twenty total claims. It is also noted that the present application does not contain any multiple dependent claims.

In light of the foregoing, it is respectfully submitted that the present application should be allowed to enter the Green Technology Pilot Program. If it is determined that the application is not in a condition for entry into the Green Technology Pilot Program, the Examiner is invited to initiate a telephone interview with the undersigned attorney to

expedite entry of the present application into the Green Technology Pilot Program.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. FER-18596.02.

Respectfully submitted,

RANKIN, HILL & CLARK LLP

By /Kenneth A. Clark/  
Kenneth A. Clark, Reg. No. 32119

38210 Glenn Avenue  
Willoughby, Ohio 44094-7808  
(216) 566-9700



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,623	01/24/2011	Hong Jiang	FER-18596.02	5541
7609 7590 09/20/2011 RANKIN, HILL & CLARK LLP 23755 Lorain Road - Suite 200 North Olmsted, OH 44070-2224			EXAMINER NGUYEN, HAIDUNG D	
			ART UNIT 1761	PAPER NUMBER
			MAIL DATE 09/20/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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RANKIN, HILL & CLARK LLP  
23755 Lorain Road - Suite 200  
North Olmsted OH 44070-2224

9/20/11

In re Application of  
Jiang et al.  
Application No. 12/675,623  
Filed: 2/26/2010  
Attorney Docket No. **FER-18596.02**

DECISION ON PETITION  
TO MAKE SPECIAL UNDER  
THE GREEN TECHNOLOGY  
PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed 8/23/2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth in 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded “special” status.

Telephone inquiries concerning this decision should be directed to Tom Dunn at 571-272-1171.

The application is being forwarded to the Technology Center Art Unit 1761 for action on the merits commensurate with this decision.

/Tom Dunn/

---

Tom Dunn  
Quality Assurance Specialist  
Technology Center 1700



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United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

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**08-NOV 2010**

**PCT LEGAL ADMINISTRATION**

FISH & RICHARDSON P.C.  
P.O. BOX 1022  
MINNEAPOLIS MN 55440-1022

In re Application of	:	
JUN, et al.	:	DECISION ON PETITION
Serial No.: 12/675,637	:	
PCT No.: PCT/KR2007/004138	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 28 August 2007	:	
Priority Date: None	:	
Atty Docket No.: 20172-0056US1	:	
For: INJECTION MOLDINGS, INJECTION-MOLDING:	:	
APPARATUS AND METHOD THEREOF	:	

This decision is issued in response to applicants' "RENEWED PETITION UNDER 37 CFR 1.47 (A)" filed 02 September 2010. In a decision dated 06 July 2010, applicants' petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor, Chang-Il Jung, was dismissed without prejudice.

The renewed petition under 37 CFR 1.47(a) is moot since the declaration which accompanies the petition has been executed by the previous non-signing inventor. The declaration filed 02 September 2010 is acceptable under 37 CFR 1.497.

For the reasons above, the renewed petition under 37 CFR 1.47(a) is **DISMISSED** as MOOT.

The application has an international filing date of 28 August 2007 under 35 U.S.C. 363 and a date of **02 September 2010** under 35 U.S.C. 371(c)(1),(c)(2) and (c)(4).

This application is being forwarded to the United States Designated/Elected Office for continued processing.

Derek A. Putonen  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel.: 571-272-3294



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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP  
300 S. WACKER DRIVE  
32ND FLOOR  
CHICAGO, IL 60606

MAILED

JAN 26 2011

PCT LEGAL ADMINISTRATION

In re Application of DAVIES et al	:	
U.S. Application No.: 12/675,668	:	
PCT Application No.: PCT/GB2008/002848	:	DECISION
Int. Filing Date: 26 August 2008	:	
Priority Date Claimed: 31 August 2007	:	
Attorney Docket No.: 10-162-WO-US	:	
For: UNDERWATER COMMUNICATIONS	:	

This is in response to applicant's petition under 37 CFR 1.47(a) filed on 09 December 2010.

**BACKGROUND**

On 26 August 2008, applicant filed international application PCT/GB2008/002848, which claimed priority of an earlier United Kingdom application filed 31 August 2007. A copy of the international application was communicated to the USPTO from the International Bureau on 05 March 2009. The thirty-month period for paying the basic national fee in the United States expired on 01 March 2010.

On 26 February 2010, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 19 May 2010, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 09 December 2010, applicant filed the present petition under 37 CFR 1.47(a).

**DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2)

factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventor on his own behalf and on behalf of the nonsigning inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

The petition states that joint inventor Jonathan Davies cannot be found. However, the petition does not adequately demonstrate that a diligent effort was made to locate Davies. In particular, petitioner has discovered Davies' new employer but has not attempted to send correspondence to Davies at the new employer's address. Thus, it would not be reasonable to conclude at the present time that Davies cannot be reached.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.


If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT

Application Number: 12/675,668

-3-

Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Bryan Lin  
PCT Legal Examiner  
PCT Legal Office

Telephone: 571-272-3303  
Facsimile: 571-273-0459



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,669	02/26/2010	Isamu Yamasaki	12394/11	5898
23838	7590	04/20/2011		
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			EXAMINER MAUST, TIMOTHY LEWIS	
			ART UNIT 3751	PAPER NUMBER
			MAIL DATE 04/20/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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KENYON & KENYON LLP  
1500 K STREET N.W.  
SUITE 700  
WASHINGTON DC 20005

*In re* Application of:  
YAMASAKI, ISAMU et al  
Serial No.: 12/675,669  
Filed: Feb. 26, 2010  
Docket: 12394/11  
Title: PAINTING MATERIAL  
CHARGING DEVICE

::  
::  
: DECISION ON REQUEST  
: TO PARTICIPATE IN  
:: PATENT PROSECUTION  
HIGHWAY (PPH) AND  
PETITION TO MAKE  
SPECIAL UNDER 37 CFR  
1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed April 19, 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more corresponding application(s) filed in the JPO or to a PCT application that does not contain any priority claim, or the U.S. application must be a national stage entry of a PCT application that does not contain any priority claim;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

In light of the petition being properly submitted, the request to participate in the PPH program and the petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application. This application will be forwarded to an examiner for examination.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen at 571-272-4856. All other inquiries concerning the examination or status of the application should be directed to Greg Huson, SPE of Art Unit 3751 and 571-272-4887 for Class 141/21 and also accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

Petition is **granted**.

/Henry C. Yuen/

---

Henry C. Yuen, Special Programs Examiner  
Technology Center 3700 – Mechanical Engineering,  
Manufacturing and Products  
571-272-4856



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Winston & Strawn LLP  
1111 Louisiana, 25th Floor  
Houston TX 77002-5242

**MAILED**

**JUL 01 2011**

**OFFICE OF PETITIONS**

Applicant: Michaud, et al.  
Appl. No.: 12/675,712  
International Filing Date: August 28, 2008  
Title: METHODS FOR INSPECTING AND REFURBISHING ENGINEERING COMPONENTS  
Attorney Docket: 12350.0030.PCUS00  
Pub. No.: US 2010/0233510 A1  
Pub. Date: September 16, 2010

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on October 21, 2010 for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication contains a material error on the front page of the application wherein the title of the invention "METHOD FOR INSPECTING AND REFURBISHING ENGINEERING COMPONENTS" is misprinted as "METHOD FOR METAL COMPONENT REFURBISHMENT USING SUBTRACTIVE SURFACE".

37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.<sup>1</sup>

The error noted by requestor on the front page of the publication wherein the title of the invention "METHOD FOR INSPECTING AND REFURBISHING ENGINEERING COMPONENTS" is misprinted as "METHOD FOR METAL COMPONENT REFURBISHING USING SUBTRACTIVE SURFACE" in this instant is not an Office error. The title was printed

<sup>1</sup>Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

as it appears in the Oath filed with the application on February 26, 2010. Furthermore, an error in the title does not affect the understanding of the application. The mistake does not affect the public's ability to appreciate the technical disclosure of the patent application publication, or determine the scope of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.

On June 8, 2010, a Filing Receipt was mailed by the Office, which improperly listed the title of the invention. To avoid this type of problem in the future, applicant's representative should correct the error and make a request for a corrected filing receipt prior to export of the application to the publisher and publication of the application.

The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221 (a). Such a request for republication "must include a copy of the application compliance with the Office's electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18 (d) and the processing fee set forth in § 1.17 (i)." If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18 (d) will be refunded. The processing fee will be retained.

A guide for filing a request for a Pre-Grant Publication, such as a request for republication, may be found on the link below:

<http://www.uspto.gov/patents/process/file/efs/guidance/index.jsp>

[http://www.uspto.gov/ebc/portal/efs/pgpub\\_quickstart.pdf](http://www.uspto.gov/ebc/portal/efs/pgpub_quickstart.pdf)

Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system, as a "Pre-Grant Publication".

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709.



Mark Polutta  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy



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MAILED

APR 04 2011

PCT LEGAL ADMINISTRATION

MEREDITH & KEYHANI, PLLC  
330 MADISON AVE.  
6TH FLOOR  
NEW YORK NY 10017

In re Application of	:	DECISION ON REQUEST
HOBBINS	:	
Application No.: 12/675,779	:	FOR WITHDRAWAL
Attorney's Docket No.: 2762/PCT/US	:	
For: WELDING A METAL PRODUCT	:	AS ATTORNEY
	:	

This is in response to the "REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS" (Form PTO/SB/83) filed 02 February 2011. Fariba Sirjani has requested that he be removed as a practitioner of record. No fee is required.

The request to withdraw as attorney of record is **GRANTED**.

Jennifer Meredith will remain as practitioner of record. The correspondence address remains the same.

/Daniel Stemmer/

Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (271) 272-3301



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MARTIN D MOYNIHAN d/b/a PRTSI  
PO BOX 16446  
ARLINGTON VA 22215

**MAILED**  
**MAR 09 2012**  
**OFFICE OF PETITIONS**

In re Application of	:	DECISION
Blank, et al.	:	ON PETITION
Application No. 12/675,801	:	
Filed: March 1, 2010	:	
Attorney Docket Number: 48003	:	

This is in response to the petition under 37 CFR 1.84(a)(2), filed March 1, 2010, for acceptance of color drawings.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled, "Renewed Petition under 37 CFR 1.84(a)(2)". No further petition fee is required for a renewed petition.

A grantable petition under 37 C.F.R. 1.84(a)(2) must be accompanied by the following:

- (1) The fee set forth in 37 C.F.R. 1.17(h);
- (2) Three (3) sets of color drawings, or one (1) set if filed via EFS, and
- (3) The specification contains appropriate language referring to the color drawings as the first paragraph in that portion of the specification relating to the brief description of the drawings.

In addition, MPEP 608.02 states that a petition to accept color drawings will only be granted when the Office "has determined that a color drawing or photograph is the only practical medium by which to disclose in a printed utility patent the subject matter to be patented."

Here, the Office has determined that color drawings are not necessary for an understanding of the invention.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Mail Stop Petitions  
                                    Commissioner for Patents  
                                    PO Box 1450  
                                    Alexandria VA 22313-1450

By FAX:                      571-273-8300  
                                    Attn: Office of Petitions

The application is being forwarded to Group Art Unit 2858.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (571)272-3207.

A handwritten signature in black ink, appearing to read 'Jose Dees', is written over the printed name and title.

Jose Dees  
Petitions Examiner  
Office of Petitions



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,843	03/01/2010	Kimiya Ikushima	2010_0295A	7373

52349 7590 09/30/2010  
WENDEROTH, LIND & PONACK L.L.P.  
1030 15th Street, N.W.  
Suite 400 East  
Washington, DC 20005-1503

EXAMINER
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ART UNIT	PAPER NUMBER
3746	

NOTIFICATION DATE	DELIVERY MODE
09/30/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com  
coa@wenderoth.com



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WENDEROTH, LIND & PONACK L.L.P.  
1030 15th Street, N.W.  
Suite 400 East  
Washington DC 20005-1503

<i>In re</i> Application of:	:	
IKUSHIMA, KIMIYA et al	:	DECISION ON REQUEST TO
Serial No.: 12/675,843	:	PARTICIPATE IN PATENT
Filed: March 1, 2010	:	PROSECUTION HIGHWAY
Docket: 2010_0295A	:	(PPH) AND PETITION TO
Title: FLUID TRANSPORTING DEVICE	:	MAKE SPECIAL UNDER 37
USING CONDUCTIVE POLYMER	:	CFR 1.102(d)

This is a decision on the renewed request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed September 28, 2010, to make the above-identified application special.

The request and petition are **DISMISSED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more corresponding application(s) filed in the JPO or to a PCT application that does not contain any priority claim, or the U.S. application must be a national stage entry of a PCT application that does not contain any priority claim;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition met all conditions except Item #6 above. The request to participate in the PPH program and petition fail to include a copy of the JPO cited references, namely, JP 2005-207406 A (Eamex Corp.), 04 August, 2005 (04.08.05) & WO 2005/042974 A1; JP 2005-269842 A (Eamex Corp.), 29 September, 2005 (29.09.05) & WO 2005/120728 A1; JP 2001-193653 A (The Fujikura Rubber Ltd.), 17 July, 2001 (17.07.01), and Microfilm of the specification and drawings annexed to the request of Japanese Utility Model Application No. 126498/1985(Laid-open No. 36266/1987) (Konan Electric Co., Ltd.).

Applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application.

Applicant is given a time period of **ONE MONTH or THIRTY DAYS**, whichever is longer, from the mailing date of this decision to correct the deficiencies. **NO EXTENSION OF TIME UNDER 37 CFR 1.136 IS PERMITTED.** If the deficiencies are not corrected with the time period given, the application will await action in its regular turn. Response must be filed via EFS-Web. Currently, the application is undergoing pre-examination processing.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen at 571-272-4856.

Petition is **dismissed**.

/Henry C. Yuen/

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Henry C. Yuen, Special Programs Examiner  
Technology Center 3700 – Mechanical Engineering,  
Manufacturing and Products, 571-272-4856



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,843	03/01/2010	Kimiya Ikushima	2010_0295A	7373

52349 7590 10/20/2010  
WENDEROTH, LIND & PONACK L.L.P.  
1030 15th Street, N.W.  
Suite 400 East  
Washington, DC 20005-1503

EXAMINER
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ART UNIT	PAPER NUMBER
3746	

NOTIFICATION DATE	DELIVERY MODE
10/20/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com  
eoa@wenderoth.com



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WENDEROTH, LIND & PONACK L.L.P.  
1030 15th Street, N.W.  
Suite 400 East  
Washington DC 20005-1503

<i>In re</i> Application of:	:	
IKUSHIMA, KIMIYA et al	:	DECISION ON REQUEST TO
Serial No.: 12/675,843	:	PARTICIPATE IN PATENT
Filed: March 1, 2010	:	PROSECUTION HIGHWAY
Docket: 2010_0295A	:	(PPH) AND PETITION TO
Title: FLUID TRANSPORTING DEVICE	:	MAKE SPECIAL UNDER 37
USING CONDUCTIVE POLYMER	:	CFR 1.102(d)

This is a decision on the renewed request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed October 14, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more corresponding application(s) filed in the JPO or to a PCT application that does not contain any priority claim, or the U.S. application must be a national stage entry of a PCT application that does not contain any priority claim;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

In light of the petition being properly submitted, the request to participate in the PPH program and the petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application.

The application is being forwarded and docketed to an examiner for action on the merits commensurate with this decision.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen at 571-272-4856. All other inquiries concerning the examination or status of the application should be directed to Devon Kramer, the SPE of Art Unit 3746, and 571-272-7118 for Class 417/410 and also accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

Petition is **granted**.

/Henry C. Yuen/

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Henry C. Yuen, Special Programs Examiner  
Technology Center 3700 – Mechanical Engineering,  
Manufacturing and Products  
571-272-4856



UNITED STATES PATENT and TRADEMARK OFFICE

MAILED

JAN 13 2011

PCT LEGAL ADMINISTRATION

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ALEXANDRIA, VA 22313-1450  
www.uspto.gov

MERCK  
PATENT DEPARTMENT (K-6-1, 1990)  
2000 GALLOPING HILL ROAD  
KENILWORTH NJ 07033-0530

In re Application of : DECISION ON  
ANILKUMAR et al :  
Application No.: 12/675,891 :  
PCT No.: PCT/US2008/010148 :  
Int. Filing Date: 27 August 2008 : PETITION  
Priority Date: 29 August 2007 :  
Attorney's Docket No.: IN06705US01 :  
For: SUBSTITUTED INDOLE DERIVATIVES AND :  
METHODS OF USE THEREOF : UNDER 37 CFR 1.182

This decision is in response to applicants' "PETITION UNDER 37 C.F.R. §1.182" filed on 23 November 2010. Applicants' Deposit Account No.: 19-0365 has been charged \$400.00 petition fee under 37 C.F.R. 1.17(f).

**BACKGROUND**

On 27 August 2008, applicants filed international application No. PCT/US2008/010148, which claims a priority date of 27 August 2007.

On 01 March 2010, applicants filed in the United States Patent and Trademark Office (PTO) a Transmittal Letter (Form PTO-1390) accompanied by, *inter alia*, the basic national fee. Applicants, however, have not satisfied the requirement set forth by 35 U.S.C. 371(c)(4) because an executed oath or declaration had not been provided.

On 28 June 2010, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date." The Notice stated that the declaration must be submitted within two months from the date of this notice or 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 23 November 2010, applicants filed an executed declaration and the instant petition requesting to change the order of names in the patent application, and it was accompanied by an executed declaration in such order which is also consistent with the application date sheet filed on 01 March 2010.

**DISCUSSION**

MPEP § 605.04(f) requires in instances where to change the order of names in the patent application when the application has been filed to submit a petition under 37 CFR 1.182. The petition must include (1) the appropriate petition fee and (2) should include an application data sheet showing the new order of inventor names to ensure appropriate printing of the inventor names in any patent to issue.

With respect to item (1), the petition fee has been charged to applicants' deposit account.

With respect to item (2), applicants have provided an application data sheet (ADS) with the correct order of inventor names.

In addition, applicants have file an executed declaration submitted with the correct order of the names of the inventors for the patent application.

**CONCLUSION**

For the reasons above, the petition under 37 CFR §1.182 is **GRANTED**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing.



Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Tel: (571) 272-3276  
Fax: (571) 273-0459



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**MERCK  
PATENT DEPARTMENT (K-6-1, 1990)  
2000 GALLOPING HILL ROAD  
KENILWORTH NJ 07033-0530**

**MAILED  
NOV 22 2010  
OFFICE OF PETITIONS**

In re Application of	:	
Anilkumar et al.	:	
Application No. 12/675,897	:	ON PETITION
Filed: October 22, 2010	:	
Attorney Docket No. IN06545US01	:	
	:	

This is a decision on the petition under 37 CFR 1.182, filed October 22, 2010, to change the order of the names of the inventors.

The petition is **DISMISSED AS MOOT**.

Petitioner has requested to change the order of the names of the inventors. However, the change of order request is exactly the present order of inventors as listed in the November 3, 2010 Filing Receipt (copy enclosed), thus rendering the petition request moot.

The \$130.00 fee submitted by petitioner will be refunded to petitioner's deposit account in due course.

Telephone inquiries regarding this decision should be directed to Joan Olszewski at (571) 272-7751. All other inquiries should be directed to the Technology Center.

/Liana Walsh/  
Liana Walsh  
Petitions Examiner  
Office of Petitions

Enclosure: November 3, 2010 Filing Receipt



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APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	TOT CLAIMS	IND CLAIMS
12/675,897	10/22/2010		2834	IN06545US01	22	3

CONFIRMATION NO. 7690

24265  
MERCK  
PATENT DEPARTMENT (K-6-1, 1990)  
2000 GALLOPING HILL ROAD  
KENILWORTH, NJ 07033-0530

## FILING RECEIPT



0000000044304573

Date Mailed: 11/03/2010

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

### Applicant(s)

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Boris Feld, New Milford, NJ;

**Power of Attorney:** The patent practitioners associated with Customer Number 24265

**Domestic Priority data as claimed by applicant**

This application is a 371 of PCT/US08/10130 08/27/2008

which claims benefit of 60/968,745 08/29/2007

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 11/01/2010

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 12/675,897**

**Projected Publication Date:** 02/10/2011

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

2,3-SUBSTITUTED INDOLE DERIVATIVES FOR TREATING VIRAL INFECTIONS

**Preliminary Class**

**PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES**

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

**LICENSE FOR FOREIGN FILING UNDER**  
**Title 35, United States Code, Section 184**  
**Title 37, Code of Federal Regulations, 5.11 & 5.15**

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This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



United States Patent and Trademark Office

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1300 EAST NINTH STREET, SUITE 1700  
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NOV 08 2010

PCT LEGAL ADMINISTRATION

Commissioner for Patents  
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P.O. Box 1450  
Alexandria, VA 22313-1450  
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In re Application of :  
Bansal :  
Application No.: 12/675,906 :  
PCT No.: PCT/US2008/074779 :  
Int. Filing Date: 29 August 2008 : **DECISION**  
Priority Date: 29 August 2007 :  
Attorney Docket No.: NMT-8777US PCT :  
For: Inhibition Of Complement And Cellular Activation :

This is in response to the correspondence filed on 01 March 2010.

**BACKGROUND**

International application PCT/US2008/074779 was filed on 29 August 2008, claimed an earlier priority date of 29 August 2007, and designated the United States. The period for payment of the basic national fee in the United States expired as of midnight on 01 March 2010 (since 28 February 2010 was a Sunday). Applicants filed *inter alia* a basic national fee in 12/675,906 on 01 March 2010.

**DISCUSSION**

Review of the instant application file reveals that the Transmittal Letter (Form PTO-1390) filed on 01 March 2010 was directed toward the national stage under 35 U.S.C. 371 of "PCT/US2008/074779," while the Electronic Acknowledgment Receipt dated 01 March 2010 shows that applicants indicated "PCT/US07/74779" was the subject of the submission. The unsigned declaration filed on 01 March 2010 was directed toward PCT/US2008/074779, and the bibliographic information for this case resembles that for PCT/US2008/074779, not PCT/US2007/074779. For instance, PCT/US2008/074779 has the same international filing date, priority date, title and applicant as shown on the Transmittal Letter. In view of the discrepancy, it is not sufficiently clear which international application was intended to enter the national stage. Resolution of this matter would require a formal petition (and fee) under 37 CFR 1.182, clarifying which international application was intended to enter the national stage under 35 U.S.C. 371.

**DECISION**

The papers filed on 01 March 2010 are **NOT ACCEPTED** under 35 U.S.C. 371, without prejudice..

Any response must be filed within **TWO (2) MONTHS** from the mailing date of this Decision, extendable under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT**.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT

**Application No.: 12/675,906**

**-2-**

Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/George Dombroske/

George Dombroske

PCT Legal Examiner

Office of PCT Legal Administration

Tel: (571) 272-3283



United States Patent and Trademark Office

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In re Application of :  
Bansal :  
Application No.: 12/675,906 :  
PCT No.: PCT/US2008/074779 :  
Int. Filing Date: 29 August 2008 :  
Priority Date: 29 August 2007 :  
Attorney Docket No.: NMT-8777US PCT :  
For: Inhibition Of Complement And Cellular Activation :

DECISION

This is in response to the petition under 37 CFR 1.182 filed on 23 November 2010.

**DISCUSSION**

In a Decision mailed on 08 November 2010, applicants were advised that

Review of the instant application file reveals that the Transmittal Letter (Form PTO-1390) filed on 01 March 2010 was directed toward the national stage under 35 U.S.C. 371 of "PCT/US2008/074779," while the Electronic Acknowledgment Receipt dated 01 March 2010 shows that applicants indicated "PCT/US07/74779" was the subject of the submission. The unsigned declaration filed on 01 March 2010 was directed toward PCT/US2008/074779, and the bibliographic information for this case resembles that for PCT/US2008/074779, not PCT/US2007/074779. For instance, PCT/US2008/074779 has the same international filing date, priority date, title and applicant as shown on the Transmittal Letter. In view of the discrepancy, it is not sufficiently clear which international application was intended to enter the national stage. Resolution of this matter would require a formal petition (and fee) under 37 CFR 1.182, clarifying which international application was intended to enter the national stage under 35 U.S.C. 371.

In response, applicants have filed the instant petition under 37 CFR 1.182. Petitioner states *inter alia* that "An inadvertent typographical error was made when this application was submitted via the EFS on March 1, 2010. Specifically, International Application number PCT/US07/74779 was input during filing via EFS instead of the correct international Application number of PCT/US08/74779." Based on the totality of the evidence now of record, it would be appropriate to accept petitioner's statements as to the nature of the discrepancy and the identity of the international application which is to enter the national phase.

**DECISION**

The petition under 37 CFR 1.182 is **GRANTED**.

**Application No.: 12/675,906**

**-2-**

This application is being returned to the Office of Patent Application Processing for processing as the national stage under 35 U.S.C. 371 of international application number PCT/US2008/074779. This processing will include updating the electronic records of the USPTO (PALM) to reflect the correct national stage parentage.

/George Dombroske/

George Dombroske

PCT Legal Examiner

Office of PCT Legal Administration

Tel: (571) 272-3283

**Doc Code: PET.GREEN**

**Document Description: Petition for Green Tech Pilot**

PTO/SB/420 (11-10)

Approved for use through 01/31/2011. OMB 0651-0062  
U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket  
Number: AA 1830 US

Application Number  
(if known): 12675913

Filing date: 2010-11-01

First Named  
Inventor: Louise Clare Arnold

Title: On Board Diagnostic System

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request.**

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirements for the Green Technology Pilot Program, if the Office determines that the claims are not obviously directed to a single invention. See Instruction Sheet.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: \_\_\_\_\_

Signature /Stephen J. Driscoll/

Date 2011-01-31

Name  
(Print/Typed) Stephen J. Driscoll

Registration Number 37564

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature see below\*.



\*Total of <sup>1</sup> forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/675,913	11/01/2010	Louise Clare Arnold	AA 1830 US	7845
23122	7590	02/11/2011		
RATNERPRESTIA				
P.O. BOX 980				
VALLEY FORGE, PA 19482				
EXAMINER				
ART UNIT		PAPER NUMBER		
3748				
MAIL DATE		DELIVERY MODE		
02/11/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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RATNERPRESTIA  
P.O. BOX 980  
VALLEY FORGE PA 19482

In re Application of	:	
ARNOLD, LOUISE CLARE et al	:	DECISION ON PETITION
Application No. 12/675,913	:	TO MAKE SPECIAL UNDER
Filed: March 1, 2010	:	THE GREEN TECHNOLOGY
Attorney Docket No. AA 1830US	:	PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed Jan. 31, 2011, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth in 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **granted**.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within ONE (1) MONTH OR THIRTY (30) DAYS from the mail date of this decision, whichever is longer. No extension of this time limit can be granted under 37 CFR 1.136(a) or (b). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of

the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded “special” status.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen at 571-272-4856.

This application will be forwarded to the Technology Center Art Unit 3748 for action on the merits commensurate with this decision.

/Henry C. Yuen/

---

Henry C. Yuen  
Quality Assurance Specialist  
Technology Center TC 3700



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4800 IDS CENTER  
80 SOUTH 8TH STREET  
MINNEAPOLIS MN 55402-2100

**MAILED**

JAN 21 2011

PCT LEGAL ADMINISTRATION

In re Application of	:	
Nadreau et al.	:	
Application No.: 12/675,946	:	DECISION
PCT No.: PCT/EP2008/061250	:	
Int. Filing Date: 27 August 2008	:	ON
Priority Date: 30 August 2007	:	
Attorney Docket No.: 3340.272WOUS	:	PETITION
For: Method Of Injecting A Treatment Substance Into	:	
Eggs And The Corresponding Injection Head	:	

This is in response to the petition under 37 CFR 1.47(a) filed on 19 November 2010.

**BACKGROUND**

This international application was filed on 27 August 2008, claimed an earliest priority date of 30 August 2007, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 05 March 2009. The 30 month time period for paying the basic national fee in the United States expired at midnight on 01 March 2010 (since 28 February 2010 was a Sunday). Applicants filed *inter alia* the basic national fee on 01 March 2010.

On 27 August 2010, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed.

**DISCUSSION**

As a preliminary matter, the Notice of Acceptance (Form PCT/DO/EO/903) and filing receipt mailed on 27 August 2010 were issued in error, and both are hereby **VACATED**.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding **requirement (1)**, the \$200.00 petition fee has been paid.

Regarding **requirement (2)**, petitioner has provided *inter alia* a "Declaration of Bertrand Hays," who describes efforts undertaken to obtain the signature of Mr. Nadreau. The accompanying documents include a copy and translation of a letter sent to Mr. Nadreau on 21 June 2010. The translation indicates that the letter was accompanied by a declaration and "a whole copy of the US Patent application," and indicates that it was sent by Ephrem Adjanohoun. However, no supporting statement by Mr. Adjanohoun has been provided. Mr. Hays' statements with respect to the facts recounted are insufficient to the extent that they are not made on the basis of first-hand knowledge. For these reasons, it would not be appropriate to conclude that

Mr. Nadreau's conduct constitutes a refusal within the meaning of 37 CFR 1.47(a) at this time. See MPEP 409.03(d).

Regarding **requirement (3)**, the petition provides the last known address of the non-signing inventor.

Regarding **requirement (4)**, inspection of the declaration of inventorship filed on 19 November 2010 reveals that it satisfies this requirement.

### **DECISION**

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283



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**JUN 28 2011**

In re Application of  
Nadreau et al.  
Application No.: 12/675,946  
PCT No.: PCT/EP2008/061250  
Int. Filing Date: 27 August 2008  
Priority Date: 30 August 2007  
Attorney Docket No.: 3340.272WOUS  
For: Method Of Injecting A Treatment Substance Into  
Eggs And The Corresponding Injection Head

**PCT LEGAL ADMINISTRATION**

DECISION

ON

PETITION

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 21 April 2011.

**DISCUSSION**

In a Decision mailed on 21 January 2011, the petition under 37 CFR 1.47(a) filed on 19 November 2010 was dismissed, without prejudice, because requirement (2) had not been satisfied.

In response, petitioner now has provided a "Declaration of Ephrem Adjanohoun," who describes his efforts to obtain Mr. Nadreau's execution of the application, and provides copies of supporting documentation. Petitioner also has provided an additional "Declaration of Bertrand Hays." Based on the totality of the evidence now of record, it would be appropriate to conclude that Mr. Nadreau was presented with a copy of the application papers and a declaration as of 25 June 2010, and to construe his failure to return the signed declaration as a refusal within the meaning of 37 CFR 1.47(a). As such, all of the requirements for relief now have been satisfied.

The duplicate \$200.00 petition fee paid on 21 April 2011 was not necessary, and will be refunded.

**DECISION**

The petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the Office of Patent Application Processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **01 March 2010**.

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283



United States Patent and Trademark Office

Michael NADREAU  
5 rue du General Leclerc  
29400 Landivisiau  
FRANCE

**MAILED**

**JUN 28 2011**

**PCT LEGAL ADMINISTRATION**

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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In re Application of  
Nadreau et al.  
Application No.: 12/675,946  
PCT No.: PCT/EP2008/061250  
Int. Filing Date: 27 August 2008  
Priority Date: 30 August 2007  
Attorney Docket No.: 3340.272WOUS  
For: Method Of Injecting A Treatment Substance Into  
Eggs And The Corresponding Injection Head

Dear Mr. Nadreau:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3283. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Requests for information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1(800) 972-6382 (outside the Washington D.C. area).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283

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**OCT 28 2010**

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Nixon Peabody LLP  
P.O. Box 60610  
Palo Alto CA 94306

**PCT LEGAL ADMINISTRATION**

In re Application of :  
SUH, Sang-Hyuk, et al. :  
Application No.: 12/675,960 :  
PCT No.: PCT/KR2008/006692 :  
Int. Filing Date: 13 November 2008 : **DECISION**  
Priority Date: 13 November 2007 :  
Attorney's Docket No.: 745273-053 :  
For: PREPREG HAVING UNIFORM ... :  
USING THE SAME :

This decision is in response to applicants' "Remarks," filed in the United States Patent and Trademark Office on 16 August 2010. It has been treated as a petition under 37 CFR 1.181 to vacate the Notification of Insufficient Fees (Form PCT/DO/EO/923) mailed 15 June 2010.

The fees required under 37 CFR 1.492 are those for the international application. A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that is effective to cancel claims and/or eliminate multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492(d)(e) and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492(f). MPEP 1893.01(c). Applicants did not file a preliminary amendment. See 37 CFR 1.121. Further, applicants assert that the Office incorrectly processed an "English translation" of the published international. The application was published in English.

For the above reasons, applicants' petition to vacate the requirement for additional claim fees is **DISMISSED** without prejudice. The additional fees will be charged to deposit account no. 50-3557, as authorized.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

**SOROKER-AGMON ADVOCATE AND PATENT ATTORNEYS  
NOLTON HOUSE, 14 SHENKAR STREET  
HERZELIYA PITUACH 46725 IL ISRAEL**

**MAILED**

**JAN 27 2012**

In re Application of	:	<b>OFFICE OF PETITIONS</b>
Adi Mor-Barak	:	
Application No. 12/675,972	:	<b>DECISION ON</b>
Filed: March 2, 2010	:	<b>PETITION TO WITHDRAW</b>
Attorney Docket No. 5425/1.2	:	<b>FROM RECORD</b>
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 23, 2012.

The request is **NOT APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request cannot be approved because there is no indication that the acts noted in the above-identified certifications for items (1) and (2) has been performed.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet  
Petitions Examiner  
Office of Petitions



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**SOROKER-AGMON ADVOCATE AND PATENT  
ATTORNEYS  
NOLTON HOUSE, 14 SHENKAR STREET  
HERZELIYA PITUACH 46725 IL ISRAEL**

In re Application of  
Adi Mor-Barak  
Application No. 12/675,972  
Filed: March 2, 2010  
Attorney Docket No. 5425/1.2

**MAILED**  
**FEB 08 2012**  
**OFFICE OF PETITIONS**

**DECISION ON PETITION  
TO WITHDRAW  
FROM RECORD**

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 7, 2012.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Daniel Schatz on behalf of all attorneys/agents associated with customer number 67305. All attorneys/agents associated with customer number 67305 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The correspondence address has been changed and is copied below.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet  
Petitions Examiner  
Office of Petitions

cc: Bit To Go Ltd.  
74 Hanesher Street  
Ra'anana, IL 43723



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UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/675,972	03/02/2010	Adi Mor-Barak	5425/1.2

**CONFIRMATION NO. 8682**

**POWER OF ATTORNEY NOTICE**



OC000000052469424

67305  
SOROKER-AGMON ADVOCATE AND PATENT ATTORNEYS  
NOLTON HOUSE, 14 SHENKAR STREET  
HERZELIYA PITUACH, 46725  
ISRAEL

Date Mailed: 02/08/2012

**NOTICE REGARDING CHANGE OF POWER OF ATTORNEY**

This is in response to the Power of Attorney filed 02/07/2012.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

/kainabinet/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101



UNITED STATES PATENT AND TRADEMARK OFFICE

**MAILED**

NOV 03 2010

HESPOS & PORCO LLP  
110 West 40th Street  
Suite 2501  
NEW YORK NY 10018

PCT LEGAL ADMINISTRATION

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Alexandria, VA 22313-1450  
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In re Application of:	:	
MORINO, Satoru, et al.	:	
U.S. Application No.: 12/675,984	:	
PCT No.: PCT/JP2008/052407	:	
International Filing Date: 14 February 2008	:	
Priority Date: 03 September 2007	:	
Attorney Docket No.: FPCT09-155US	:	
For: EXTRACTION PREVENTING	:	
DEVICE FOR CONNECTOR	:	
	:	DECISION ON RENEWED PETITION (37 CFR 1.47(a))

This decision is issued in response to applicants' "Renewed Petition Under 37 CFR 1.47(a)" filed 29 September 2010. Applicants have previously paid the required petition fee.

**BACKGROUND**

The procedural background for the present application was set forth in the decision mailed on 28 July 2010. The decision dismissed without prejudice the petition under 37 CFR 1.47(a), finding that applicants had failed to satisfy all requirements of a grantable petition. Specifically, applicants had failed to provide an express statement of the last known address of the non-signing inventor and an adequate showing that the non-signing inventor had refused to execute the application or could not be located after diligent effort.

On 29 September 2010, applicants filed the renewed petition considered herein.

**DISCUSSION**

The renewed petition confirms that the address set forth on the letter forwarded to the non-signing inventor (attached to the original petition) is the last known address of the inventor. The renewed petition also includes supplemental materials describing additional efforts made to locate the non-signing inventor, including contacting former co-workers of the non-signing inventor and performing an internet search. These materials, in combination with those previously submitted, provide an acceptable showing that the non-signing inventor cannot be located after diligent effort.

In view of the above, applicants have now satisfied the final requirements of a grantable petition under 37 CFR 1.47(a).

**CONCLUSION**

Applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

The application is accepted without the signature of non-signing inventor Satoru MORINO.

A notice of the acceptance of the application will be published in the Official Gazette, and a letter informing the non-signing inventor of the application will be forwarded to the inventor's last-known address, as set forth in the petition.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing, including consideration of the additional sequence listing materials filed by applicants on 02 October 2008. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 02 March 2010.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296  
Facsimile: (571) 273-0459



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**NOV 03 2010**

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Alexandria, VA 22313-1450  
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Mr. Satoru MORINO  
A102, 3-7-25, Inou  
Suzuka -City 510-0205  
JAPAN

**PCT LEGAL ADMINISTRATION**

In re Application of: MORINO, Satoru, et al.  
U.S. Application No.: 12/675,984  
PCT No.: PCT/JP2008/052407  
International Filing Date: 14 February 2008  
Priority Date: 03 September 2007  
Attorney Docket No.: FPCT09-155US  
For: EXTRACTION PREVENTING DEVICE FOR CONNECTOR

Dear Mr. MORINO:

You are identified as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296  
Facsimile: (571) 273-0459

Counsel Of Record:  
Gerald E. Hespos  
HESPOS & PORCO LLP  
110 West 40th Street  
Suite 2501  
NEW YORK NY 10018



United States Patent and Trademark Office

**MAILED**

**NOV 29 2010**

**PCT LEGAL ADMINISTRATION**

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DICKINSON WRIGHT PLLC  
38525 WOODWARD AVENUE  
SUITE 2000  
BLOOMFIELD HILLS MI 48304-297

In re Application of	:	
Galecka et al.	:	
Application No.: 12/676,246	:	DECISION
PCT No.: PCT/US2008/075693	:	
Int. Filing Date: 09 September 2008	:	ON.
Priority Date: 10 September 2007	:	
Attorney Docket No.: 21407-00277	:	PETITION
For: Electrical Connection Protection Unit	:	

This is in response to the petition under 37 CFR 1.47(b) filed on 02 August 2010, which is being treated under 37 CFR 1.47(a).

### **BACKGROUND**

This international application was filed on 09 September 2008, claimed an earliest priority date of 10 September 2007, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 10 March 2010. Applicants filed *inter alia* the basic national fee on 03 March 2010.

On 31 March 2010, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring *inter alia* the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

### **DISCUSSION**

Petitioner requests treatment under 37 CFR 1.47(b), but review of the declaration filed on 02 August 2010 reveals that it has been signed by at least one joint inventor. Pursuant to the practice explained at MPEP 409.03(b), the petition is being treated under 37 CFR 1.47(a).

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding **requirement (1)**, the \$200.00 petition fee has been paid.

Regarding **requirement (2)**, petitioner describes the sending of correspondence to Mr. Vincent. A copy of a letter sent to him on 15 March 2010 by Martina Tiedemann has been provided, but the letter does not indicate whether it was accompanied by a copy of the application papers, and no first-hand statement by Ms. Tiedemann has been provided. Petitioner has also provided copies of letters sent by Atty. Jones on 22 April 2010 and 21 June 2010, and stated that the 21 June 2010 letters were accompanied by declarations and copies of the

application. Petitioner indicates that Mr. Vincent picked up the 21 June 2010 letter on 13 July 2010, but the instant petition was filed less than one month later. As such, it is not clear whether Mr. Vincent was given sufficient time to review the materials and return an executed declaration before the petition was filed. As such, it would not be appropriate to conclude that requirement (2) has been satisfied at this time.

Regarding **requirement (3)**, the petition indicates the last known address of the non-signing joint inventor.

Regarding **requirement (4)**, the declaration filed on 02 August 2010 has been signed on behalf of Mr. Vincent by Sandra Quick as agent of putative 37 CFR 1.47(b) applicant Johnson Controls. However, insofar as this petition is properly treated under 37 CFR 1.47(a), it is not appropriate for the declaration to be signed on behalf of Mr. Vincent by a putative 37 CFR 1.47(b) applicant. It is also noted that the declaration appears to have been assembled from separately-signed sheets (in that two differently signed copies of sheet 3 are present). *See* MPEP 605.04(a) ("Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration (by combining the signature pages)"). As such, it would not be appropriate to accept this declaration in satisfaction of requirement (4).

### **DECISION**

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283



United States Patent and Trademark Office

DICKINSON WRIGHT PLLC  
38525 WOODWARD AVENUE  
SUITE 2000  
BLOOMFIELD HILLS MI 48304-297

**MAILED**

MAY 31 2011

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In re Application of	:	
Galecka et al.	:	
Application No.: 12/676,246	:	DECISION
PCT No.: PCT/US2008/075693	:	
Int. Filing Date: 09 September 2008	:	ON
Priority Date: 10 September 2007	:	
Attorney Docket No.: 21407-00277	:	PETITION
For: Electrical Connection Protection Unit	:	

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 31 January 2011.

**DISCUSSION**

In a Decision mailed on 29 November 2010, the petition under 37 CFR 1.47(b) filed on 02 August 2010 was treated under 37 CFR 1.47(a) and dismissed, without prejudice, because

Regarding **requirement (2)**, petitioner describes the sending of correspondence to Mr. Vincent. A copy of a letter sent to him on 15 March 2010 by Martina Tiedemann has been provided, but the letter does not indicate whether it was accompanied by a copy of the application papers, and no first-hand statement by Ms. Tiedemann has been provided. Petitioner has also provided copies of letters sent by Atty. Jones on 22 April 2010 and 21 June 2010, and stated that the 21 June 2010 letters were accompanied by declarations and copies of the application. Petitioner indicates that Mr. Vincent picked up the 21 June 2010 letter on 13 July 2010, but the instant petition was filed less than one month later. As such, it is not clear whether Mr. Vincent was given sufficient time to review the materials and return an executed declaration before the petition was filed. As such, it would not be appropriate to conclude that requirement (2) has been satisfied at this time.

Regarding **requirement (4)**, the declaration filed on 02 August 2010 has been signed on behalf of Mr. Vincent by Sandra Quick as agent of putative 37 CFR 1.47(b) applicant Johnson Controls. However, insofar as this petition is properly treated under 37 CFR 1.47(a), it is not appropriate for the declaration to be signed on behalf of Mr. Vincent by a putative 37 CFR 1.47(b) applicant. It is also noted that the declaration appears to have been assembled from separately-signed sheets (in that two differently signed copies of sheet 3 are present). See MPEP 605.04(a) ("Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration (by combining the signature pages)"). As such, it would not be appropriate to accept this declaration in satisfaction of requirement (4).

In response, concerning requirement (2), in view of the further passage of time without Mr. Vincent having returned an executed declaration, it now would be appropriate to regard this requirement as having been satisfied.

Regarding requirement (4), "Applicants have submitted the Declaration and Power of Attorney signed by each individual inventor as received as individual declarations." As this petition is properly treated under 37 CFR 1.47(a), the declaration must be executed by the available inventors on behalf of themselves and the non-signing inventor, per MPEP 409.03(a). The declarations signed by the inventors and filed on 31 January 2011 are being accepted in satisfaction of requirement (4). With respect to the declaration signed (only) by Ms. Quick, she is implicitly signing in the capacity of a representative of a putative 37 CFR 1.47(b) applicant, but this is not appropriate in this case, per the first paragraph of MPEP 409.03(b). None of the other inventors have subscribed to this particular declaration document, so it is regarded as extraneous.

#### **DECISION**

The petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the Office of Patent Application Processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **31 January 2011**.

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283  
Fax: (571) 273-0459



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Jeffrey Vincent  
10921 Stoney Point Drive  
South Lyon, MI 48179

**MAILED**

**MAY 31 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of  
Galecka et al.  
Application No.: 12/676,246  
PCT No.: PCT/US2008/075693  
Int. Filing Date: 09 September 2008  
Priority Date: 10 September 2007  
Attorney Docket No.: 21407-00277  
For: Electrical Connection Protection Unit

Dear Mr. Vincent:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3283. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Requests for information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1(800) 972-6382 (outside the Washington D.C. area).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283

DICKINSON WRIGHT PLLC  
38525 WOODWARD AVENUE  
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Alexandria, VA 22313-1450

MUETING, RAASCH & GEBHARDT, P.A.  
P.O. BOX 581336  
MINNEAPOLIS, MN 55458-1336

**MAILED**

**AUG 04 2011**

**OFFICE OF PETITIONS**

Applicant: Geert-Jan Boons  
Appl. No.: 12/676,253  
International Filing Date: September 5, 2008  
Title: SYNTHETIC LIPID A DERIVATIVE  
Attorney Docket No.: 235.01000101  
Pub. No.: US 2010/0221269 A1  
Pub. Date: September 2, 2010

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on October 8, 2010, for the above-identified application.

The request is granted.

The corrected patent application publication will be published in due course, unless the patent issues before the application is republished.

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709.

Mark Polutta  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/676,306	03/03/2010	Koji Aso	12916/16	1624
23838	7590	09/14/2011	EXAMINER	
KENYON & KENYON LLP			CRONIN, STEPHEN K	
1500 K STREET N.W.			ART UNIT	PAPER NUMBER
SUITE 700			3747	
WASHINGTON, DC 20005			MAIL DATE	DELIVERY MODE
			09/14/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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KENYON & KENYON LLP  
1500 K STREET N.W.  
SUITE 700  
WASHINGTON DC 20005

In re Application of	:	
ASO, KO	:	DECISION ON REQUEST TO
Application No. 12/676,306	:	PARTICIPATE IN PATENT
Filed: March 3, 2010	:	PCT/PROSECUTION HIGHWAY
Attorney Docket No. 12916/16	:	PROGRAM AND PETITION
For: ABNORMALITY DETECTION DEVICE	:	37 CFR 1.102(a)
FOR INTERNAL COMBUSTION ENGINE	:	

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed August 15, 2011 to make the above-identified application special.

The request and petition are dismissed.

A grantable request to participate in the PPH pilot program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO/PCT application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions from each of the JPO/PCT application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition met all conditions except Item #3

The request to participate in the PPH pilot program and petition does not show JPO allowed claims 1-11 correspond with the current pending claims 1-14. Currently, this application contains claims 1-14 as filed on March 3, 2010. The newly added independent claims 12-14 were not examined by the JPO examiner. In order to grant the PPH Request in this case, it is suggested that the applicant cancel the newly added independent claims 12-14.

It must be noted that the independent claims 12-14 with non-means plus function language contain a different scope from the JPO allowed claims. The searches are totally different. Therefore, it can not be said the newly added independent claims 12-14 contain a similar or same scope as the JPO allowed independent claims.

Applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application.

Applicant is given a time period of **ONE MONTH or THIRTY DAYS**, whichever is longer, from the mailing date of this decision to correct the deficiencies. **NO EXTENSION OF TIME UNDER 37 CFR 1.136 IS PERMITTED.** If the deficiencies are not corrected with the time period given, the application will await action on the merits for claims 1-14 in its regular turn.

Response must be filed via EFS-Web. Telephone inquiries concerning this decision should be directed to Henry C. Yuen, at 571-272-4856.

/Henry C. Yuen/

---

Henry C. Yuen  
Special Programs Examiner  
Technology Center 3700  
Tel: 571-272-4856

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANTS : Koji ASO, et al.  
SERIAL NO. : 12/676,306  
FILED : 03 March 2010  
FOR : ABNORMALITY DETECTION DEVICE FOR INTERNAL  
COMBUSTION ENGINE  
GROUP ART UNIT : 3747 Conf. No. 1624  
EXAMINER : Stephen K. Cronin

COMMISSIONER FOR PATENTS  
PETITIONS BRANCH  
P. O. Box 1450  
Alexandria, VA 22313-1450

Attention: Henry C. Yuen, Special Programs Examiner  
Technology Center 3700

**RESPONSE TO DISMISSAL OF REQUEST FOR PPH PROGRAM PARTICIPATION**

SIR:

In response to the communication mailed 14 September 2011 dismissing the request and petition for PPH Program participation, please further amend the application as follows:

**Amendments to the Claims begin on page 2.**

**Remarks begin on page 7.**



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/676,306	03/03/2010	Koji Aso	12916/16	1624
23838	7590	10/03/2011		
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			EXAMINER CRONIN, STEPHEN K	
			ART UNIT 3747	PAPER NUMBER
			MAIL DATE 10/03/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
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P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

KENYON & KENYON LLP  
1500 K STREET N.W.  
SUITE 700  
WASHINGTON DC 20005

In re Application of	:	
<u>ASO, KOJI</u> , et al.	:	DECISION ON REQUEST TO
Application No. 12/676,306	:	PARTICIPATE IN PATENT
Filed: March 03, 2010	:	PCT/PROSECUTION HIGHWAY
Attorney Docket No. 12916/16	:	PROGRAM AND PETITION
For: ABNORMALITY DETECTION DEVICE	:	TO MAKE SPECIAL UNDER
FOR INTERNAL COMBUSTION ENGINE	:	37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed September 28, 2011 to make the above-identified application special.

The request and petition are granted.

A grantable request to participate in the PPH pilot program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO/PCT application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions from each of the JPO/PCT application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

In light of the petition being properly submitted, the request to participate in the PPH program and the petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application. Upon completion of pre-examination processing, this application will be forwarded to an examiner for examination.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen at 571-272-4485. All other inquiries concerning the examination or status of the application should be directed to Stephen Cronin, SPE of Art Unit 3747, and 571-272-4536 for Class 123 and also accessible in the PAIR system at <http://www.uspto.gov/eac/index.html>.

Petition is **granted**.

/Henry C. Yuen/

---

Henry C. Yuen, Special Programs Examiner  
Technology Center 3700 – Mechanical Engineering,  
Manufacturing and Products  
571-272-4856



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450

**MAILED**

**JAN 31 2012**

**OFFICE OF PETITIONS**

**LRK Patent Law Firm  
1952 Gallows Rd  
Suite 200  
Vienna VA 22182**

In re Application of : DECISION ON REQUEST TO  
Han Min JUNG et al. : PARTICIPATE IN PPH PROGRAM  
Application No. 12/676,380 : AND PETITION TO MAKE SPECIAL  
Filed: March 4, 2010 : UNDER 37 CFR 1.102(a)  
Atty. Docket No.: P10278US :  
For: SYSTEM AND METHOD FOR INSTANCES REGISTERING BASED ON  
HISTORY

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed October 24, 2011 to make the above-identified application special.

The petition and request are **DENIED**.

A grantable request to participate in the PPH (patent prosecution highway) program and petition to make special require:

(1) the U.S. application is a Paris Convention application which either validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the KIPO (Korean Intellectual Property Office) or claims priority to a PCT application that contains no priority claims. Alternatively, it can be a national stage application under the PCT which validly claims priority to an application filed in the KIPO or claims priority to a PCT application that contains no priority claims. It can also be a "bypass application" filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application validly claims priority to an application filed in the KIPO or claims priority to a PCT application that contains no priority claims, or contains no priority claim;

(2) applicant must submit a copy of the allowable/patentable claim(s) from the KIPO application(s) along with an English translation thereof and a statement that the English translation is accurate;

(3) all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the KIPO application(s);

(4) examination of the U.S. application has not begun;

(5) applicant must submit a copy of all the office actions from each of the KIPO application(s) containing the allowability/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and

(6) applicant must submit an IDS listing the documents cited by the KIPO examiner in the KIPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

Requirements (1) to (3) and (5) to (6) above are considered to have been met. However, the request to participate in the PPH program and petition fail to meet requirement (4).

Regarding the requirement of requirement (4), condition (4) is not met as a non-final Office action for the instant application was mailed November 8, 2011.

Telephone inquiries concerning this decision should be directed to Robert DeWitty, Petition Attorney, Office of Petitions at 571-272-8427.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.



Anthony Knight  
Director  
Office of Petitions

MAILED

OCT 07 2010



UNITED STATES PATENT AND TRADEMARK OFFICE

PCT LEGAL ADMINISTRATION

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

THOMAS, KAYDEN, HORSTEMEYER & RISLEY LLP  
600 GALLERIA PARKWAY, 15TH FLOOR  
ATLANTA GA 30339

In re Application of	:	
JEDEMA, Friso, et al.	:	
U.S. Application No.: 12/676,393	:	
PCT No.: PCT/IB2008/053498	:	
Int. Filing Date: 29 August 2008	:	DECISION
Priority Date: 07 September 2007	:	
Attorney Docket No.: 252011-4500	:	
For: AN ELECTRONIC COMPONENT,	:	
AND A METHOD OF	:	
MANUFACTURING AN	:	
ELECTRONIC COMPONENT	:	

This decision is in response to applicants' petition filed in the United States Patent and Trademark Office on 11 August 2010.

The correspondence address of record in this application is the one associated with customer no. 47390, as set forth in the power of attorney by assignee, filed 05 May 2010. The appointed practitioners are those associated with customer no. 47390.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292

Doc Code: PPH.PCT.652

Document Description: Petition to make special under PCT-Patent Pros Hwy

PTO/SB/20PCT-US (09-10)

Approved for use through 01/31/2012. OMB 0651-0058

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM IN A U.S. APPLICATION WHERE THE USPTO WAS THE ISA OR IPEA**

Application No:	12/676,434	Filing date:	March 4, 2010
First Named Inventor:	Brian Manning		

Title of the Invention: **GAMING SYSTEM HAVING DYNAMIC PLAYER INPUTS**

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBC/EF5\\_HELP.HTML](http://www.uspto.gov/ebc/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/US2008/010184

**The international date of the corresponding PCT application(s) is/are:**

August 28, 2008

**I. List of Required Documents:**

- a. **A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**

☒

Is attached

☐

Is not attached because the document is already in the U.S. application.

- b. **A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**

☒

Is attached.

☐

Is not attached because the document is already in the U.S. application.

- c. **English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

**REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM  
IN A U.S. APPLICATION WHERE THE USPTO WAS THE ISA OR  
IPEA**  
(continued)

☒ Are attached.

☐ Have already been filed in the above-identified U.S. application on \_\_\_\_\_

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

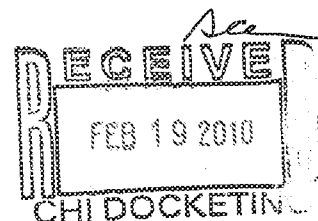
The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant ( i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

**REQUIRED DOCUMENT I(A)**

**The following document(s) include(s) a copy of the latest international work product in the corresponding PCT application**

# PATENT COOPERATION TREATY



From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:  
WILLIAM D. PEGG  
NIXON PEABODY LLP  
300 S. RIVERSIDE PLAZA  
16TH FLOOR  
CHICAGO, IL 60606

REVIEWED BY DOCKET

## PCT

NOTIFICATION OF TRANSMITTAL OF  
INTERNATIONAL PRELIMINARY  
REPORT ON PATENTABILITY  
(Chapter II of the Patent Cooperation Treaty)

(PCT Rule 71.1)

Date of mailing  
(day/month/year)

12 FEB 2010

Applicant's or agent's file reference

WMS-134 PCT

247079-734WPT

IMPORTANT NOTIFICATION

International application No.

PCT/US08/10184

International filing date (day/month/year)

28 August 2008 (28.08.2008)

Priority date (day/month/year)

05 September 2007 (05.09.2007)

Applicant

WMS GAMING INC.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary report on patentability and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. **REMINDER**

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices)(Article 39(1))(see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the *PCT Applicant's Guide*.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed invention is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the IPEA/ US

Mail Stop PCT, Attn: IPEA/US  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
Facsimile No. (571) 273-3201

Authorized officer

Scott Jones  
Telephone No. (571) 272-6788

Form PCT/IPEA/416 (January 2004)

# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference WMS-134 PCT	<b>FOR FURTHER ACTION</b>		See Form PCT/IPEA/416																								
International application No. PCT/US08/10184	International filing date (day/month/year) 28 August 2008 (28.08.2008)	Priority date (day/month/year) 05 September 2007 (05.09.2007)																									
International Patent Classification (IPC) or national classification and IPC IPC: A63F 13/00( 2006.01) USPC: 463/16-20																											
Applicant WMS GAMING INC.																											
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>4</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p style="margin-left: 20px;">a. <input checked="" type="checkbox"/> (sent to the applicant and to the International Bureau) a total of <u>3</u> sheets, as follows:</p> <p style="margin-left: 40px;"><input checked="" type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p style="margin-left: 40px;"><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p style="margin-left: 20px;">b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in electronic form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>																											
<p>4. This report contains indications relating to the following items:</p> <table style="width: 100%; border: none;"> <tr> <td style="width: 10%;"><input checked="" type="checkbox"/></td> <td style="width: 20%;">Box No. I</td> <td>Basis of the report</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. II</td> <td>Priority</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table>				<input checked="" type="checkbox"/>	Box No. I	Basis of the report	<input type="checkbox"/>	Box No. II	Priority	<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input type="checkbox"/>	Box No. IV	Lack of unity of invention	<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	<input type="checkbox"/>	Box No. VI	Certain documents cited	<input type="checkbox"/>	Box No. VII	Certain defects in the international application	<input type="checkbox"/>	Box No. VIII	Certain observations on the international application
<input checked="" type="checkbox"/>	Box No. I	Basis of the report																									
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<input type="checkbox"/>	Box No. VI	Certain documents cited																									
<input type="checkbox"/>	Box No. VII	Certain defects in the international application																									
<input type="checkbox"/>	Box No. VIII	Certain observations on the international application																									
Date of submission of the demand 06 July 2009 (06.07.2009)		Date of completion of this report 27 January 2010 (27.01.2010)																									
Name and mailing address of the IPEA/ US Mail Stop PCT, Attn: IPEA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (571) 273-3201		Authorized officer Scott Jones Telephone No. (571) 272-6788																									

Form PCT/IPEA/409 (cover sheet)(April 2007)

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/US08/10184

## Box No. I Basis of the report

1. With regard to the **language**, this report is based on:

- ☒ the international application in the language in which it was filed.
- ☐ a translation of the international application into English, which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3(a) and 23.1(b))
- ☐ publication of the international application (under Rule 12.4(a))
- ☐ international preliminary examination (under Rules 55.2(a) and/or 55.3(a))

2. With regard to the **elements** of the international application, this report is based on (*replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report*):

- ☐ the international application as originally filed/furnished
- ☒ the description:  
pages 1-20 as originally filed/furnished  
pages\* NONE received by this Authority on \_\_\_\_\_  
pages\* NONE received by this Authority on \_\_\_\_\_
- ☒ the claims:  
pages NONE as originally filed/furnished  
pages\* NONE as amended (together with any statement) under Article 19  
pages\* 21-23 received by this Authority on 06 July 2009 (07.07.2009)  
pages\* NONE received by this Authority on \_\_\_\_\_
- ☐ the drawings:  
pages 1-8 as originally filed/furnished  
pages\* NONE received by this Authority on \_\_\_\_\_  
pages\* NONE received by this Authority on \_\_\_\_\_
- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.

3. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, Nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (*specify*): \_\_\_\_\_
- ☐ any table(s) related to the sequence listing (*specify*): \_\_\_\_\_

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, Nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (*specify*): \_\_\_\_\_
- ☐ any table(s) related to the sequence listing (*specify*): \_\_\_\_\_

5. ☐ This report has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 70.2(e)).

\* If item 4 applies, some or all of those sheets may be marked "superseded."

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.  
PCT/US08/10184**Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. Statement**

Novelty (N)	Claims <u>1-20</u>	YES
	Claims <u>NONE</u>	NO
Inventive Step (IS)	Claims <u>1-20</u>	YES
	Claims <u>NONE</u>	NO
Industrial Applicability (IA)	Claims <u>1-20</u>	YES
	Claims <u>NONE</u>	NO

**2. Citations and Explanations (Rule 70.7)**

Claims 1-20 meet the novelty and inventive step criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest "during the play of the primary wagering game, cause the display to present an altered display of the at least one soft key to reveal some or all of the first portion in a deactivated state, such deactivated state occurring during play of the primary wagering game and ending upon conclusion of the play of the primary wagering game," as recited in independent claim 1; "displaying a first soft key overlying and concealing a first portion of the primary wagering game;" and "during the play of the primary wagering game, displaying an altered version of the first soft key to reveal at least part of the first portion such that the altered version of the first soft key is deactivated until the play of the primary wagering game is concluded," as recited in independent claim 8; and displaying a soft key overlying and concealing a first portion of the primary wagering game" and "altering the display of the soft key to reveal at least part of the first portion, the altered display of the soft key being deactivated until the play of the primary wagering game is concluded," as recited in independent claim 15.

Claims 1-20 meet the criteria set out in PCT Article 33(4), and thus has industrial applicability because the subject matter claimed can be made or used in industry.

**REQUIRED DOCUMENT I(B)**

**The following document(s) include(s) a copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the corresponding PCT application**

**What is claimed is:**

1. A gaming system comprising:
  - a wager input device;
  - a display for displaying a primary wagering game;
  - a touch screen overlying at least a portion of the display; and
  - a controller operative to:
    - (i) cause the display to display at least one soft key, the at least one soft key overlying and concealing a first portion of the primary wagering game in an active state;
    - (ii) cause the display to display a play of the primary wagering game; and
    - (iii) during the play of the primary wagering game, cause the display to present an altered display of the at least one soft key to reveal some or all of the first portion in a deactivated state, such deactivated state occurring during play of the primary wagering game and ending upon conclusion of the play of the primary wagering game.
2. The system of claim 1, wherein the controller is further operative to detect a first player input on the touch screen associated with the at least one soft key.
3. The system of claim 2, wherein the first player input initiates the play of the primary wagering game.
4. The system of claim 1, wherein the altered display of the soft key comprises a change in the translucence of at least a portion of the soft key.
5. The system of claim 4, wherein the at least a portion of the soft key is made transparent.
6. The system of claim 1, wherein the altered display of the soft key comprises a reduction in size of the soft key.
7. The system of claim 1, wherein the altered display of the soft key comprises a moving or relocation the soft key on the display.

8. A method of operating a wagering game comprising:  
receiving a wager;  
displaying a primary wagering game on a first display;  
displaying a first soft key overlying and concealing a first portion of the primary wagering game;  
detecting a player input to initiate a play of the primary wagering game; and  
during the play of the primary wagering game, displaying an altered version of the first soft key to reveal at least part of the first portion, such that the altered version of the first soft key is deactivated until the play of the primary wagering game is concluded.
9. The method of claim 8, wherein the altered version of the first soft key comprises a change in one or more of a size, translucence, and location of the first soft key.
10. The method of claim 8, wherein the first display is supported by a housing of a handheld gaming device.
11. The method of claim 10, wherein the handheld gaming device includes at least one hand grip, wherein the first soft key is displayed proximate the at least one hand grip.
12. The method of claim 8, further comprising displaying a second soft key.
13. The method of claim 12, wherein the second soft key overlies and conceals a second portion of the primary wagering game.
14. The method of claim 13, further comprising, during play of the primary wagering game, displaying an altered version of the second soft key to reveal at least part of the second portion.

15. A method of operating a wagering game comprising:  
receiving a wager;  
displaying a primary wagering game on a first display;  
displaying a soft key overlying and concealing a first portion of the primary wagering game;  
detecting a player selection of the soft key via a touch screen overlying the first display;  
in response to the player selection of the soft key, initiating a play of the primary wagering game; and  
prior to a conclusion of the play of the primary wagering game, altering the display of the soft key to reveal at least part of the first portion, the altered display of the soft key being deactivated until the play of the primary wagering game is concluded.
16. The method of claim 15, wherein altering the display of the soft key comprises one or more of resizing the soft key, changing the translucence of the soft key, and moving the soft key.
17. The method of claim 15, wherein the primary wagering game comprises a plurality of reels, the plurality of reels having a plurality of symbols thereon.
18. The method of claim 17, wherein the first portion of the primary wagering game comprises at least one of the plurality of symbols.
19. The method of claim 15, further comprising, upon conclusion of the play of the wagering game, restoring the soft key to an initial state overlying and concealing the first portion.
20. One or more computer readable storage media encoded with instructions for performing the method of claim 15.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.								
12/676,434	03/04/2010	Brian Manning	247079-000734USPX	2614								
70243 NIXON PEABODY LLP 300 S. Riverside Plaza 16th Floor CHICAGO, IL 60606	7590 07/25/2011		<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">VO, PETER DUNG BA</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>3718</td><td></td></tr></table>		EXAMINER		VO, PETER DUNG BA		ART UNIT	PAPER NUMBER	3718	
EXAMINER												
VO, PETER DUNG BA												
ART UNIT	PAPER NUMBER											
3718												
			<table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>07/25/2011</td><td>PAPER</td></tr></table>		MAIL DATE	DELIVERY MODE	07/25/2011	PAPER				
MAIL DATE	DELIVERY MODE											
07/25/2011	PAPER											

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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NIXON PEABODY LLP  
300 S. Riverside Plaza  
16th Floor  
CHICAGO IL 60606

<i>In re</i> Application of:	:	DECISION ON A REQUEST TO
MANNING, BRIAN, et al	:	PARTICIPATE IN PATENT
Serial No.: 12/676434	:	PCT/PROSECUTION HIGHWAY
Filed: 03/04/2010	:	PROGRAM AND PETITION
Attorney Docket No. : 247079-000734USPX	:	TO MAKE SPECIAL UNDER
Title: GAMING SYSTEM HAVING DYNAMIC :	:	CFR 1.102(a)
PLAYER INPUTS	:	

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed July 8, 2011 to make the above-identified application special.

The request and petition are **granted**.

A grantable request to participate in the PPH pilot program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more PCT applications filed in the JPO, EPO, KIPO, or USPTO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the PCT application(s) latest international work product (the written opinion or the IPER) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the PCT application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of the latest international work product from the PCT application containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

In light of the petition being properly submitted, the request to participate in the PPH program and the petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application.

Response must be filed via EFS-Web. Telephone inquiries concerning this decision should be directed to Henry C. Yuen, at 571-272-4856.

Petition is **granted**.

/Henry C. Yuen/

---

Henry C. Yuen  
Special Programs Examiner  
Technology Center 3700  
Tel: 571-272-4856

23 SEP 2010



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NOVO NORDISK, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
100 COLLEGE ROAD WEST  
PRINCETON, NJ 08540

In re Application of	:	DECISION ON
SPETZLER et al	:	
Application No.: 12/676,451	:	
PCT No.: PCT/EP2008/061755	:	
Int. Filing Date: 05 September 2008	:	PETITION UNDER
Priority Date: 05 September 2007	:	
Attorney Docket No.: 7668.204-US	:	
For: GLUCAGON-LIKE PEPTIDE-1 ...	:	
PHARMACEUTICAL USE	:	37 CFR 1.182

This decision is in response to petitioner's "RESPONSE TO NOTICE TO FILE MISSING PARTS" filed on 09 July 2010, which is being treated as a petition under 37 CFR 1.182. The petition fee of \$400.00 has been charged to Deposit Account No.: 14-1447.

### **BACKGROUND**

On 04 March 2010, applicants filed in the United States Patent and Trademark Office (PTO) a Transmittal Letter (Form PTO-1390) accompanied by, *inter alia*, the basic national fee. Applicants, however, did not provide an executed oath or declaration as required under 35 U.S.C. 371(c)(4).

On 06 May 2010, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905).

On 09 July 2010, applicants submitted a "RESPONSE TO NOTICE TO FILE MISSING PARTS," composite executed declaration. In the declaration section pertaining to the name of the sixth co-inventor in the first set has been amended, REEDTZ-RUNGE, Steffen, appears; this name did not appear in the international application, which the named that appeared is RUNGE Steffen. In addition, the declaration has been signed as "REEDTZ-RUNGE, Steffen." However, no explanation has been provided for the name change or the reason for the correction of the name to the submitted name, besides the statement that this is the correct name.

### **DISCUSSION**

MPEP § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include (1) the appropriate petition fee and (2) an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

With respect to item (1), the petition fee of \$400.00 has been provided.

With respect to item (2), an affidavit has not been provided signed under REEDTZ-RUNGE, Steffen that sets forth the procedure whereby the change of name was effected. Therefore, item (2) has not been satisfied.

In the case where there is no change name of the individual but an incorrect name was given, a petition under **37 CFR 1.182** must be filed with the correction of applicant's name with an explanation.

Alternatively, applicants may provide a showing that the name correction was effected in accordance with PCT Rule 92Bis prior to the filing of the present national stage application.

For the reasons above, the application may not enter into national stage processing at this time.

### **CONCLUSION**

The petition under 37 CFR 1.182 is **DISMISSED**, without prejudice.

A proper response to the Notice must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Rafael Bacares

PCT Legal Examiner

PCT Legal Office

Telephone: (571) 272-3276

Facsimile: (571) 273-0459



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100 COLLEGE ROAD WEST  
PRINCETON, NJ 08540

MAILED

DEC 27 2010

In re Application of	:	DECISION ON	PCT LEGAL ADMINISTRATION
SPETZLER et al	:		
Application No.: 12/676,451	:		
PCT No.: PCT/EP2008/061755	:		
Int. Filing Date: 05 September 2008	:	PETITION UNDER	
Priority Date: 05 September 2007	:		
Attorney Docket No.: 7668.204-US	:		
For: GLUCAGON-LIKE PEPTIDE-1 ...	:		
PHARMACEUTICAL USE	:	37 CFR 1.182	

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.182" filed on 13 October 2010.

**BACKGROUND**

In a decision from this Office on 23 September 2010, the decision indicated that the application could not enter into national stage at that time because item (2) under MPEP §605/04(c) was not met.

On 13 October 2010, this renewed petition was filed that included an affidavit in support of the name change from Steffen Runge to **Steffen Reedtz-Runge**.

**DISCUSSION**

MPEP § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include (1) the appropriate petition fee and (2) an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

With respect to item (1), the petition fee has been paid.

With respect to item (2), petitioner has provided with the renewed petition an affidavit from Steffen Reedtz-Runge explaining her named changed from Steffen Runge (maiden name) to **Steffen Reedtz-Runge** (married named), and sets forth the procedure whereby the change of name was effected. She has also signed the affidavit under both names. Therefore, item (2) has been satisfied, and her correct name is **Steffen Reedtz-Runge**.

For the reasons above, the application may enter into national stage processing at this time.

**CONCLUSION**

The petition under 37 CFR 1.182 is **GRANTED**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing.



Rafael Bacares

PCT Legal Examiner

PCT Legal Office

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SHELL OIL COMPANY  
P.O. Box 2463  
Houston, TX 77252-2463

**MAILED**  
**DEC 30 2010**  
**PCT LEGAL ADMINISTRATION**

In re Application of :  
ESTABA SAMBRANO *et al* :  
U.S. Application No.: 12/676,475 :  
PCT No.: Unknown :  
Int. Filing Date: 08 September 2008 :  
Priority Date: 10 September 2007 :  
Attorney Docket No.: TS2040 US :  
For: PROCESS FOR PRODUCING :  
PURIFIED SYNTHESIS GAS FROM :  
SYNTHESIS GAS COMPRISING :  
TRACE AMOUNTS OF SULPHUR :  
CONTAMINANTS : ... :

**DECISION**

This decision is in response to the petition under 37 CFR 1.182 filed 03 November 2010.

**BACKGROUND**

On 04 March 2010, applicants filed papers using the USPTO EFS-Web system as the national stage of PCT/US2008/061844. However, all other papers submitted listed the international application as PCT/EP2008/061844.

On 10 May 2010, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 1.495 (Form PCT/DO/EO/903) and filing receipt. Both forms recorded the PCT number as PCT/US2008/061844.

On 22 October 2010, a communication was mailed requesting a petition under 37 CFR 1.182 to correct the PCT number.

On 03 November 2010, applicants filed the subject petition which was accompanied by a \$400.00 petition fee.

**DISCUSSION**

Applicants' petition under 37 CFR 1.182 to correct the PCT number in the above-captioned national stage application to PCT/EP2008/061844. The \$400.00 petition fee

has been paid.

A review of the above-captioned application file verifies that the wrong PCT number was designated when filing the application electronically using the USPTO EFS-Web. The application was filed as the national stage of PCT/US2008/061844; however, applicants provided a transmittal letter, declaration, international papers and a preliminary amendment corresponding to PCT/EP2008/061844 on initial filing. WIPO records also show that the name of the inventors, the title, and the international filing date correspond to PCT/EP2008/061844, not PCT/US2008/061844.

Thus, it is clear that the subject application was intended to be filed as the national stage of PCT/EP2008/061844 but for a typographical mistake.

#### **CONCLUSION**

Applicants' petition under 37 CFR 1.182 is **GRANTED**.

USPTO records have been changed to reflect that the above-captioned application is the national stage of PCT/EP2008/061844.

The Form PCT/DO/EO/903 and filing receipt mailed 10 May 2010 contain erroneous information on the international application number and are both hereby **VACATED**.

This application is being forwarded to the DO/EO/US for the mailing of a corrected Form PCT/DO/EO/903 and filing receipt.



James Thomson  
Attorney Advisor

Office of PCT Legal Administration

Tel.: (571) 272-3302



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23416  
CONNOLY BOVE LODGE & HUTZ, LLP  
P.O. Box 2207  
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FEB 07 2011

**PCT LEGAL ADMINISTRATION**

In re Application of  
TISHKOV *et al*  
U.S. Application No.: 12/676,495  
PCT No.: PCT/EP2008/061625  
Int. Filing Date: 03 September 2008  
Priority Date: 04 September 2007  
Attorney Docket No.: 13111-00143-US  
For: CYCLIC PHOSPHINES AS FLAME  
RETARDANTS

**DECISION**

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 30 November 2010.

**BACKGROUND**

On 03 May 2010, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an English translation, processing fee, oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 30 November 2010, applicants filed the subject response which was accompanied by, *inter alia*, a five-month extension and fee; a declaration signed by six of the seven named inventors on behalf of the nonsigning inventor; a \$130.00 petition fee; a declaration of facts by Ms. Liliana Ammon; and other documentary evidence in support of the petition.

**DISCUSSION**

Applicants claim that one of the co-inventors (Dr. Alexander TISHKOV) refuses to cooperate and have filed the subject petition under 37 CFR 1.47(a).

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventor.

Items (1), (3) and (4) of 37 CFR 1.47(a) are satisfied<sup>1</sup>.

Regarding item (2), the 37 CR 1.47(a) applicants claim that the conduct of Dr. TISHKOV constitutes a refusal to cooperate. In a statement of facts, Ms. Ammon states that the nonsigning inventor was contacted by email on 10 February 2010 and asked to execute the attached documents. A letter was then sent "containing the documents to be signed" on 08 March 2010. The documents were again sent on 27 April 2010 by FedEx, in mid-August 2010 and again on 06 October 2010 by email. Applicants provided documentary evidence to corroborate the facts listed by Ms. Ammon.

The 37 CFR 1.47(a) applicants' burden in showing that an inventor refuses to cooperate is explained in MPEP § 409.03(d)(II). Several pertinent segments are listed below:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made . . .

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that

---

<sup>1</sup> Applicants submitted a \$130.00 petition fee. The petition fee is \$200.00. The \$70.00 difference has been charged to Deposit Account No. 03-2775 as authorized. The last known address of the nonsigning inventor was provided. A declaration signed by six of the seven named inventors was submitted. This declaration satisfies the requirements of section 409.03(a)(A) of the MPEP and complies with 37 CFR 1.497(a) and (b).

conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

Here, applicants have not demonstrated that a complete copy of the application including specification, claims and drawings were sent to the nonsigning inventor. As such, a refusal to cooperate cannot be shown. Ms. Ammon does not state that she included a complete copy of the application in her declaration. Moreover, it is not clear from looking at the evidence whether a copy of the application was included in any of the mailings or emails.

It is also noted that the USPTO does not accept evidence in a foreign language without an accompanying English translation. The emails and DHL receipt provided as evidence with the petition are not translated.

For these reasons, item (2) of 37 CFR 1.47(a) is not yet satisfied.

#### **CONCLUSION**

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available.

**Failure to timely respond will result in the abandonment of the application.**

Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web, by facsimile to (571) 273-0459, or if mailed addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450.

  
James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302



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Wilmington, DE 19899

**MAILED**

**MAY 09 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of  
TISHKOV *et al*  
U.S. Application No.: 12/676,495  
PCT No.: PCT/EP2008/061625  
Int. Filing Date: 03 September 2008  
Priority Date: 04 September 2007  
Attorney Docket No.: 13111-00143-US  
For: CYCLIC PHOSPHINES AS FLAME  
RETARDANTS

**DECISION**

This decision is in response to the papers filed 10 March 2011 which are treated as a renewed petition under 37 CFR 1.47(a).

**BACKGROUND**

On 07 February 2011, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Applicants were given two months to respond with extensions of time available.

On 10 March 2011, applicants filed the subject response which was accompanied by a declaration executed by the nonsigning inventor.

**DISCUSSION**

In the renewed petition, applicants submitted a declaration executed by the nonsigning inventor, Alexander TISHKOV. This declaration is in compliance with 37 CFR 1.497(a) & (b).

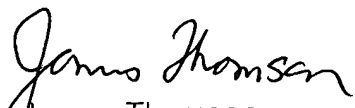
No further action on the petition under 37 CFR 1.47(a) is required.

**CONCLUSION**

For the reason discussed above, the petition under 37 CFR 1.47(a) is **DISMISSED** as **MOOT**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 03 September 2008, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 10 March 2011.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

A handwritten signature in cursive script that reads "James Thomson".

James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/676,516	03/23/2010	You-seok Seo	5040-0102PUS1	3134

2292	7590	05/25/2011
BIRCH STEWART KOLASCH & BIRCH		
PO BOX 747		
FALLS CHURCH, VA 22040-0747		

EXAMINER	
AHVAZI, BIJAN	

ART UNIT	PAPER NUMBER
1761	

NOTIFICATION DATE	DELIVERY MODE
05/25/2011	ELECTRONIC

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The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com



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[www.uspto.gov](http://www.uspto.gov)

CST

May 24, 2011

In re application of	:	DECISION ON REQUEST TO
You-Seok Seo et al	:	PARTICIPATE IN PATENT
Serial No. 12/676,516	:	PROSECUTION HIGHWAY
Filed: March 23, 2010	:	PROGRAM AND
For: FLAME RETARDANT RESIN	:	PETITION TO MAKE SPECIAL
COMPOSITION HAVING GOOD	:	UNDER 37 CFR 1.102(a)
IMPACT STRENGTH AND HIGH	:	
MELT FLOW INDEX	:	

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program, filed April 5, 2011.

The request and petition are **DISMISSED**.

A grantable request to participate in the PPH program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the KIPO, note where the KIPO application with similar claims is not the same application from which the U.S. application claims priority that the applicant must identify the relationship between the KIPO application with similar claims and the KIPO priority application;

(2) Applicant must submit a copy of:

- a. The allowable/patentable claim(s) from the KIPO application(s) or if a copy of the allowable/patentable claims is available via the Dossier Access System (DAS) applicant may request the USPTO to obtain a copy from DAS; however, if the USPTO is unable to obtain a copy from the DAS, the applicant will be required to submit a copy;
- b. An English translation of the allowable/ patentable claim(s), if applicable; and
- c. A statement that the English translation is accurate, if applicable;

(3) Applicant must:

- a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the KIPO application(s); and
- b. Submit a claims correspondence table in English;

- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit:
- a. Documentation of prior office action:
    - i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the KIPO application(s) containing the allowable/patentable claims(s) or
    - ii. if the allowable/patentable claim(s) are from "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
    - iii. if the KIPO application is a first action allowance then no office action from the KIPO is necessary should be indicated on the request/petition form:  
Further, if a copy of the documents from (i) or (ii) is available via the Dossier Access System (DAS), applicant may request the USPTO obtain a copy from the DAS; however, if the USPTO is unable to obtain a copy of the DAS, the applicant will be required to submit a copy;
  - b. An English language translation of the KIPO Office action from (5)(a)(i)-(ii) above if applicable; and
  - c. A statement that the English translation is accurate; and
- (6) Applicant must submit:
- a. An IDS listing the documents cited by the KIPO examiner in the KIPO office action (unless already submitted in this application)
  - b. Copies of documents except U.S. patents or U.S. patent application publications (unless already submitted in this application).

The request to participate in the PPH program and petition fail because:

- (3) All of the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the KIPO application(s).

Claim 1 of the present application requires that the octabromodiphenyl ethane is produced by brominating diphenylethane, however claim 1 of the KIPO application does not require that the octabromodiphenyl ethane is produced by brominating diphenylethane. Similarly, present claim 17 requires that the octabromodiphenyl ethane is produced by brominating diphenylethane, however claim 1 of the KIPO application does not require that the octabromodiphenyl ethane is produced by brominating diphenylethane.

Applicant is given a time period of **ONE MONTH OR THIRTY DAYS**, whichever is longer, from the mailing date of this decision to correct the deficiencies. **NO EXTENSION OF TIME UNDER 37 CFR 1.136 IS PERMITTED.** If the deficiencies are

Application No. 12/676,516

not corrected within the time period given, the application with await action in its regular turn.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Christine Tierney/

---

Christine Tierney  
Quality Assurance Specialist  
Technology Center 1700



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JUL 11 2011

KENYON & KENYON LLP  
1500 K STREET N.W.  
SUITE 700  
WASHINGTON DC 20005

PCT LEGAL ADMINISTRATION

In re Application of :  
DOMARD, Alain, et al. :  
Application No.: 12/676,560 :  
PCT No.: PCT/FR2008/051587 :  
Int. Filing Date: 05 September 2008 :  
Priority Date: 07 September 2007 :  
Docket No.: 13415/202092 :  
For: HOLLOW, NOTABLY :  
MULTI-MEMBRANE FIBERS, :  
METHOD FOR PREPARATION :  
THEREOF BY SPINNING AND :  
DEVICE FOR APPLYING SAID :  
METHOD :

DECISION

This is a decision on applicants' Petition Under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 09 May 2011.

**BACKGROUND**

On 06 May 2010, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors and the surcharge for late filing or the search fee, examination fee or oath or declaration were required.

On 12 May 2011, applicants filed a response to the Notification of Missing Requirements, including a declaration of the inventors.

On 08 April 2011, the Office mailed Notification of Defective Response (Form PCT/DO/EO/916) indicating that the declaration was defective as it contained non-initialed, non-dated alterations.

On 09 May 2011, applicants filed a petition under 37 CFR 1.47(a), indicating additionally that an inventor was now deceased and a new declaration.

**DISCUSSION**

While the 12 May 2010 declaration contained non-initialed, non-dated alterations, this is now regarded as a defect under 37 CFR 1.63 and not under 37 CFR 1.497(a)-(b). An examiner may later request an oath or declaration in compliance with the requirements in MPEP 605.04(a).

However, the Notification of Defective Response (Form PCT/DO/EO/916) did not indicate that the declaration lists the third inventor by a name other than the one set during the international phase. Under 37 CFR 1.41(a)(4), the inventorship of the international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92*bis*. A petition under 37 CFR 1.182 to correct the inventor's name is required. If this was a clerical error, a statement explaining that and the petition are all that is required. If the inventor's name changed, the procedure is set forth in MPEP 605.04(c).

### **CONCLUSION**

For the above reasons, applicant's petition under 37 CFR 1.47(a) and request for status under 37 CFR 1.42 are **DISMISSED AS MOOT**.

The Notification of Defective Response (Form PCT/DO/EO/916) mailed 08 April 2011 is **VACATED**.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292



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OCT 31 2011

KENYON & KENYON LLP  
1500 K STREET N.W.  
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WASHINGTON DC 20005

PCT LEGAL ADMINISTRATION

In re Application of :  
DOMARD, Alain, et al. :  
Application No.: 12/676,560 :  
PCT No.: PCT/FR2008/051587 :  
Int. Filing Date: 05 September 2008 :  
Priority Date: 07 September 2007 :  
Docket No.: 13415/202092 :  
For: HOLLOW, NOTABLY ... SAID :  
METHOD :

DECISION

This is a decision on applicants' Petition Under 37 CFR 1.182, filed in the United States Patent and Trademark Office (USPTO) on 06 September 2011.

**BACKGROUND**

On 11 July 2011, the Office mailed Decision, dismissing applicants' petition under 37 CFR 1.47(a) and indicating that a petition under 37 CFR 1.182 was required.

On 06 September 2011, applicants filed a petition under 37 CFR 1.182 to correct the name of the third listed inventor.

**DISCUSSION**

Applicants have explained that the inventor listed as on the international application as "Ricio Rivas" is named "Rocío Nohemí Rivas Araiza". The \$400 petition fee has been paid.

**CONCLUSION**

Applicant's petition under 37 CFR 1.182 to correct applicant's name is **GRANTED**.

This application is being referred to the national phase processing branch of the Office of Patent Application Processing for further action consistent with this decision.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292



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1940 DUKE STREET  
ALEXANDRIA, VA 22314

**MAILED**

DEC 02 2010

PCT LEGAL ADMINISTRATION

In re Application of KATSUYAMA et al :  
U.S. Application No.: 12/676,608 :  
PCT Application No.: PCT/CH2007/000440 :  
Int. Filing Date: 05 September 2007 :  
Priority Date Claimed: none :  
Attorney Docket No.: 355461US28PCT :  
For: COMPUTER SYSTEM AND COMPUTER- :  
IMPLEMENTED METHOD FOR :  
MANAGING A FINANCIAL PRODUCT :

DECISION

This is in response to applicant's petition under 37 CFR 1.47(b) filed 01 November 2010.

**BACKGROUND**

On 05 September 2007, applicant filed international application PCT/CH2007/000440. A copy of the international application was communicated to the USPTO from the International Bureau on 12 March 2009. The thirty-month period for paying the basic national fee in the United States expired on 05 March 2010.

On 05 March 2010, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 01 June 2010, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 01 November 2010, applicant filed the present petition under 37 CFR 1.47(b).

**DISCUSSION**

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached

after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

The petition states that joint inventors Masaaki Katsuyama and Albert Selius cannot be found. However, the petition does not adequately demonstrate that a diligent effort was made to locate the inventors. Although the petition includes evidence of a single attempt to reach the inventors by postal mail (see affidavit of Markus Schmutz, ¶¶8,12), the petition does not provide details of efforts to contact the inventors by other means such as by telephone, by electronic mail, by searching directories, and by speaking with former co-workers. Thus, it would not be reasonable to conclude at the present time that the inventors cannot be found. It is further noted that if it is shown that the letters delivered to the inventors' last known addresses were personally signed for by the inventors, it could not be concluded that the inventors cannot be located, but the inventors' failure to respond to such letters may constitute a constructive refusal to cooperate.

With regard to item (3) above, the petition states the last known addresses of the nonsigning inventors.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventors has not been provided.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

The petition states that the inventor has agreed in writing to assign the invention to Swiss Reinsurance Company ("SRC"). The petition includes copies of employment agreements signed

by the inventors which state that the inventors agree to assign inventions made during the term of employment with SRC and using SRC resources. However, the petition is not accompanied by an affidavit from the person(s) with firsthand knowledge (i.e. personal observation or supervision) of the present invention being made during the term of employment with SRC and using SRC resources. Thus, it would not be reasonable to conclude at the present time that SRC has sufficient proprietary interest in the application.

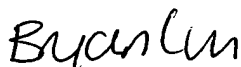
With regard to item (6) above, an adequate statement regarding preservation of the rights of the parties and/or prevention of irreparable damage has not been provided.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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ALEXANDRIA, VA 22314

**MAILED**

SEP 19 2011

PCT LEGAL ADMINISTRATION

In re Application of KATSUYAMA et al :  
U.S. Application No.: 12/676,608 :  
PCT Application No.: PCT/CH2007/000440 :  
Int. Filing Date: 05 September 2007 :  
Priority Date Claimed: none :  
Attorney Docket No.: 355461US28PCT :  
For: COMPUTER SYSTEM AND COMPUTER- :  
IMPLEMENTED METHOD FOR :  
MANAGING A FINANCIAL PRODUCT :

DECISION

This is in response to applicant's renewed petition under 37 CFR 1.47(b) filed on 02 March 2011.

**BACKGROUND**

On 05 September 2007, applicant filed international application PCT/CH2007/000440. A copy of the international application was communicated to the USPTO from the International Bureau on 12 March 2009. The thirty-month period for paying the basic national fee in the United States expired on 05 March 2010.

On 05 March 2010, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 01 June 2010, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 01 November 2010, applicant filed a petition under 37 CFR 1.47(b).

On 02 December 2010, this Office mailed a decision dismissing the 01 November 2010 petition.

On 02 March 2011, applicant filed the instant renewed petition under 37 CFR 1.47(b).

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Petitioner previously satisfied items (1) and (3) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of . . . documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

The petition states that joint inventors Masaaki Katsuyama and Albert Selius cannot be found. The petition adequately demonstrates that a diligent effort was made to locate the inventors. Specifically, the petition includes evidence of unsuccessful attempts to reach the inventors by postal mail, by telephone, and by electronic mail (see affidavit of Markus Schmutz, ¶¶9-11, 15-17). Thus, it can be concluded with reasonable certainty that the inventors cannot be found.

With regard to item (4) above, the declaration filed with the renewed petition cannot be accepted at the present time because the surname of the second inventor does not match that shown in the international application.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

The petition states that the inventor has agreed in writing to assign the invention to Swiss Reinsurance Company ("SRC"). The petition includes copies of employment agreements signed by the inventors which state that the inventors agree to assign inventions made during the term of employment with SRC and using SRC resources. Furthermore, the petition is accompanied by a statement that the present invention being made during the term of employment with SRC and using SRC resources (see Schmutz affidavit, ¶¶7, 13). Thus, it can be concluded with reasonable certainty that SRC has sufficient proprietary interest in the application.

With regard to item (6) above, an adequate statement regarding preservation of the rights of the parties and/or prevention of irreparable damage has been provided.

### CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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1940 DUKE STREET  
ALEXANDRIA, VA 22314

**MAILED**

**DEC 22 2011**

PCT LEGAL ADMINISTRATION

In re Application of KATSUYAMA et al :  
U.S. Application No.: 12/676,608 :  
PCT Application No.: PCT/CH2007/000440 :  
Int. Filing Date: 05 September 2007 :  
Priority Date Claimed: none :  
Attorney Docket No.: 355461US28PCT :  
For: COMPUTER SYSTEM AND COMPUTER- :  
IMPLEMENTED METHOD FOR :  
MANAGING A FINANCIAL PRODUCT :

DECISION

This is in response to applicant's renewed petition under 37 CFR 1.47(b) filed on 21 November 2011.

**BACKGROUND**

On 05 September 2007, applicant filed international application PCT/CH2007/000440. A copy of the international application was communicated to the USPTO from the International Bureau on 12 March 2009. The thirty-month period for paying the basic national fee in the United States expired on 05 March 2010.

On 05 March 2010, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 01 June 2010, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 01 November 2010, applicant filed a petition under 37 CFR 1.47(b).

On 02 December 2010, this Office mailed a decision dismissing the 01 November 2010 petition.

On 02 March 2011, applicant filed a renewed petition under 37 CFR 1.47(b).

On 19 September 2011, this Office mailed a decision dismissing the 02 March 2011 petition.

On 21 November 2011, applicant filed the instant renewed petition under 37 CFR 1.47(b).

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Petitioner previously satisfied items (1), (2), (3), (5), and (6) above.

With regard to item (4) above, a proper declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors has been provided.

### CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.47(b) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 05 September 2007, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 21 November 2011.

As set forth in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the nonsigning inventors at the last known addresses of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

*Bryan Lin*

Bryan Lin  
PCT Legal Examiner  
PCT Legal Office

Telephone: 571-272-3303  
Facsimile: 571-273-0459



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Masaaki Katsuyama  
5-2-3-1101  
Higashi-Shinkoiwa  
124-0023 Katsushika-ku, Tokyo  
JAPAN

**MAILED**

**DEC 22 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of KATSUYAMA et al  
U.S. Application No.: 12/676,608  
PCT Application No.: PCT/CH2007/000440  
Int. Filing Date: 05 September 2007  
Priority Date Claimed: none  
For: COMPUTER SYSTEM AND COMPUTER-  
IMPLEMENTED METHOD FOR  
MANAGING A FINANCIAL PRODUCT

Dear Masaaki Katsuyama:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 118. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost set forth in 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you choose to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

*Bryan Lin*

Bryan Lin  
PCT Legal Examiner  
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
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ALEXANDRIA, VA 22314  
Attorney Docket No.: 355461US28PCT



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Albert Otto Selius  
14 York Road  
1538 Larchmont, NY 10538

**MAILED**

**DEC 22 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of KATSUYAMA et al  
U.S. Application No.: 12/676,608  
PCT Application No.: PCT/CH2007/000440  
Int. Filing Date: 05 September 2007  
Priority Date Claimed: none  
For: COMPUTER SYSTEM AND COMPUTER-  
IMPLEMENTED METHOD FOR  
MANAGING A FINANCIAL PRODUCT

Dear Albert Otto Selius:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 118. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost set forth in 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you choose to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

*Bryan Lin*

Bryan Lin  
PCT Legal Examiner  
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Facsimile: 571-273-0459

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
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ALEXANDRIA, VA 22314  
Attorney Docket No.: 355461US28PCT



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ARLINGTON, VA 22201

**MAILED**

**FEB 03 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of KURODA et al :  
U.S. Application No.: 12/676,638 :  
PCT Application No.: PCT/JP2008/065943 :  
Int. Filing Date: 04 September 2008 : **DECISION**  
Priority Date Claimed: 07 September 2007 :  
Attorney Docket No.: HAYAK-0034 :  
For: THERAPEUTIC AND PROPHYLACTIC :  
AGENTS FOR ARTHRITIS :

This is in response to applicant's correspondence filed 29 November 2010, which is being treated as a request for status under 37 CFR 1.42.

**BACKGROUND**

On 04 September 2008, applicant filed international application PCT/JP2008/065943, which claimed priority of an earlier Japan application filed 07 September 2007. A copy of the international application was communicated to the USPTO from the International Bureau on 12 March 2009. The thirty-month period for paying the basic national fee in the United States expired on 08 March 2010.

On 05 March 2010, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 28 May 2010, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 30 August 2010, applicant filed an executed declaration.

On 13 October 2010, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which identified a discrepancy with respect the name of one of the inventors.

On 29 November 2010, applicant filed the present request for status under 37 CFR 1.42 including a newly executed declaration.

### DISCUSSION

The request states that joint inventor Hiroyuki Shirono is deceased.

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

The declarations filed 30 August 2010 and 29 November 2010 fail to list the name and citizenship of inventor Hiroyuki Shirono as required by 37 CFR 1.497(a)(3). With further regard to citizenship, applicant is advised that a singular indication of citizenship in a signature block cannot be used for both a deceased inventor and his/her legal representative. The declarations are further defective because they fail to state that Chitose Shirono is the legal representative of the deceased inventor. Applicant is advised that any foreign language text contained in a declaration must be in compliance with 37 CFR 1.69.

### CONCLUSION

For the reasons above, the request for status under 37 CFR 1.42 is DISMISSED without prejudice.

If reconsideration on the merits of the request is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Request for Status under 37 CFR 1.42".

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT

Application Number: 12/676,638

-3-

Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

*Bryan Lin*

Bryan Lin  
PCT Legal Examiner  
PCT Legal Office

Telephone: 571-272-3303  
Facsimile: 571-273-0459



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
2200 CLARENDON BLVD.  
SUITE 1400  
ARLINGTON, VA 22201

**MAILED**

**JUL 13 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of KURODA et al :  
U.S. Application No.: 12/676,638 :  
PCT Application No.: PCT/JP2008/065943 :  
Int. Filing Date: 04 September 2008 :  
Priority Date Claimed: 07 September 2007 :  
Attorney Docket No.: HAYAK-0034 :  
For: THERAPEUTIC AND PROPHYLACTIC :  
AGENTS FOR ARTHRITIS :

**DECISION**

This is in response to applicant's renewed request for status under 37 CFR 1.42 filed 13 May 2011.

**BACKGROUND**

On 04 September 2008, applicant filed international application PCT/JP2008/065943, which claimed priority of an earlier Japan application filed 07 September 2007. A copy of the international application was communicated to the USPTO from the International Bureau on 12 March 2009. The thirty-month period for paying the basic national fee in the United States expired on 08 March 2010.

On 05 March 2010, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 28 May 2010, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 30 August 2010, applicant filed an executed declaration.

On 13 October 2010, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which identified a discrepancy with respect the name of one of the inventors.

On 29 November 2010, applicant filed a request for status under 37 CFR 1.42 including a newly executed declaration.

On 03 February 2011, this Office mailed a decision dismissing the 29 November 2010 request for status.

On 13 May 2011, applicant filed the instant renewed request for status under 37 CFR 1.42.

### DISCUSSION

The request states that joint inventor Hiroyuki Shirono is deceased.

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

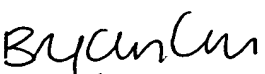
The declarations filed 13 May 2011 are in compliance with 37 CFR 1.42 and 1.497(d).

### CONCLUSION

For the reasons above, the renewed request for status under 37 CFR 1.42 is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 04 September 2008, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 13 May 2011.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

  
Bryan Lin  
PCT Legal Examiner  
PCT Legal Office

Telephone: 571-272-3303  
Facsimile: 571-273-0459

**REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY – PATENT  
PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN  
THE EUROPEAN PATENT OFFICE (EPO) AND THE USPTO**

Application No.:	12/676,650	First Named Inventor:	Graf
Filing Date:	03/05/2010	Attorney Docket No.:	3023-122
Title of the Invention:	METHOD OF ASSAYING SEPSIS IN HUMANS		

THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBS/DFS\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html).

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PILOT PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PILOT PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

The corresponding PCT application number(s) is/are: PCT/EP2008/007158

The international filing date of the corresponding PCT application(s) is/are: 09/02/2008

**I. List of Required Documents:**

- a. **A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**
  - ☒ is attached.
  - ☐ is not attached because the document is already in the U.S. application.
- b. **A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s)**
  - ☒ is attached.
  - ☐ is not attached because the document is already in the U.S. application.
- c. **English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**
- d. **(1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.**
  - ☐ is attached.
  - ☒ has already been filed in the above-identified U.S. application on 03/05/2010
- (2) Copies of all documents (except for U.S. patents or U.S. patent application publications)**
  - ☐ are attached.
  - ☒ have already been filed in the above-identified U.S. application on 03/05/2010

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

(continued)

Application No.:	12/676,650	First Named Inventor:	Graf
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## II. Claims Correspondence Table:

[illegible]

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature <b>/Joyce v. Natzmer/</b>	Date <b>03/01/2012</b>
Name (Print/Typed) <b>Joyce von Natzmer</b>	Registration Number <b>48120</b>

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
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P.O. Box 1450  
Alexandria, VA 22313-1450  
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**MAILED**

DEC 29 2010

PCT LEGAL ADMINISTRATION

FROMMER LAWRENCE & HAUG LLP  
745 FIFTH AVENUE  
NEW YORK, NY 10451

In re Application of  
TOKUMITSU et al.  
Application No.: 12/676,673  
PCT No.: PCT/JP08/66505  
Int. Filing Date: 08 September 2008  
Priority Date: 07 September 2007  
Attorney Docket No.: 1345405-2008  
For: SOLVENT-DISPERSIBLE PARTICLE

:  
:  
: DECISION  
:  
: ON PETITION UNDER  
:  
: 37 CFR 1.182  
:

This is a decision on applicant's PETITION UNDER 37 CFR 1.182 to change the name of inventor filed in the United States Patent and Trademark Office (USPTO) on 07 October 2010. Applicants request that the application reflect joint inventor's name change to Yuki HIRAJIMA. Attorney for applicant indicates that the inventor's name changed due to her marriage.

To change the inventor's name to Yuki HIRAJIMA, a petition under 37 CFR 1.182 is required. The petition must include an appropriate petition fee and a statement signed by the inventor setting forth both names and the procedure whereby the change of name was effected, or a copy of the court order. See MPEP §605.04(c). The \$400 petition fee has been paid. The fee paid with the instant petition will be refunded to applicant's deposit account. Applicant now submits a statement signed by the inventor setting forth both names and the procedure whereby the change of name was effected to support the change in the inventor's name from Yuki MAEDA to Yuki HIRAJIMA due to her marriage. The petition under 37 CFR 1.182 to change the inventor's name is **GRANTED**.

The declaration submitted on 05 March 2010 is in the Japanese/English language. As set forth in 37 CFR 1.69(b), unless the text of any oath or declaration in a language other than English is in the form provided by the Patent and Trademark Office..., it must be accompanied by an English translation together with a statement that the translation is accurate. See also MPEP 602.06. Applicant has not provided a statement regarding the accuracy of the English translation of the Japanese/English language declaration. The declaration is unacceptable at this time and not in compliance with 37 CFR 1.497(a) and (b).

The petition under 37 CFR 1.182 to change the inventor's name is **GRANTED**. The application will be forwarded to the United States Designated/Elected Office for further processing, including issuance of a Notification of Missing Requirements in accord with this decision.

/Cynthia M. Kratz/  
Cynthia M. Kratz  
Attorney Advisor  
PCT Legal Office  
Office of PCT Legal Administration  
Telephone: (571) 272-3286



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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WOLF GREENFIELD & SACKS, P.C.  
600 ATLANTIC AVENUE  
BOSTON, MA 02210-2206

**MAILED**  
**NOV 09 2011**  
**OFFICE OF PETITIONS**

APPLICANT(S): DOLK, et al.  
Appl. No.: 12/676,705  
International Filing Date: December 17, 2007  
Title: BINDING MOLECULES WITH MULTIPLE BINDING SITES, COMPOSITIONS  
COMPRISING THE SAME AND USES THEREOF  
Attorney Docket No.: A0848.70125US00  
Pub. No.: US 2011/0129458 A1  
Pub. Date: June 2, 2011

This is a decision on the request for correction of patent application publication under  
37 CFR 1.221(b), received on July 28, 2011, for the above-identified application.

The request is granted

The corrected patent application publication will be published in due course, unless the patent  
issues before the application is republished.

Inquiries relating to this matter may be directed to Sherry D. Brinkley at (571) 272-3204.

/Christopher Bottorff/

Christopher Bottorff  
Petitions Examiner  
Office of Petitions



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/676,807		John B. Elder	SHAP.13159	5296
23123 7590 08/25/2010 SCHMEISER OLSEN & WATTS 18 E UNIVERSITY DRIVE SUITE # 101 MESA, AZ 85201			EXAMINER	
			ART UNIT	PAPER NUMBER
			3745	
			MAIL DATE	DELIVERY MODE
			08/25/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

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SCHMEISER OLSEN & WATTS  
18 E UNIVERSITY DRIVE  
SUITE # 101  
MESA AZ 85201

In re Application of:  
ELDER, JOHN B. et al  
Serial No. 12/676,807  
Filed: March 5, 2010  
Docket: SHAP.13159

Title: BOOM SLEWING ACTUATOR  
SYSTEM

:  
:  
: DECISION ON REQUEST TO  
:  
: PARTICIPATE IN PATENT  
:  
: PROSECUTION HIGHWAY  
:  
: PILOT PROGRAM AND  
:  
: PETITION TO MAKE  
: SPECIAL UNDER 37 CFR  
1.102(d)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) pilot program and the petition under 37 CFR 1.102(d), filed July 1, 2010 to make the above-identified application special. The required petition fee under 37 CFR 1.17(h) was charged to the deposit account as authorized.

The request and petition are granted.

A grantable request to participate in the PPH pilot program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the CIPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the CIPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the CIPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions from each of the CIPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the CIPO examiner in the CIPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen, at 571-272-4856.

All other inquiries concerning the examination or status of the application should be directed to Edward Look, SPE of Art Unit 3745, 571-272-4820.

The application is currently undergoing pre-examination processing. When completed, the application will be forwarded to the examiner for action on the merits commensurate with this decision.

/Henry C. Yuen/

---

Henry C. Yuen, Special Programs Examiner  
Technology Center 3700 – Mechanical Engineering,  
Manufacturing and Products  
571-272-4856



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MAILED

DEC 20 2010

FOLEY & LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON DC 20007

PCT LEGAL ADMINISTRATION

In re Application of	:	
LYNCH et al.	:	
Application No.: 12/676,819	:	DECISION
PCT No.: PCT/US2008/083940	:	
Int. Filing Date: 18 November 2008	:	
Priority Date: 19 November 2007	:	
Attorney Docket No.: 090589-0104	:	
For: PROLONGED RELEASE OF LOCAL	:	
ANESTHETICS USING MICROPARTICLES	:	
AND SURGERY APPLICATIONS	:	

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 22 November 2010 in the United States Patent and Trademark Office (USPTO). The petition is **GRANTED**.

**BACKGROUND**

On 18 November 2008, applicants filed international application PCT/US2008/083940, which designated the United States and claimed a priority date of 19 November 2007. A copy of the international application was communicated from the International Bureau to the USPTO on 28 May 2009. The thirty-month period for paying the basic national fee in the United States expired at midnight on 19 May 2010.

On 05 March 2010, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 21 June 2010, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a two-month extendable period for response.

On 03 May 2010, applicants filed the instant petition under 37 CFR 1.47(a) which was

accompanied by, *inter alia*, a petition/fee for a three-month extension of time, a declaration of inventors, and a statement of facts by Steven J. Rutt with documentation in support thereof.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1), (3), and (4) have been satisfied.

Item (2) has been satisfied as well. It has been established that non-signing inventor Lwandiko E. MASINDE has been presented with a copy of the application papers. Mr. MASINDE's conduct constitutes a refusal to sign.

### **CONCLUSION**

For the reasons set forth above, applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to each of the non-signing inventors at their respective last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of **22 November 2010**.

/Daniel Stemmer/  
Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301



UNITED STATES PATENT AND TRADEMARK OFFICE

**MAILED**

**DEC 20 2010**

**PCT LEGAL ADMINISTRATION**

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Mr. Lwandiko Masinde  
5 Miles Cary Mews  
Hampton, VA 23669

In re Application of  
LYNCH et al.

Application No.: 12/676,819

PCT No.: PCT/US2008/083940

Int. Filing Date: 18 November 2008

Priority Date: 19 November 2007

Attorney Docket No.: 090589-0104

For: PROLONGED RELEASE OF LOCAL ANESTHETICS USING MICROPARTICLES  
AND SURGERY APPLICATIONS

Dear Mr. Masinde:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/Daniel Stemmer/  
Daniel Stemmer  
PCT Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301

FOLEY & LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON DC 20007



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Alexandria, VA 22313-1450  
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**MAILED**

MAR 03 2011

MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS MN 55402-0903

PCT LEGAL ADMINISTRATION

In re Application of:	:	
FANSELOW, Markus, et al.	:	
U.S. Application No.: 12/676,824	:	DECISION
PCT No.: PCT/GB2008/050779	:	(37 CFR 1.47(a))
International Filing Date: 03 September 2008	:	
Priority Date: 06 September 2007	:	
Attorney's Docket No.: 16206.0003FPWO	:	
For: CONVERSION METHOD	:	

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a)" filed 09 November 2010, treated herein under 37 CFR 1.47(a). Applicants have paid the required petition fee.

**BACKGROUND**

On 03 September 2008, applicants filed international application PCT/GB2008/050779. The international application claimed a priority date of 06 September 2007, and it designated the United States. On 12 March 2009, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 06 March 2010.

On 05 March 2010, applicants' filed materials to initiate the present national stage application including, among other materials, payment of the basic national fee.

On 07 July 2010, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date.

On 07 January 2011, applicants filed a response to the Notification Of Missing Requirements (with required four-month extension fee). The response included payment of the required surcharge, a partially executed declaration, and the "Petition Under 37 CFR 1.47(a)" considered herein. The petition requests acceptance of the declaration without the signature of co-inventor Anna ZHENG, whom applicants assert cannot be located.

### **DISCUSSION**

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have provided the required petition fee. Item (1) is therefore satisfied.

Regarding item (2), the petition contains an express statement of the last known address of the non-signing inventor. Item (2) is therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed declarations executed by four of the five inventors of record, and the declarations contain an unsigned signature block for the non-signing inventor Anna ZHENG. These declarations may be accepted as having been executed by the co-operating inventors on their own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) sets forth the requirements for a showing that a non-signing inventor cannot be located after diligent effort:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. [...]

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

The present petition sets forth the efforts made to contact the non-signing inventor, including correspondence forwarded to the inventor's last known addresses by Dr. Sarah Thompson and additional records review by Ray McEvoy. However, the petition does not include firsthand statements of facts from the persons who made these efforts, as required to confirm such actions (the petition is accompanied by a statement of Dr. Sarah Thompson; however, the statement has not been signed). Moreover, the petition does not indicate that an

internet search has been conducted to identify current contact information for the non-signing inventor and contact her at any address identified by such a search.

In view of the above, the present record does not provide an acceptable showing that a diligent effort has been made to locate the non-signing inventor. Acceptable firsthand statement(s) confirming the efforts made to locate and contact the nonsigning inventor, with supporting documents, must be provided. In addition to the efforts described in the present petition, any supplemental materials filed herein should include confirmation that an internet search was conducted (with the results of such internet search being made of record). Until such additional materials are provided, item (4) of a grantable petition under 37 CFR 1.47(a) is not considered satisfied.

### **CONCLUSION**

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should be entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy item (4) of a grantable petition, as discussed above and in the MPEP. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application.  
Extensions of time are available under 37 CFR 1.136(a)

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296



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MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS MN 55402-0903

**MAILED**

SEP 07 2011

PCT LEGAL ADMINISTRATION

In re Application of:	:	
FANSELOW, Markus, et al.	:	
U.S. Application No.: 12/676,824	:	DECISION ON RENEWED
PCT No.: PCT/GB2008/050779	:	PETITION UNDER
International Filing Date: 03 September 2008	:	37 CFR 1.47(a)
Priority Date: 06 September 2007	:	
Attorney's Docket No.: 16206.0003FPWO	:	
For: CONVERSION METHOD	:	

This decision is issued in response to applicants' "Renewed Petition 37 CFR 1.47(a)" filed on 08 August 2011. No additional petition fee is required.

**BACKGROUND**

The procedural background for the present application was set forth in the decision issued on 08 March 2011. The decision dismissed without prejudice applicants' petition under 37 CFR 1.47(a), finding that applicants had not satisfied all the requirements of a grantable petition. Specifically, the decision indicated that applicants had not provided an acceptable showing that the non-signing inventor cannot be located after diligent effort.

On 08 August 2011, applicants filed the renewed petition under 37 CFR 1.47(a) considered herein (with required extension fee).

**DISCUSSION**

The renewed petition is accompanied by supplemental materials, including an executed firsthand statement from Dr. Sarah Thompson, with supporting documents, setting forth the efforts made to locate and contact the non-signing inventor. These materials include, among other materials, the results of unsuccessful internet searches for the inventor. These materials, in combination with those previously submitted, provide an acceptable showing that the non-signing inventor cannot be located after diligent effort.

Based on the above, applicants have now satisfied the final outstanding elements of a grantable petition under 37 CFR 1.47(a). The petition is therefore appropriately granted.

**CONCLUSION**

Applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

The application is accepted without the signature of non-signing co-inventor Anna ZHENG.

A notice of the acceptance of the application will be published in the Official Gazette, and a letter informing the non-signing inventor of the application will be forwarded to the address of the non-signing inventor, as set forth in the petition.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 07 January 2011.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296



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**SEP 07 2011**

**PCT LEGAL ADMINISTRATION**

Ms. Anna ZHENG  
21 Mount Prospect Park  
Belfast CBT9 7BG  
UNITED KINGDOM

In re Application of: FANSELOW, Markus, et al.  
U.S. Application No.: 12/676,824  
PCT No.: PCT/GB2008/050779  
International Filing Date: 03 September 2008  
Priority Date: 06 September 2007  
Attorney's Docket No.: 16206.0003FPWO  
For: CONVERSION METHOD

Dear Ms. ZHENG:

You are identified as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296

Counsel Of Record:

Eric E. DeMaster  
MERCHANT & GOULD PC  
P.O. BOX 2903  
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MINNEAPOLIS MN 55402-0903

**MAILED**

**MAR 22 2011**

In re Application of  
HOLBREY et al  
Application No.: 12/676,831  
PCT No.: PCT/GB2008/050780  
Int. Filing Date: 3 September 2008  
Priority Date: 6 September 2007  
Attorney's Docket No.: 16206.0004FPWO  
For: CONVERSION METHOD

: DECISION ON PCT LEGAL ADMINISTRATION  
:  
:  
: PETITION UNDER  
:  
:  
: 37 CFR 1.47(a)  
:

This decision is in response to applicants' "PETITION UNDER 37 CFR 1.47(a)" submitted on 20 January 2011 that seeks the acceptance of the application without the signature of the joint inventor Ms. Anna Xi ZHENG. Petitioner has provided the petition fee of \$200.00.

**BACKGROUND**

On 05 March 2010, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration or oath was submitted at such time.

On 23 August 2010, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating, *inter alia*, that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date." The notification set two (2) months from the date of this notice or 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicants, *inter alia*, filed on 20 January 2011, a petition under 37 CFR 1.47(a), and an executed declaration without the signature of joint inventor Anna Xi ZHENG.

**DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

**INVENTOR CANNOT BE REACHED:**

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under **37 CFR 1.47**, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under **37 CFR 1.47**.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under **37 CFR 1.47**. **37 CFR 1.43** may be available under these circumstances. See **MPEP § 409.02**. Such a petition under **37 CFR 1.47** will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioner has satisfied requirements (1), and (3) – (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

Regarding requirement (1), petitioner has provided the petition fee of \$200.00 under 37 CFR 1.17(g).

Regarding requirement (2), the averments of Mr. DeMaster are insufficient to support a finding that the nonsigning joint inventor, Ms. Zheng could not be found after diligent effort. The petition enumerates steps taken to reach Ms. Zheng such as the email from the building administrator, the University indication that she did not complete an exit questionnaire and that the Chemical Society did not have a forwarding address as her membership expired. This list is insufficient by themselves because the list fails to show diligent effort to locate joint inventor Ms. Zheng because petitioner has not shown that a search for the above non-signing inventor's new address was done using a broad search in the internet (google, facebook and internet white pages ) or by using a phone directory to try to locate Ms. Zheng's new address.

In addition, the statements are from DeMaster and not from Dr. Sarah Thompson, who appears to have performed the actions listed in that section of the petition to try to reach Ms. Zheng, and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Dr. Sarah Thompson or DeMaster was not the person who performed the actions listed to try to reach Ms. Zheng, petitioner will need to submit statements, with specific facts on the actions referred in the petition by the person(s) who have first-hand knowledge of such facts.

Accordingly, at this time it can not be concluded that the nonsigning Ms. Zheng could not be reached after diligent effort as stipulated under 37 CFR 1.47(a).

Regarding requirement (3), petitioner has provided a statement of the last known address of the missing inventor.

Ms. Anna Zheng  
21 Mount Prospect Park  
Belfast CBT9 7BG  
United Kingdom

Ms. Anna Zheng  
C10/Room 01  
Firhill Court  
80 Firhill Road  
Glasgow G20 7BA  
Scotland, UK

Regarding requirement (4), the petitioner has provided a properly executed declaration without the signature of joint inventor Ms. Zheng.

Consequently, the petition does not satisfy all the requirements under 37 CFR 1.47(a).

### **CONCLUSION**

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Tel: (571) 272-3276  
Fax: (571) 273-0459



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**MAILED**  
OCT 13 2011

PCT LEGAL ADMINISTRATION

In re Application of	:	DECISION ON
HOLBREY et al	:	
Application No.: 12/676,831	:	
PCT No.: PCT/GB2008/050780	:	PETITION UNDER
Int. Filing Date: 3 September 2008	:	
Priority Date: 6 September 2007	:	
Attorney's Docket No.: 16206.0004FPWO	:	37 CFR 1.47(a)
For: CONVERSION METHOD	:	

This is in response to the "SECOND RENEWED PETITION UNDER 37 CFR 1.47(a)" filed on 15 August 2011 that seeks the acceptance of the application without the signature of the inventor Ms. Anna Xi ZHENG.

### **BACKGROUND**

In a decision from this Office on 22 March 2011, the petition filed on 20 January 2011 was dismissed. The decision stated that item (2) of 37 CFR 1.47 was not met.

On 15 August 2011, petitioner filed the present renewed petition accompanied with a statement from Dr. Sarah Thompson.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

The renewed petition of 11 August 2011 has satisfied the items under 37 CFR 1.47(a).

Item (2) has been satisfied. The renewed petition is accompanied by a statement by Dr. Sarah Thompson, who contacted Mr. Raymond McEvoy of The Queen's University of Belfast Personnel Department and confirmed that Ms. Zheng did not provide a forwarding address. She then states that she did a search for her through LinkedIn, which listed 73 hits but none matched the characteristics of co-inventor Anna Xi ZHENG and Google listed over 3,000 hits.

Accordingly, the steps enumerated by Dr. Thompson are sufficient to establish that Ms. Thompson could not be found or reached after diligent effort

Petitioner has now satisfied items (1), (2), (3), and (4) under 37 CFR 1.47(a), thus completing the requirements under 37 CFR 1.47(a).

**CONCLUSION**

The petition under 37 CFR 1.47(a) is **GRANTED**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.



Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Telephone: (571) 272-3276  
Facsimile: (571) 273-0459



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Ms. Anna Zheng  
21 Mount Prospect Park  
Belfast CB7 7BG  
United Kingdom

**MAILED**

OCT 13 2011


PCT LEGAL ADMINISTRATION

In re Application of  
HOLBREY et al  
Application No.: 12/676,831  
PCT No.: PCT/GB2008/050780  
Int. Filing Date: 3 September 2008  
Priority Date: 6 September 2007  
Attorney's Docket No.: 16206.0004FPWO  
For: CONVERSION METHOD

Dear Ms. ZHENG:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/676,850	09/21/2010	Bum Chul Cho	3449-1362PUSI	5613
2292	7590	11/09/2011	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			BREWSTER, WILLIAM M	
PO BOX 747			ART UNIT	
FALLS CHURCH, VA 22040-0747			PAPER NUMBER	
			2823	
			NOTIFICATION DATE	
			DELIVERY MODE	
			11/09/2011	
			ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com



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**BIRCH STEWART KOLASCH &  
BIRCH  
PO BOX 747  
FALLS CHURCH VA 22040-0747**

**In re Application of  
CHO et al.**

**Application No.: 12/676850**

**Filed: 21 September 2010**

**Attorney Docket No.: 3449-1362PUS1**

**For: LIGHTING EMITTING DEVICE**

**PACKAGE AND METHOD OF**

**FABRICATING THE SAME**

**: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)**

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed 15 July 2010, to make the above-identified application special.

The request and petition are **DISMISSED** as moot as the application has been allowed.

Telephone inquiries concerning this decision should be directed to Colleen Dunn at 571-272-1170.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Colleen Dunn/

Colleen Dunn  
Quality Assurance Specialist  
Technology Center 2800



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JEROME D. JACKSON (JACKSON PATENT LAW OFFICE)  
211 N. UNION STREET, SUITE 100  
ALEXANDRIA, VA 22314

**MAILED**

**OCT 19 2010**

**OFFICE OF PETITIONS**

In re Application of

Dino Andreini

Application No. 12/676,893

Filed: March 6, 2010

Attorney Docket No. 242.002

DECISION ON PETITION  
TO MAKE SPECIAL UNDER  
37 CFR 1.102(c)(1)

This is a decision on the petition under 37 CFR 1.102(c)(1), filed September 10, 2010, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section IV: Applicant's Age must be accompanied by evidence showing that at least one of the applicants is 65 years of age, or more, such as a birth certificate or a statement by applicant. No fee is required

The instant petition includes a statement from applicant's representative that he is in possession of proof of applicant's age. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to undersigned at 571-272-1642.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

The application is being forwarded to the Technology Center Art Unit 3748 for action on the merits commensurate with this decision.

/AMW/

April M. Wise

Petitions Examiner

Office of Petitions



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/676,958	03/08/2010	Hitoshi Matsushima	03284.0111-00000	6507
22852 7590 10/11/2011 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER ROCCA, JOSEPH M	
			ART UNIT 3616	PAPER NUMBER
			MAIL DATE 10/11/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON DC 20001-4413

In re application of  
Matsushima et al  
Application No. 12/676,958  
Filed: March 08, 2010  
For: KNEE AIRBAG DEVICE  
FOR A VEHICLE

: **DECISION ON REQUEST TO**  
: **PARTICIPATE IN PATENT**  
: **PROSECUTION HIGHWAY**  
: **PROGRAM AND PETITION**  
: **TO MAKE SPECIAL UNDER**  
: **37 CFR 1.102(a)**

This is a decision on the renewed request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed August 04, 2011 to make the above-identified application special.

The request and petition are **DISMISSED as MOOT**.

A grantable request to participate in the PPH pilot program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO, application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of the latest Office action from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO Office action along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH pilot is not grantable as per item (4) above in that Examination of the U.S. application has already begun. A Non Final Office action was mailed on September 02, 2011.

No time period for reply to this decision is available since an Office action on the merits has already been mailed.

Any inquiry regarding this decision should be directed to Mikado Buiz, Quality Assurance Specialist, at (571) 272-6578.

/ Mikado Buiz /

Mikado Buiz,  
Quality Assurance Specialist  
Technology Center 3600

MB/MB: 10/06/11



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WARNER NORCROSS & JUDD LLP  
INTELLECTUAL PROPERTY GROUP  
900 FIFTH THIRD CENTER  
111 LYON STREET, N.W.  
GRAND RAPIDS MI 49503-2487

**MAILED**

**JAN 07 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of	:	DECISION ON
Weiwen et al	:	
Int. Application: PCT/US2009/048754	:	
Application No.: 12/677,001	:	REQUEST UNDER
Int. Filing Date: 26 June 2009	:	
Priority Date: 26 June 2008	:	
Attorney's Docket No.: 061379.123552-0005	:	
For: METHOD FOR ... MODIFIED MESENC	:	37 CFR 1.497(d)

This is a decision on petitioner's "REQUEST TO CORRECT INVENTORSHIP UNDER 37 CFR 1.48(a)" filed on 23 August 2010, which is being treated as a request under 37 CFR 1.497(d) to add joint inventor Anthony J. Senagore in the executed declaration. The petition fee of \$130.00 has been provided by petitioner via electronic transfer.

**BACKGROUND**

On 26 June 2009, applicants filed international application No. PCT/US2009/048754 and claiming a priority date of 26 June 2008.

On 08 March 2010, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee, but no executed declaration was submitted at such time.

On 23 August 2010, applicants filed, inter alia, an executed declaration and a request under 37 CFR 1.497(d) to add co-inventor Anthony J. Senagore in the executed declaration..

**DISCUSSION**

A submission under 37 CFR 1.497(d) must include:

- (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) the fee set forth in § 1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied item (2) under 37 CFR 1.497(d), but not items (1) and (3).

With respect to item (1), the statement submitted on 23 August 2010 by Anthony J. SENAGORE is sufficient because the statement states that the error in inventorship occurred without a deceptive intent in the U.S. patent application. However, the executed declaration filed is defective and, for the reason below, the application may not enter into national stage processing at this time. It does not comply with 37 CFR 1.497(a)(3). A Declaration, under 37 CFR 1.497(a)(3), must identify each inventor. See MPEP § 602. In this instance, applicants submitted a composite declaration comprising of two sets of declarations, which one is incomplete because each set must be complete by having the correct number of pages and listing all the inventors. In this case only, one set is complete because it comprises of the two (2) sheets of the declaration. The other set is incomplete because it only contains page 1 (one sheet) and it does not have other sheet of the Declaration to make it complete. Therefore the sets of Declarations are incomplete.

Copies of the same page is not part of a proper declaration since it is considered a set of declarations and each must be a complete declaration with the proper statement and the names of each inventor even though each set of declarations may not have all the signatures of the inventors. Therefore, a proper declaration must consist of individual complete sets of declaration that taken as a whole would have all the required signatures as required under 37 CFR 1.497(a)(3).

With respect to item (2), the processing fee of \$130.00 has been provided.

With respect to item (3), Spectrum Health Hospitals, the assignee, has not consented to the correction of inventorship to the above application. Also, to establish the right of the Assignee to take action, applicant must submit a copy of the executed assignment or specify the reel and frame number. Note MPEP 324 and 37 CFR 3.73(b).

Accordingly, the request does not meet the requirements under 37 CFR 1.497(d).

### **CONCLUSION**

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Rafael Bacares  
PCT Legal Examiner  
PCT Legal Administrative Office  
Telephone: (571) 272-3276  
Facsimile: (571) 273-0459



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**MAILED**

**APR 20 2011**

**PCT LEGAL ADMINISTRATION**

WARNER NORCROSS & JUDD LLP  
INTELLECTUAL PROPERTY GROUP  
900 FIFTH THIRD CENTER  
111 LYON STREET, N.W.  
GRAND RAPIDS MI 49503-2487

In re Application of	:	DECISION ON RENEWED
Weiwen et al	:	
Int. Application: PCT/US2009/048754	:	
Application No.: 12/677,001	:	REQUEST UNDER
Int. Filing Date: 26 June 2009	:	
Priority Date: 26 June 2008	:	
Attorney's Docket No.: 061379.123552-0005	:	
For: METHOD FOR ... MODIFIED MESENC	:	37 CFR 1.497(d)

This is a decision on applicants' "RENEWED REQUEST UNDER 37 CFR 1.497(d)" filed on 18 February 2011.

**BACKGROUND**

In a decision from this Office mailed on 07 January 2011, the decision indicated that the request was dismissed because the request did not satisfy items (1) and (3) of 37 CFR 1.497(d).

On 18 February 2011, applicant filed the current renewed request, which included specifying the reel and frame number of the assignment, and a statement by Kristine K.S. White having authorization to act on behalf of assignee, and a proper executed set of declarations.

**DISCUSSION**

A review of the renewed request reveals that applicants have satisfied item (3) of 37 CFR 1.497(d) as Kristine K.S. White has authority to act on behalf of the assignee, and consents to the addition of co-inventor Anthony J. Senagore and the assignee has filed in the requisite papers establishing its right to take action under 37 CFR §3.73(b) as the executed assignment as been recorded at Reel No.024043/Frame No.0947.

In addition, applicants have provided a properly executed set of declarations.

Accordingly, applicant is deemed to satisfy requirements (1), (2), and (3) under 37 CFR 1.497(d).

Accordingly, applicants are deemed to satisfy items (1) - (3) under 37 CFR 1.497(d).

**CONCLUSION**

For the reasons above, the request under 37 CFR 1.497(d) is **GRANTED**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing consistent with this decision.

A handwritten signature in black ink, appearing to read 'R. Bacares', is written over the printed name.

Rafael Bacares

PCT Legal Examiner

PCT Legal Office

Telephone: (571) 272-3276

Facsimile: (571) 273-0459

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE KOREAN INTELLECTUAL PROPERTY OFFICE (KIPO) AND THE USPTO

Application No:	12/677021	Filing date:	02-SEP-2008
First Named Inventor:	Lamon, Alain		
Title of the Invention:	Flexible Epoxy-Based Compositions		
THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT <a href="http://www.uspto.gov/ebs/efs_help.html">HTTP://WWW.USPTO.GOV/EBS/EFBS_HELP.HTML</a>			

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/US2008/075028

**The international date of the corresponding PCT application(s) is/are:** 02-SEP-2008

## I. List of Required Documents:

- a. **A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**

☒

Is attached.

☐

Is not attached because the document is already in the U.S. application.

- b. **A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**

☒

Is attached.

☐

Is not attached because the document is already in the U.S. application.

- c. **English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM  
BETWEEN THE KIPO AND THE USPTO**

(continued)

Application No.: 12/677021

First Named Inventor: Lamon, Alain

- d. (1)
- An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.**

☐

Is attached

☒Has already been filed in the above-identified U.S. application on 7-27-2010

- (2)
- Copies of all documents (except) for U.S. patents or U.S. patent application publications)**

☒

Are attached.

Have already been filed in the above-identified U.S. application on 7-27-2010**II. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
21	1 and 2	Claims 1 and 2 combined, and expressed in the alternative
22	1	Corresponds to claim 1 of the PCT, amended to depend from new claim 1
23	2	Corresponds to claim 2 of the PCT, amended to depend from new claim 1
24	3	Corresponds in scope to claim 3 with amended antecedent basis
25	4	Corresponds in scope to claim 4, amended to delete redundant limitation
26	5	Corresponds in scope to claim 5 as it depended from claim 4
27	7	Corresponds in scope to claim 7 as it depended from claims 1 or 2
28	8-11	Combination of claims 8-11, expressed in the alternative
29	12	Corresponds in scope to claim 12 as it depended from claims 1 or 2
30	16	Corresponds in scope to claim 16 as it depended from claims 1 or 2
31	16	Corresponds in scope to claim 16 as it depended from claim 1
32	16	Corresponds in scope to claim 16 as it depended from claim 2
33	16	Corresponds in scope to claim 16 as it depended from claim 3
34	17	Corresponds in scope to claim 17 as it depended from claims 1 or 2
35	18	Corresponds in scope to claim 18 as it depended from claim 17
36	--	canceled
37	--	canceled

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature /Thomas M. Spielbauer/

Date August 13, 2010

Name (Print/Typed) Thomas M. Spielbauer

Registration Number 58,492



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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12/677,021

03/08/2010

Alain H. Lamon

63436US005

7034

32692

7590

11/16/2010

3M INNOVATIVE PROPERTIES COMPANY

PO BOX 33427

ST. PAUL, MN 55133-3427

EXAMINER

ART UNIT

PAPER NUMBER

1787

NOTIFICATION DATE

DELIVERY MODE

11/16/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com

LegalDocketing@mmm.com



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Commissioner for Patents  
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P.O. Box 1450  
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BC

November 15, 2010

In re application of	:	DECISION ON REQUEST TO
Alain H. Lamon	:	PARTICIPATE IN PATENT
Serial No. 12/677,021	:	PROSECUTION HIGHWAY
Filed: March 08, 2010	:	PROGRAM AND
For: FLEXIBLE EPOXY-BASED	:	PETITION TO MAKE SPECIAL
COMPOSITIONS	:	UNDER 37 CFR 1.102(a)

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed August 13, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, KIPO or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;
- (6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof if the latest international work

Application No. 12/677,021

product is not in the English language; and

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Blaine Copenheaver, Quality Assurance Specialist, at (571) 272-1156.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Blaine Copenheaver/

---

Blaine Copenheaver  
Quality Assurance Specialist  
Technology Center 1700



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/677,232	03/09/2010	Shingo Koumura	144683	8801
25944	7590	01/21/2011		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER BEAULIEU, YONEL	
			ART UNIT 3661	PAPER NUMBER
			NOTIFICATION DATE 01/21/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com  
jarmstrong@oliff.com



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JAN 20 2011

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OLIFF & BERRIDGE, PLC  
P.O. BOX 320850  
ALEXANDRIA VA 22320-4850

In re application of	:	<b>DECISION ON REQUEST TO</b>
Koumura et al.	:	<b>PARTICIPATE IN PATENT</b>
Application No. 12/677,232	:	<b>PROSECUTION HIGHWAY</b>
Filed: March 09, 2010	:	<b>PROGRAM AND PETITION</b>
For: BODY-ROLL RESTRAINING	:	<b>TO MAKE SPECIAL UNDER</b>
SYSTEM FOR VEHICLE	:	<b>37 CFR 1.102(a)</b>

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed December 02, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of the latest Office action from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO Office action along with copies of documents except U.S. patents or U.S. patent application publications.

In light of the preliminary amendment filed December 02, 2010. The request to participate in the PPH pilot program complies with the above requirements. Therefore, the above-identified application has been accorded "special" status.

All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Mikado Buiz, Quality Assurance Specialist, at (571) 272-6578.

/ Mikado Buiz /

Mikado Buiz,  
Quality Assurance Specialist  
Technology Center 3600

BM/BM: 01/19/11



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ORRICK, HERRINGTON & SUTCLIFFE, LLP  
IP PROSECUTION DEPARTMENT  
4 PARK PLAZA  
SUITE 1600  
IRVINE, CA 92614-2558

**MAILED**  
**MAY 17 2011**  
**OFFICE OF PETITIONS**

In re Application of  
Frank P. Becking, et al.  
Application No. 12/677,269  
Filed: January 20, 2011  
Attorney Docket No. 20004.4024

DECISION ON PETITION  
TO WITHDRAW  
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) filed March 16, 2011.

The request is **NOT APPROVED**.

The Office will no longer approve requests from practitioners to withdraw from application where the requesting practitioners is acting, or has acted, in a representative capacity pursuant to 37 CFR 1.34. In these situations, the practitioner is responsible for the correspondence the practitioner files in the application while acting in a representative capacity. As such, there is no need for the practitioner to obtain the Office's permission to withdraw from representation. However, practitioners acting in a representative capacity, like practitioners who have power of attorney in the application, remain responsible for noncompliance with 37 CFR 1.56, as well as 37 CFR 10.18, with respect to the documents they file.

A review of the file record indicates that Mark Stirrat does not have power of attorney in this patent application. See 37 C.F.R. § 10.40. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

All future communications from the Office will continue to be directed to the above-listed address until otherwise properly notified by the applicant.

There are no pending Office actions at the present time.

Telephone inquiries concerning this decision should be directed to undersigned at 571-272-1642.

All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

/AMW/  
April M. Wise  
Petitions Examiner  
Office of Petitions

cc: NFOCUS NEUROMEDICAL, INC.  
ATTN: FRANK P. BECKING  
2191 EAST BAYSHORE ROAD  
SUITE 100  
PALO ALTO, CA 94303



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MINCHEOL KIM  
KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

**MAILED**

**JAN 10 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of	:	
KWEON et al	:	
Application No.: 12/677,281	:	
PCT No.: PCT/KR2008/001400	:	
Int. Filing Date: 12 March 2008	:	PETITION
Priority Date: 12 March 2007	:	
For: POLYPHENOL COMPOUNDS WITH	:	UNDER 37 CFR 1.137(b)
MODULATING NEUROTRANSMITTER	:	
RELEASE	:	

This decision is in response to applicant's "PETITION FOR REVIVAL UNDER 37 C.F.R. 1.137(b) AND STATEMENT OF UNINTENTIONAL DELAY" filed in the United States Patent and Trademark Office (USPTO) on 09 March 2010.

**BACKGROUND**

On 12 March 2008, applicants filed international application No. PCT/KR2008/001400, which claimed a priority date of 12 March 2007, and which designated the United States. The deadline for entry and payment of the basic national fee was set to expire 30 months from the priority date, i.e. 14 September 2009.

On 09 March 2010, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the specification, claims and the basic national fee and the present petition under 37 CFR 1.137(b) to revive the application.

**DISCUSSION**

A petition under 37 CFR 1.137(b) requesting that the application be revived the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this

Application No.: 12/677,281

paragraph was unintentional” and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required).

Regarding item (1), applicants have provided the required reply.

Regarding item (2), the \$810 petition fee has been charged to the credit card.

Regarding item (3), the petition includes a statement that “the entire delay in filing the United States National Phase application from the due date for the required filing the United States National Phase application until the filing of a grantable petition under 37 C.F.R § 1.137(b) was unintentional” satisfies the requirement.

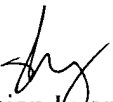
With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.


### **CONCLUSION**

For the reasons detailed above, applicants’ petition under 37 CFR 1.137(b) is **GRANTED**.

This application has an International Filing date under 35 U.S.C. 363 of 12 March 2008, and a date under 35 U.S.C. 371 (c)(1), (c)(2), and (c)(4) of 09 March 2010.

This application is being referred to the National Stage Processing (DO/EO/US) for further processing in accordance with this decision.

  
Shian Luong  
PCT Special Programs Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-4557  
Fax: (571) 273-0459

  
Bryan Lin  
PCT Legal Examiner  
Office of PCT Legal Administration



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10 SEP 2010

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Lerner Greenberg Sterner LLP  
P O Box 2480  
Hollywood, FL 33022-2480

In re Application of: RITT et al. :  
Application No.: 12/677,342 :  
PCT No.: PCT/EP2008/007155 : DECISION ON REQUEST  
Int. Filing Date: 02 September 2008 :  
Priority Date: 01 October 2007 :  
Attorney Docket No.: 2007P16616 :  
For: FAST READOUT METHOD AND :  
SWITCHED CAPACITOR ARRAY :  
CIRCUITRY FOR WAVEFORM :  
DIGITIZING :

This decision is issued in response to applicant's "Response" filed 20 July 2010. Applicant's request is being treated as a petition under 37 CFR 1.497(d), as explained below.

**BACKGROUND**

On 02 September 2008, applicant filed international application PCT/EP2008/007155 which claimed a priority date of 01 October 2007. The international application named Stefan RITT as the sole applicant/inventor. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 01 April 2010.

On 10 March 2010, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee; an application data sheet; a preliminary amendment, and a declaration executed by Stefan RITT and Roberto DINOPOLI.

On 20 April 2010, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the declaration filed 02 September 2008 was defective because the declaration sets forth an additional inventor (Roberto DINOPOLI) who had not been named in the international application. The notification set a two-month time limit in which to respond.

On 20 July 2010, applicant filed the present response to the Notification of Missing Requirements.

### DISCUSSION

The published international application identified one applicant/inventor (Stefan RITT) for the United States. The present submission seeks to correct the inventorship so as to add inventor Roberto DINOPOLI to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17; and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).
- (4) any new oath or declaration required by paragraph (f) of this subsection.

Applicant here has not submitted the required statements from the added inventor (Roberto DINOPOLI). Item (1) is therefore not satisfied.

The submission filed 20 July 2010 includes the authorization to charge Deposit Account No. 12-1099 for required fees. Based on this authorization, Deposit Account No. 12-1099 will be charged the required processing fee. Item (2) is satisfied.

Regarding item (3), applicant has not submitted the assent of the assignee to the change of inventorship. Item (3) is therefore not satisfied. It is noted that any such consent must be accompanied by a proper statement under 37 CFR 3.73(b) from the assignee.

Based on the above, the present record does not satisfy all the requirements of 37 CFR 1.497(d). The inventorship of record therefore remains that set forth in the international application. Because the inventors who executed the declaration filed 10 March 2010 are not the inventors of record herein, such declaration is defective under 37 CFR 1.497.

### CONCLUSION

For the reasons discussed above, applicant's request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3298



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United States Patent and Trademark Office  
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Alexandria, VA 22313-1450  
www.uspto.gov

Lerner Greenberg Stermer LLP  
P O Box 2480  
Hollywood, FL 33022-2480

**MAILED**

**NOV 15 2010**

**PCT LEGAL ADMINISTRATION**

In re Application of: RITT et al. :  
Application No.: 12/677,342 :  
PCT No.: PCT/EP2008/007155 : **DECISION ON REQUEST**  
Int. Filing Date: 02 September 2008 :  
Priority Date: 01 October 2007 :  
Attorney Docket No.: 2007P16616 :  
For: FAST READOUT METHOD AND :  
SWITCHED CAPACITOR ARRAY :  
CIRCUITRY FOR WAVEFORM :  
DIGITIZING :

This decision is issued in response to applicant's "Petition for Correction of Inventorship in Patent Application under 37 CFR 1.48(a)" filed 27 October 2010. Applicant's request is being treated as a petition under 37 CFR 1.497(d), as explained below.

**BACKGROUND**

On 02 September 2008, applicant filed international application PCT/EP2008/007155 which claimed a priority date of 01 October 2007. The international application named Stefan RITT as the sole applicant/inventor. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 01 April 2010.

On 10 March 2010, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee; an application data sheet; a preliminary amendment; and a declaration executed by Stefan RITT and Roberto DINOPOLI.

On 20 April 2010, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the declaration filed 02 September 2008 was defective because the declaration sets forth an additional inventor (Roberto DINOPOLI) who had not been named in the international application. The notification set a two-month time limit in which to respond.

On 20 July 2010, applicant filed a response to the Notification of Missing Requirements which was treated as a request under 37 CFR 1.497(d). In a decision dated 10 September 2010, applicant's request was dismissed without prejudice.

On 27 October 2010, applicant filed the present renewed request under 37 CFR 1.497(d).

### DISCUSSION

The published international application identified one applicant/inventor (Stefan RITT) for the United States. The present submission seeks to correct the inventorship so as to add inventor Roberto DINOPOLI to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17; and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).
- (4) any new oath or declaration required by paragraph (f) of this subsection.

Applicant here has submitted the required statement from the added inventor (Roberto DINOPOLI). Item (1) is therefore satisfied.

The submission filed 20 July 2010 included the authorization to charge Deposit Account No. 12-1099 for required fees. Based on this authorization, Deposit Account No. 12-1099 will be charged the required processing fee. Item (2) is satisfied.

Regarding item (3), applicant has submitted a document entitled "Statement Support of Petition for Correction of Inventorship in Patent Application under 37 CFR 1.48(a)." Additionally, applicant has submitted a "Statement under 37 CFR 3.73(b)."

These document states that: (1) the assignment is submitted for recordation and the person signing the document is an authorized representative of the assignee; and (2) the assignee consents to the addition of Roberto DINOPOLI as an inventor herein. However, the "Statement under 37 CFR 3.73(b)" states that a copy of the Assignment is enclosed therewith; however, the present petition file does not include a copy of the purportedly enclosed Assignment (nor does the "Statement under 37 CFR 3.73(b)" identify the recorded Assignment by reel and frame number, as required by 3.73(b)(1)(ii) if a copy of the Assignment is not provided). Because the assignee has not properly established ownership pursuant to 37 CFR 3.73(b), the statement of consent submitted here cannot, on the present record, be accepted in satisfaction of this requirement. Item (3) is therefore not satisfied.

Based on the above, the present record does not satisfy all the requirements of 37 CFR 1.497(d). The inventorship of record therefore remains that set forth in the international application. Because the inventors who executed the declaration filed 10 March 2010 are not the inventors of record herein, such declaration is defective under 37 CFR 1.497.

#### CONCLUSION

For the reasons discussed above, applicant's request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3298



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P O Box 2480  
Hollywood, FL 33022-2480

**MAILED**

**DEC 16 2010**

**PCT LEGAL ADMINISTRATION**

In re Application of: RITT et al. :  
Application No.: 12/677,342 :  
PCT No.: PCT/EP2008/007155 : **DECISION ON REQUEST**  
Int. Filing Date: 02 September 2008 :  
Priority Date: 01 October 2007 :  
Attorney Docket No.: 2007P16616 :  
For: FAST READOUT METHOD AND :  
SWITCHED CAPACITOR ARRAY :  
CIRCUITRY FOR WAVEFORM :  
DIGITIZING :

In a decision mailed by this Office on 15 November 2010, applicant's request to correct inventorship was dismissed without prejudice for failure to satisfy all the requirements of 37 CFR 1.497(d).

On 01 December 2010, applicant filed the renewed request under 37 CFR 1.497(d) considered herein. Applicant's submissions satisfy the requirements of 37 CFR 1.497(d). Applicant has submitted a statement from the added inventor. The processing fee set in forth in 37 CFR §1.17 has been submitted. And the present submission includes the consent of the assignee to the requested correction of inventorship, in the form required under 37 CFR 1.497(d)(3) and 3.73(b).

Based on the above, applicant's request to add Roberto DINOPOLI as an inventor is appropriately granted. Based on this correction, the declaration filed on 10 March 2010 (which named Stefan RITT and Roberto DINOPOLI) is acceptable under 37 CFR 1.497. Applicant's request to correct inventorship under 37 CFR 1.497(d) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accordance with this decision. The 35 U.S.C. 371(c) date is 10 March 2010.

Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3298



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/677,368	08/11/2010	Pierre Belloir	F-1069	1038
25264 7590 06/14/2011 FINA TECHNOLOGY INC PO BOX 674412 HOUSTON, TX 77267-4412				
EXAMINER				
ART UNIT PAPER NUMBER				
3754				
MAIL DATE DELIVERY MODE				
06/14/2011 PAPER				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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FINA TECHNOLOGY INC  
PO BOX 674412  
HOUSTON TX 77267-4412

Applicant: Belloir et al.  
Appl. No.: 12/677,368  
Filing Date: August 11, 2010  
Title: PIPES FOR TRANSPORTING WATER CONTAINING CHLORINE  
Attorney Docket No.: F-1069  
Pub. No.: US 2010/0323142 A1  
Pub. Date: December 23, 2010

This is a decision on the request for republication of patent application publication under 37 CFR 1.221(a), filed on June 13, 2011, for the above-identified application.

The request under 37 CFR 1.221(a) is DISMISSED.

37 CFR 1.221(a) requires "a copy of the application in compliance with the Office electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i)". If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

The applicant did not supply a copy of the application in compliance with the Office electronic filing system, as required by 37 CFR 1.221(a) because **the applicant submitted the papers as a "Document for an existing application", which are entered into the application file, and not as a "Pre-Grant Publication" submission.** The request for republication does not comply with the electronic filing system requirements, thus republication will not take place.

Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system, as a Pre-Grant publication submission and must include a copy of the application in compliance with the Office electronic filing system requirements. The applicant is directed to the following website for additional instructions on how to submit a Pre-Grant Publication submission via the electronic filing system:

[http://www.uspto.gov/ebc/portal/efs/pgpub\\_quickstart.pdf](http://www.uspto.gov/ebc/portal/efs/pgpub_quickstart.pdf)

Any questions or requests for reconsideration of the decision should be addressed as follows:

By mail to: Mail Stop PGPUB  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Va. 22313-1450

By facsimile: 571-273-8300

Telephone inquiries regarding this correspondence should be directed to The Office of Data Management at 571-272-4200.

A handwritten signature in black ink, appearing to read "Tammy J. Koontz", with a large, stylized loop at the end.

Tammy J. Koontz  
Office of Data Management  
United States Patent & Trademark Office

Adjustment date: 06/15/2011 KKING1  
06/13/2011 INTEFSW 00007944 033345 12677368  
01 FC:1504 300.00 CR



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/677,380	03/10/2010	Masahiro Kashiwagi	2010_0339A	1147

513	7590	08/26/2011
WENDEROTH, LIND & PONACK, L.L.P.		
1030 15th Street, N.W.,		
Suite 400 East		
Washington, DC 20005-1503		

EXAMINER	
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ART UNIT	PAPER NUMBER
3644	

NOTIFICATION DATE	DELIVERY MODE
08/26/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com  
eoa@wenderoth.com



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**AUG 25 2011**

WENDEROTH, LIND & PONACK, L.L.P.  
1030 15th Street, N.W.,  
Suite 400 East  
Washington DC 20005-1503

In re application of	:	<b>DECISION ON REQUEST TO</b>
Kashiwagi et al.	:	<b>PARTICIPATE IN PATENT</b>
Application No. 12/677,380	:	<b>PROSECUTION HIGHWAY</b>
Filed: March 10, 2010	:	<b>PROGRAM AND PETITION</b>
For: LIGHTNING-PROTECTION	:	<b>TO MAKE SPECIAL UNDER</b>
FASTERNER	:	<b>37 CFR 1.102(a)</b>

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed July 07, 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of the latest Office action from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO Office action along with copies of documents except U.S. patents or U.S. patent application publications.

In light of the preliminary amendment filed July 07, 2011. The request to participate in the PPH pilot program complies with the above requirements. Therefore, the above-identified application has been accorded "special" status.

All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Mikado Buiz, Quality Assurance Specialist, at (571) 272-6578.

          / Mikado Buiz /  
Mikado Buiz,  
Quality Assurance Specialist  
Technology Center 3600

MB/MB: 08/25/11



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MICHAEL L. DUNN  
SIMPSON & SIMPSON, PLLC  
5555 MAIN STREET  
WILLIAMSVILLE NY 14221

**MAILED**

**MAY 25 2011**

In re Application of  
Pandey et al  
Application No.: 12/677,381  
PCT No.: PCT/US2008/010609  
Int. Filing Date: 11 September 2008  
Priority Date: 14 September 2007  
Attorney's Docket No.: RPP183US  
For: MULTIMODALITY AGENTS FOR...  
AND THERAPY

: DECISION ON <sup>PCT</sup> LEGAL ADMINISTRATION  
:  
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: PAPERS FILED  
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: UNDER 37 CFR 1.42

This is a decision on the declaration filed 23 November 2010, which has been treated as a request for status under 37 CFR 1.42.

**BACKGROUND**

On 10 March 2010, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration was submitted at such time.

On 27 September 2010, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date... is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68." It also stated that items set forth above must be submitted within two months from date of mailing or by 32 months from the priority date, whichever is later. Failure to properly respond will result in abandonment."

On 23 November 2010, applicants submitted a responded to the Notice by filing an executed declaration which is signed, *inter alia*, by Stephanic Pincus as legal representative of the deceased joint inventor Allan Oseroff.

**DISCUSSION**

The executed declaration submitted is signed by Stephanic Pincus as legal representative of the deceased joint inventor Allan Oseroff and it satisfies the requirements under 37 CFR 1.42.

Accordingly, the requirements under 37 CFR 1.42 are satisfied and the declaration is acceptable at this time.

**CONCLUSION**

The submission filed under 37 CFR 1.42 is **ACCEPTED**.

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision.



Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Tel: (571) 272-3276  
Fax: (571) 273-0459

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE JAPAN PATENT OFFICE (JPO) AND THE USPTO

Application No:	12/677,387	Filing date:	March 10, 2010
First Named Inventor:	Yasutaka Okano		

Title of the Invention: COMPOSITE SHAPED ARTICLE AND PROCESS FOR MANUFACTURING THE SAME

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBS/EFIS\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

The corresponding PCT application number(s) is/are: PCT/JP2008/065939

The international date of the corresponding PCT application(s) is/are: 04.09.2008

## I. List of Required Documents:

- a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)



Is attached.



Is not attached because the document is already in the U.S. application.

- b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).



Is attached.



Is not attached because the document is already in the U.S. application.

- c. English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM  
BETWEEN THE JPO AND THE USPTO**

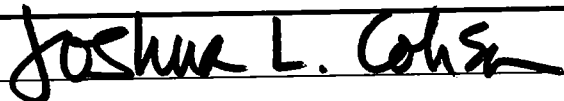
(continued)

Application No.:	12/677,387
First Named Inventor:	Yasutaka Okano
<p>d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.</p> <p><input type="checkbox"/> Is attached</p> <p><input checked="" type="checkbox"/> Has already been filed in the above-identified U.S. application on <u>March 10, 2010</u></p> <p>(2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)</p> <p><input type="checkbox"/> Are attached.</p> <p><input checked="" type="checkbox"/> Have already been filed in the above-identified U.S. application on <u>March 10, 2010</u></p>	

**II. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
1	1	Same scope accounting for differences due to translation
2	2	Same scope accounting for differences due to translation
3	3	Same scope accounting for differences due to translation
4	4	Same scope accounting for differences due to translation
5	5	Same scope accounting for differences due to translation
6	6	Same scope accounting for differences due to translation
7	7	Same scope accounting for differences due to translation
8	8	Same scope accounting for differences due to translation
9	9	Same scope accounting for differences due to translation
10	10	Same scope accounting for differences due to translation
11	11	Same scope accounting for differences due to translation
12	12	Same scope accounting for differences due to translation
13	13	Same scope accounting for differences due to translation
14	14	Same scope accounting for differences due to translation
15	15	Same scope accounting for differences due to translation
16	16	Same scope accounting for differences due to translation

III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.

Signature 	Date August 24, 2010
Name (Print/Typed) Joshua L. Cohen	Registration Number 38,040

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

## 請求の範囲

- [1] 板状部材と樹脂部材とからなり、前記板状部材と前記樹脂部材とが互いに向かい合う側端面において接合された接合面を有し、前記板状部材は、上面側と下面側とに位置する表層基材と該両表層基材の間に位置するコア層基材とからなり、前記各表層基材は、繊維強化樹脂から形成され、前記コア層基材は、前記各表層基材を形成する前記繊維強化樹脂よりも軟質の軟質材料から形成されている複合成品品において、前記接合面の少なくとも一部の接合面は、前記各表層基材の側端面と前記樹脂部材の側端面とが凹凸形状を有して接合された凹凸形状接合面であり、該凹凸形状における凹凸に沿って形成される実際の接合線の長さが、前記各表層基材が描く凹凸形状における隣り合う凸部の頂きを結ぶ直線線分の連続からなる凸部通過線の長さ1mm当たり、1.05mm以上であり、かつ、前記凹凸形状接合面において、前記樹脂部材の先端部が前記両表層基材の間に嵌入している樹脂部材嵌入先端部を有する複合成品品。
- [2] 少なくとも前記凹凸形状接合面における前記樹脂部材の側端面は、前記樹脂部材嵌入先端部を除いて、平面にて形成されている請求項1に記載の複合成品品。
- [3] 少なくとも前記凹凸形状接合面において、前記板状部材の厚さと前記樹脂部材の厚さが、実質的に同一である請求項1に記載の複合成品品。
- [4] 前記板状部材の厚さが、0.7乃至1.5mmである請求項1に記載の複合成品品。
- [5] 前記凹凸形状接合面において、前記各表層基材が描く凹凸形状における凸部の数が、前記凸部通過線の長さ100mm当たり、1乃至100である請求項1に記載の複合成品品。
- [6] 前記凹凸形状接合面において、前記各表層基材が描く凹凸形状における凹部 $P_n$ の前記凸部通過線から凹部谷底までの距離を凹部深さ $L_n$ とし、該凹部 $P_n$ の形状において前記凸部通過線により形成される凹部開口辺の両端間の距離を凹部開口幅 $F_n$ とすると、前記凹部深さ $L_n$ が、前記凹部開口幅 $F_n$ の0.1乃至10倍である請求項1に記載の複合成品品。
- [7] 前記凹部 $P_n$ が、凹部形状の輪郭線の一部に、丸みを有する線分を含んでいる請求項6に記載の複合成品品。

- [8] 前記凹部Pnが、前記凹部開口幅Fnよりも幅が広い部分を有する請求項6に記載の複合成形品。
- [9] 前記凹部Pnの形状が、実質的に多角形である請求項6に記載の複合成形品。
- [10] 前記各表層基材を形成する前記繊維強化樹脂における強化繊維が、炭素繊維である請求項1に記載の複合成形品。
- [11] 前記各表層基材を形成する前記繊維強化樹脂におけるマトリックス樹脂が、熱硬化性樹脂を含む樹脂である請求項1に記載の複合成形品。
- [12] 前記コア層基材を形成する前記軟質材料が、発泡材、ハニカム材、繊維シート、樹脂シートからなる群から選ばれた少なくとも一つの材料である請求項1に記載の複合成形品。
- [13] 前記樹脂部材が、繊維強化樹脂から形成されている請求項1に記載の複合成形品。
- [14] 前記樹脂部材を形成する繊維強化樹脂における強化繊維が、ガラス繊維あるいは炭素繊維である請求項13に記載の複合成形品。
- [15] (a) 繊維強化樹脂で形成された上面側と下面側に位置する表層基材と、該両表層基材の間に位置する、前記繊維強化樹脂よりも軟質の材料から形成されたコア層基材とからなる板状体の一側端面において、該端面から内方に向かう複数列の溝が設けられていることにより、該端面に凹凸形状が形成されている板状部材を用意する工程、  
(b) 用意された板状部材を、射出成形機の金型に收容する工程、および、  
(c) 前記板状部材が前記金型に收容された前記射出成形機において、少なくとも前記板状部材の凹凸形状を有する前記端面に対し、樹脂を射出し、該樹脂を前記板状部材の凹凸形状を有する前記端面に接合させるとともに、該樹脂が、前記両表層基材の間に嵌入するように射出成形する工程、  
とからなる請求項1に記載の複合成形品の製造方法。
- [16] 前記射出成形する工程において、前記板状部材とこれに接合される樹脂との少なくとも前記凹凸形状を有する接合部において、成形後の前記板状部材と樹脂部材の厚みが実質的に同一となるように、前記樹脂が射出される請求項15に記載の複合成

形品の製造方法。

**English Translation of Claims from PCT/JP2008/065939**

1. A molded composite article comprising a plate member and a resin member and having a bonding interface at which the plate member and the resin member are bonded to each other at side end faces thereof facing each other, in which the plate member comprises surface layer base materials positioned on the upper surface side and the lower surface side of the plate member and a core layer base material positioned between the both surface layer base materials; and the respective surface layer base materials are formed of a fiber-reinforced resin, while the core layer base material is formed of a soft material softer than the fiber-reinforced resin forming the respective surface layer base materials, wherein at least a partial bonding interface of the bonding interface is an undulating bonding interface at which undulating side end faces of the respective surface layer base materials and an undulating side end face of the resin member are bonded to each other; a length of an actual bonding line formed along an undulation of the undulating bonding interface is 1.05 mm or more per 1 mm length of a projection-connecting line consisting of straight line segments connecting crests of the respective projections adjacent to each other in an undulation form of the respective surface layer base materials; and at the undulating bonding interface, the resin member has a resin member penetrating tip portion that penetrates into a region between both the surface layer base materials.

2. The molded composite article according to claim 1, wherein at least at the undulating bonding interface, the side end face of the resin member is formed to be flat excluding the resin member penetrating tip portion.

3. The molded composite article according to claim 1, wherein at least at the undulating bonding interface, the thickness of the plate member is substantially equal to the thickness of the resin member.

4. The molded composite article according to claim 1, wherein the thickness of the plate member is 0.7 to 1.5 mm.

5. The molded composite article according to claim 1, wherein at the undulating bonding interface, the number of the projections in the undulation form of

the respective surface layer base materials is 1 to 100 per 100 mm length of the projection-connecting line.

6. The molded composite article according to claim 1, wherein at the undulating bonding interface, if the distance from the projection-connecting line to a recess bottom of each of recesses  $P_n$  in the undulation form of the respective surface layer base materials is a recess depth  $L_n$ , and the distance between both the ends of a recess opening line of the recess  $P_n$  formed as a line segment of the projection-connecting line within a form of the recess is a recess opening width  $F_n$ , then the recess depth  $L_n$  is 0.1 to 10 times the recess opening width  $F_n$ .

7. The molded composite article according to claim 6, wherein the recess  $P_n$  contains a roundish line segment in the profile line of the recess form.

8. The molded composite article according to claim 6, wherein the recess  $P_n$  has a portion wider than the recess opening width  $F_n$ .

9. The molded composite article according to claim 6, wherein the form of the recess  $P_n$  is substantially polygonal.

10. The molded composite article according to claim 1, wherein reinforcing fibers in the fiber-reinforced resin forming the respective surface layer base materials are carbon fibers.

11. The molded composite article according to claim 1, wherein a matrix resin in the fiber-reinforced resin forming the respective surface layer base materials is a resin containing a thermosetting resin.

12. The molded composite article according to claim 1, wherein the soft material forming the core layer base material is at least one material selected from the group consisting of foams, honeycomb materials, fiber sheets and resin sheets.

13. The molded composite article according to claim 1, wherein the resin member is formed of a fiber-reinforced resin.

14. The molded composite article according to claim 13, wherein reinforcing fibers in the fiber-reinforced resin forming the resin member are glass fibers or carbon fibers.

15. A process for producing a molded composite article as set forth in claim 1 comprising the steps of:

(a) preparing a plate member having an undulation form formed at one side end face of a plate-like body comprising surface layer base materials formed of a fiber-reinforced resin and positioned on the upper surface side and the lower surface side and a core layer base material formed of a material softer than the fiber-reinforced resin and positioned between both the surface layer base materials, by forming multiple grooves at the end face inward into the surface layer base materials,

(b) accommodating the prepared plate member in a mold of an injection molding machine, and

(c) injecting a resin at least toward the end face having an undulation form of the plate member in the injection molding machine having the plate member accommodated in the mold, to ensure that the resin can be bonded to the end face having the undulation form of the plate member and that the resin can penetrate into a region between both the surface layer base materials.

16. The process for producing a molded composite article according to claim 15, wherein in the injecting step, the resin is injected to ensure that the thickness of the plate member and the thickness of the resin member can be substantially equal to each other after completion of molding at least at a joint having the undulation form between the plate member and the resin bonded thereto.

**ACCURACY STATEMENT**

I, the below named translator, hereby declare that:

1. My name and post office address are as stated below.
2. That I am knowledgeable in the English language and in the Japanese language.
3. The above claims are English translations of claims 1-16 which were included in PCT application number PCT/JP2008/065939.
4. The above English translations of the claims are accurate translations.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: August 11, 2010

Full Name of the Translator

Motohiko Nagashima

Signature of the Translator

Motohiko Nagashima

Post Office Address

2-1-417, Hakusan 1-chome, Asao-ku, Kawasaki-shi, Kanagawa 2150014 Japan

# PATENT COOPERATION TREATY

# PCT

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference TP-08064-PCT	<b>FOR FURTHER ACTION</b>		See item 4 below
International application No. PCT/JP2008/065939	International filing date ( <i>day/month/year</i> ) 04 September 2008 (04.09.2008)	Priority date ( <i>day/month/year</i> ) 11 September 2007 (11.09.2007)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant TORAY INDUSTRIES, INC.			

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 4 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- |                                     |              |   |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I    | Basis of the report   |
| <input type="checkbox"/>            | Box No. II   | Priority  |
| <input type="checkbox"/>            | Box No. III  | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability  |
| <input type="checkbox"/>            | Box No. IV   | Lack of unity of invention  |
| <input checked="" type="checkbox"/> | Box No. V    | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/>            | Box No. VI   | Certain documents cited   |
| <input type="checkbox"/>            | Box No. VII  | Certain defects in the international application  |
| <input type="checkbox"/>            | Box No. VIII | Certain observations on the international application   |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report 30 March 2010 (30.03.2010)
Facsimile No. +41 22 338 82 70	Authorized officer  <div style="text-align: center; font-weight: bold;">Yoshiko Kuwahara</div> e-mail: pt07.pct@wipo.int

# PATENT COOPERATION TREATY

TRANSLATION

From the  
INTERNATIONAL SEARCHING AUTHORITY

## PCT

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing  
(day/month/year)

Applicant's or agent's file reference

**TP-08064-PCT**

**FOR FURTHER ACTION**

See paragraph 2 below

International application No.

**PCT/JP2008/065939**

International filing date (day/month/year)

**04.09.2008**

Priority date (day/month/year)

**11.09.2007**

International Patent Classification (IPC) or both national classification and IPC:

Applicant

**TORAY INDUSTRIES, INC.**

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/JP	Date of completion of this opinion	Authorized officer
Facsimile No.		Telephone No.

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/JP2008/065939

**Box No. I**

**Basis of this opinion**

1. With regard to the **language**, this opinion has been established on the basis of:
  - ☒ the international application in the language in which it was filed
  - ☐ a translation of the international application into \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).
2. ☐ This opinion has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43bis.1(a))
3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material
    - ☐ a sequence listing
    - ☐ table(s) related to the sequence listing
  - b. format of material
    - ☐ on paper
    - ☐ in electronic form
  - c. time of filing/furnishing
    - ☐ contained in the international application as filed
    - ☐ filed together with the international application in electronic form
    - ☐ furnished subsequently to this Authority for the purposes of search
4. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
5. Additional comments:

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.  
PCT/JP2008/065939

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;  
citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1-16	YES
	Claims		NO
Inventive step (IS)	Claims	1-16	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-16	YES
	Claims		NO

2. Citations and explanations:

Document 1: JP 2007-38519 A (Toray Industries, Inc.), 15  
February 2007

Document 2: JP 2006-44259 A (Toray Industries, Inc.), 16  
February 2006

Document 3: JP 4-305436 A (Nitta Corporation), 28 October 1992

Document 4: JP 48-15017 Y1 (The Furukawa Electric Co., Ltd.),  
25 April 1973

Document 5: Microfilm of the specification and drawings  
annexed to the request of Japanese Utility Model  
Application No. 48632/1986 (Laid-open No.  
159619/1987) (Matsumoto Co., Ltd.), 09 October  
1987

The invention as in claims 1-16 is neither disclosed in  
any of documents 1-5 cited in the ISR nor would it be obvious  
to a person skilled in the art, and therefore is novel and  
involves an inventive step.

# PATENT COOPERATION TREATY

# PCT

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference TP-08064-PCT	<b>FOR FURTHER ACTION</b>	See item 4 below
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International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
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1.	This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).																								
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3.	<p>This report contains indications relating to the following items:</p> <table style="width: 100%; border: none;"> <tr> <td style="width: 15%;"><input checked="" type="checkbox"/></td> <td style="width: 35%;">Box No. I</td> <td style="width: 50%;">Basis of the report</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. II</td> <td>Priority</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td><input checked="" type="checkbox"/></td> <td>Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td><input type="checkbox"/></td> <td>Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table>	<input checked="" type="checkbox"/>	Box No. I	Basis of the report	<input type="checkbox"/>	Box No. II	Priority	<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input type="checkbox"/>	Box No. IV	Lack of unity of invention	<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	<input type="checkbox"/>	Box No. VI	Certain documents cited	<input type="checkbox"/>	Box No. VII	Certain defects in the international application	<input type="checkbox"/>	Box No. VIII	Certain observations on the international application
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<p style="text-align: center;">The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland</p> <p>Facsimile No. +41 22 338 82 70</p>	<p>Date of issuance of this report 16 March 2010 (16.03.2010)</p> <p>Authorized officer</p> <p style="text-align: center; font-size: 1.2em;">Yoshiko Kuwahara</p> <p>e-mail: pt07.pct@wipo.int</p>
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# 特許協力条約

発信人 日本国特許庁（国際調査機関）

出願人 東レ株式会社 様 あて名 〒103-8666 日本国東京都中央区日本橋室町2丁目1番1号		PCT 国際調査機関の見解書 （法施行規則第40条の2） [PCT規則43の2.1]	
		発送日 （日.月.年） 11.11.2008	
出願人又は代理人 の書類記号 TP-08064-PCT		今後の手続きについては、下記2を参照すること。	
国際出願番号 PCT/J P 2008/065939	国際出願日 （日.月.年） 04.09.2008	優先日 （日.月.年） 11.09.2007	
国際特許分類（IPC）Int.Cl. B29C65/70(2006.01)i, B29C45/14(2006.01)i, B32B3/02(2006.01)i, B32B5/00(2006.01)i			
出願人（氏名又は名称） 東レ株式会社			

1. この見解書は次の内容を含む。 <input checked="" type="checkbox"/> 第I欄 見解の基礎 <input type="checkbox"/> 第II欄 優先権 <input type="checkbox"/> 第III欄 新規性、進歩性又は産業上の利用可能性についての見解の不作成 <input type="checkbox"/> 第IV欄 発明の単一性の欠如 <input checked="" type="checkbox"/> 第V欄 PCT規則43の2.1(a)(i)に規定する新規性、進歩性又は産業上の利用可能性についての見解、それを裏付けるための文献及び説明 <input type="checkbox"/> 第VI欄 ある種の引用文献 <input type="checkbox"/> 第VII欄 国際出願の不備 <input type="checkbox"/> 第VIII欄 国際出願に対する意見	
2. 今後の手続き 国際予備審査の請求がされた場合は、出願人がこの国際調査機関とは異なる国際予備審査機関を選択し、かつ、その国際予備審査機関がPCT規則66.1の2(b)の規定に基づいて国際調査機関の見解書を国際予備審査機関の見解書とみなさない旨を国際事務局に通知していた場合を除いて、この見解書は国際予備審査機関の最初の見解書とみなされる。 この見解書が上記のように国際予備審査機関の見解書とみなされる場合、様式PCT/ISA/220を送付した日から3月又は優先日から22月のうちいずれか遅く満了する期限が経過するまでに、出願人は国際予備審査機関に、適当な場合は補正書とともに、答弁書を提出することができる。 さらなる選択肢は、様式PCT/ISA/220を参照すること。	
3. さらなる詳細は、様式PCT/ISA/220の備考を参照すること。	

見解書を作成した日 31.10.2008	
名称及びあて先 日本国特許庁（ISA/J P） 郵便番号100-8915 東京都千代田区霞が関三丁目4番3号	特許庁審査官（権限のある職員） 川端 康之 電話番号 03-3581-1101 内線 3430

様式PCT/ISA/237（表紙）（2007年4月）

## 第 I 欄 見解の基礎

1. 言語に関し、この見解書は以下のものに基づき作成した。

- ☒ 出願時の言語による国際出願  
☐ 出願時の言語から国際調査のための言語である \_\_\_\_\_ 語に翻訳された、この国際出願の翻訳文  
(PCT規則12.3(a)及び23.1(b))

2. ☐ この見解書は、PCT規則 91 の規定により国際調査機関が認めた又は国際調査機関に通知された明らかな誤りの訂正を考慮して作成した (PCT規則 43 の 2.1(b))。

3. この国際出願で開示されたヌクレオチド又はアミノ酸配列に関して、以下に基づき見解書を作成した。

- a. タイプ ☐ 配列表  
☐ 配列表に関連するテーブル  
b. フォーマット ☐ 紙形式  
☐ 電子形式  
c. 提出時期 ☐ 出願時の国際出願に含まれていたもの  
☐ この国際出願と共に電子形式により提出されたもの  
☐ 出願後に、調査のために、この国際調査機関に提出されたもの

4. ☐ さらに、配列表又は配列表に関連するテーブルを提出した場合に、出願後に提出した配列若しくは追加して提出した配列が出願時に提出した配列と同一である旨、又は、出願時の開示を超える事項を含まない旨の陳述書の提出があった。

5. 補足意見：

第Ⅴ欄 新規性、進歩性又は産業上の利用可能性についてのPCT規則43の2.1(a)(i)に定める見解、  
それを裏付ける文献及び説明

1. 見解

新規性 (N)	請求の範囲	1-16	有
	請求の範囲		無
進歩性 (IS)	請求の範囲	1-16	有
	請求の範囲		無
産業上の利用可能性 (IA)	請求の範囲	1-16	有
	請求の範囲		無

2. 文献及び説明

文献1 : JP 2007-38519 A (東レ株式会社) 2007. 02. 15  
 文献2 : JP 2006-44259 A (東レ株式会社) 2006. 02. 16  
 文献3 : JP 4-305436 A (ニッタ株式会社) 1992. 10. 28  
 文献4 : JP 48-15017 Y1 (古河電気工業株式会社) 1973. 04. 25  
 文献5 : 日本国実用新案登録出願 61-48632 号 (日本国実用新案登録出願公開  
 62-159619 号) の願書に添付した明細書及び図面の内容を撮影したマイクロフィルム  
 (株式会社 松本製作所) 1987. 10. 09

請求の範囲1-16に係る発明は、国際調査報告で引用された文献1-5の何れにも記載されておらず、当業者にとって自明のものでもないから、新規性及び進歩性を有する。



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/677,387	03/10/2010	Yasutaka Okano	TOR-148US	1190
23122	7590	01/04/2011		
RATNERPRESTIA			EXAMINER	
P.O. BOX 980				
VALLEY FORGE, PA 19482			ART UNIT	PAPER NUMBER
			1783	
			MAIL DATE	DELIVERY MODE
			01/04/2011	PAPER

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BC

January 4, 2011

In re application of	:	DECISION ON REQUEST TO
Yasutaka Okano et al.	:	PARTICIPATE IN PATENT
Serial No. 12/677,387	:	PROSECUTION HIGHWAY
Filed: March 10, 2010	:	PROGRAM AND
For: COMPOSITE SHAPED ARTICLE AND	:	PETITION TO MAKE SPECIAL
PROCESS FOR MANUFACTURING	:	UNDER 37 CFR 1.102(a)

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed August 24, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, KIPO or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;
- (6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof if the latest international work

Application No. 12/677,387

product is not in the English language; and

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Blaine Copenheaver, Quality Assurance Specialist, at (571) 272-1156.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Blaine Copenheaver/

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Blaine Copenheaver  
Quality Assurance Specialist  
Technology Center 1700

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE JAPAN PATENT OFFICE (JPO) AND THE USPTO

Application No:	12/677388	Filing date:	March 10, 2010
First Named Inventor:	Rakan Matsui		
Title of the Invention:	TRANSDERMALLY ABSORBABLE PREPARATION		
THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT HTTP://WWW.USPTO.GOV/EBC/EFSS_HELP.HTML			
APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.			
<p>The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.</p>			
<p>The corresponding PCT application number(s) is/are: PCT/JP2008/002493</p>			
<p>The international date of the corresponding PCT application(s) is/are: September 10, 2008; We are not surrendering any claim for priority</p>			
<p><b>I. List of Required Documents:</b></p> <p>a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)</p> <p><input type="checkbox"/> Is attached.</p> <p><input checked="" type="checkbox"/> Is <u>not</u> attached because the document is already in the U.S. application.</p> <p>b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).</p> <p><input checked="" type="checkbox"/> Is attached.</p> <p><input type="checkbox"/> Is <u>not</u> attached because the document is already in the U.S. application.</p> <p>c. English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.</p>			

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM  
BETWEEN THE JPO AND THE USPTO**

(continued)

Application No.: 12/677388

First Named Inventor: Rakan Matsui

- d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

☐

Is attached

☒Has already been filed in the above-identified U.S. application on 6/15/2010; 8/3/2010

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)


☐

Are attached.

☒Have already been filed in the above-identified U.S. application on 6/15/2010; 8/3/2010**II. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
1-7	N/A	US claims canceled
8	1	The claims sufficiently correspond.
9	2	The claims sufficiently correspond.
10	3	The claims sufficiently correspond.
11	4	The claims sufficiently correspond.
12	5	The claims sufficiently correspond.
13	3	The claims sufficiently correspond.
14	4	The claims sufficiently correspond.
15	5	The claims sufficiently correspond.
16	6	The claims sufficiently correspond.
17	6	The claims sufficiently correspond.
18	6	The claims sufficiently correspond.
19	7	The claims sufficiently correspond.
20	7	The claims sufficiently correspond.
21	7	The claims sufficiently correspond.

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature 	Date <u>11/4/11</u>
Name (Print/Typed) <b>Kenneth A. Clark</b>	Registration Number <b>32119</b>

Statement

I, **Takashi Ikeda**, a technical translator to **Masashi Yanagida**, do solemnly and sincerely declare:

1. that I am fully conversant with the Japanese and English languages;
2. that the attached document is a copy of the Japanese language version of the claims indicated as having novelty, inventive step, and industrial applicability in the International Preliminary Examination Report (IPER) issued by the International Preliminary Examining Authority (JPO) for PCT/JP2008/002493;
3. that the attached document is an accurate English translation made by me of the claims indicated as having novelty, inventive step, and industrial applicability in the International Preliminary Examination Report (IPER) issued by the International Preliminary Examining Authority (JPO) for PCT/JP2008/002493; and
4. that I make this solemn declaration conscientiously believing the same to be true and correct.

Declared in Yokohama, Japan

This 17th day of October, 2011

Takashi Ikeda

### 請求の範囲

- [1] 有効成分としての天然型性ホルモンと、エチレンオキシド付加モル数が20のポリオキシエチレンオレイルエーテルと、アジピン酸ジイソプロピル、セチルアルコール、ベンジルアルコールおよびジカプリン酸プロピレングリコールから選択される2種以上の油分と、多価アルコールと、エタノールとを含む経皮吸収製剤。
- [2] エチレンオキシド付加モル数が2から10の1種以上のポリオキシエチレンオレイルエーテルをさらに含むことを特徴とする請求項1記載の経皮吸収製剤。
- [3] 前記天然型性ホルモンが、プロゲステロン、エストラジオール、エストロン、エストリオール、テストステロンおよびデヒドロエピアンドロステロンから選択される1種又は2種以上を含むことを特徴とする請求項1または2記載の経皮吸収製剤。
- [4] 前記天然型性ホルモンがプロゲステロンを含むことを特徴とする請求項3記載の経皮吸収製剤。
- [5] 前記天然型性ホルモンがエストラジオールを更に含むことを特徴とする請求項4記載の経皮吸収製剤。
- [6] 前記多価アルコールが、1, 3-ブチレングリコールまたはプロピレングリコールであることを特徴とする請求項1から5記載の経皮吸収製剤。
- [7] エタノールの配合量が製剤の全質量に対して20～60質量%であることを特徴とする請求項1から6いずれか1項記載の経皮吸収製剤。

1. A transdermally absorbable preparation, comprising:
  - i) a natural type sex hormone acting as an active ingredient,
  - ii) a polyoxyethylene oleyl ether having a molar number of ethylene oxide units added of 20,
  - iii) at least two kinds of oily ingredients selected from the group consisting of diisopropyl adipate, cetyl alcohol, benzyl alcohol, and propylene glycol dicaprate,
  - iv) a polyhydric alcohol, and
  - v) ethanol.
2. A transdermally absorbable preparation as defined in Claim 1 wherein the preparation further contains at least one kind of a polyoxyethylene oleyl ether having a molar number of ethylene oxide units added falling within the range of 2 to 10.
3. A transdermally absorbable preparation as defined in Claim 1 or 2 wherein the natural type sex hormone contains at least one kind of hormone selected from the group consisting of progesterone, estradiol, estrone, estriol, testosterone, and dehydroepiandrosterone.
4. A transdermally absorbable preparation as defined in Claim 3 wherein the natural type sex hormone contains progesterone.
5. A transdermally absorbable preparation as defined in Claim 4 wherein the natural type sex hormone further contains estradiol.
6. A transdermally absorbable preparation as defined in any of Claims 1 to 5 wherein the polyhydric alcohol is selected from the group consisting of 1,3-butylene glycol and propylene glycol.
7. A transdermally absorbable preparation as defined in any of Claims 1 to 6 wherein a containing quantity of ethanol falls within the range of 20% by mass to 60% by mass with respect to the total mass of the preparation.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/677,406	03/10/2010	Tomoyuki Aida	100278	1364
38834 7590 09/09/2010 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
			EXAMINER	
			ART UNIT	PAPER NUMBER
			3656	
			NOTIFICATION DATE	DELIVERY MODE
			09/09/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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patentmail@whda.com



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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP  
1250 CONNECTICUT AVENUE, NW  
SUITE 700  
WASHINGTON DC 20036

In re application of  
Aida et al.  
Application No. 12/677406  
Filed: March 10, 2010  
For: ROTATION RING

: **DECISION ON REQUEST TO**  
: **PARTICIPATE IN PATENT**  
: **PROSECUTION HIGHWAY**  
: **PROGRAM AND PETITION**  
: **TO MAKE SPECIAL UNDER**  
: **37 CFR 1.102(d)**

This is a decision on the renewed request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed July 21, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the EPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the EPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the EPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of the latest Office action from each of the EPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
- (6) Applicant must submit an IDS listing the documents cited by the EPO examiner in the EPO Office action along with copies of documents except U.S. patents or U.S. patent application publications.

In light of renewed petition, filed on July 21, 2010, the request to participate in the PPH program complies with the above requirements. Therefore, the above-identified application has been accorded "special" status.

All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Mikado Buiz, Quality Assurance Specialist, at (571) 272-6578.

          / Mikado Buiz /  
Mikado Buiz,  
Quality Assurance Specialist  
Technology Center 3600

BM/BM: 9/08/10



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26 AUG 2010

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HOXIE & ASSOCIATES LLC  
75 MAIN STREET , SUITE 301  
MILLBURN NJ 07041

In re Application of	:	
BIESSEN, et al.	:	DECISION ON PETITION
U.S. Application No.: 12/677,437	:	
PCT No.: PCT/IB2008/002771	:	UNDER 37 CFR 1.497(d)
Int. Filing Date: 10 September 2008	:	
Priority Date: 10 September 2007	:	
Atty Docket No.: UL-01-US	:	
For: FUTURE CARDIAC EVENT	:	
BIOMARKERS	:	

This decision is in response to applicant's petition to add an inventor filed 06 July 2010 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 10 September 2008, applicant filed international application PCT/IB2008/002771 which claimed priority to a previous application filed 10 September 2007. A copy of the international application was transmitted to the USPTO from the International Bureau (IB) on 19 March 2009. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 10 March 2010.

On 10 March 2010, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a preliminary amendment.

On 05 April 2010, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. In addition, applicant was notified of the need to provide a surcharge of \$130.00 for filing the oath or declaration later than 30 months from the earliest priority date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 06 July 2010, applicant filed the present petition including a combined declaration and power of attorney.

### DISCUSSION

A request under 37 CFR 1.497(d) [formally, 37 CFR 1.48] to correct an error in naming inventorship requires:

- (1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;
- (3) the fee set forth in 37 CFR 1.17(h); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

Applicant has satisfied all four items detailed above and it is proper to grant applicant's petition at this time.

### CONCLUSION

For the reasons discussed above, the request under 37 CFR 1.497(d) is **GRANTED**.

A review of the application papers reveals that applicant has now completed all the requirements of 35 U.S.C. 371 for entry into the national stage.

This application has an international application filing date of 10 September 2008 and will be given a date of **06 July 2010** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.

Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294



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22 SEP 2010

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SMART & BIGGAR  
P.O. BOX 2999, STATION D  
900-55 METCALFE STREET  
OTTAWA, CANADA K1P 5-Y6

In re Application of NOVAK et al	:	
U.S. Application No.: 12/677,438	:	
PCT Application No.: PCT/CA2008/001608	:	
Int. Filing Date: 11 September 2008	:	DECISION
Priority Date Claimed: 12 September 2007	:	
Attorney Docket No.: 77682-597	:	
For: SYSTEMS AND METHODS FOR UPLINK	:	
SIGNALLING	:	

This is in response to applicant's correspondence filed 30 June 2010, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

**BACKGROUND**

On 11 September 2008, applicant filed international application PCT/CA2008/001608, which claimed priority of an earlier United States application filed 12 September 2007. A copy of the international application was communicated to the USPTO from the International Bureau on 19 March 2009. The thirty-month period for paying the basic national fee in the United States expired on 12 March 2010.

On 10 March 2010, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and an executed declaration.

On 30 April 2010, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which identified certain defects in the declaration filed 10 March 2010.

On 30 June 2010, applicant filed the present petition under 37 CFR 1.181.

**DISCUSSION**

A review of the declaration filed 10 March 2010 reveals that the declaration fails to adequately identify the application to which it is directed. Although the petition states that the

international application number was stamped on the declaration prior to execution, the application number is not contained within the actual text of the declaration, i.e. not contained within the words which the inventors have declared.

Because petitioner provided a statement (regarding the stamping of the application number) which was intended to supplement the declaration filed on 10 March 2010, the present response is deemed a bona fide reply to the Notification of Missing Requirements, and accordingly the present application is not abandoned, even though the reply is not complete and proper.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is DISMISSED without prejudice.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of Defective Response (Form PCT/DO/EO/916), which should indicate that the declaration still does not identify the application to which it is directed. Failure to furnish a proper declaration within the period for response set forth in the Notification of Defective Response will result in abandonment of the application.



Bryan Lin  
PCT Legal Examiner  
PCT Legal Office

Telephone: 571-272-3303  
Facsimile: 571-273-0459



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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12/677,443

04/26/2010

Daniel Purkis

51026-P005WOUS

1594

7590  
WINSTEAD PC  
P.O. BOX 50784  
DALLAS, TX 75201

08/11/2010

EXAMINER

ART UNIT

PAPER NUMBER

3672

MAIL DATE

DELIVERY MODE

08/11/2010

PAPER

## DECISION DISMISSING PETITION UNDER 37 CFR 1.138(d)

*The declaration of express abandonment will not be recognized*

This is in response to the petition under 37 CFR 1.138(d), requesting for a refund of any previously paid search fee and excess claims fee in the above-identified application.

The petition is dismissed.

The express abandonment will **not** be recognized for the reason(s) indicated below:

- ☐ The petition was not filed in sufficient time to permit the appropriate officials to recognize the abandonment before an examination has been made of the application. See 37 CFR 1.138(d).
- ☐ The petition was not signed by a party authorized by 37 CFR 1.33(b)(1), (3) or (4).
- ☐ The application is not an application filed under 35 U.S.C. 111(a) on or after December 8, 2004.
- ☐ The petition for express abandonment under 1.138(d) is dismissed because the applicant did not pay any search fee and excess claims fees in the above-identified application.

Telephone inquiries should be directed to the Office of Data Management at (571) 272-4200.

  
Patent Publication Branch  
Office of Data Management

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**DATE : 08/01/11**

**TO SPE OF : ART UNIT: 1761 Attn: PYON HAROLD Y (SPE)**

**SUBJECT : Request for Certificate of Correction for Appl. No.: 12/677450 Patent No.: 7967872**

CofC mailroom date: 07/27/11

Please respond to this request for a certificate of correction within 7 days.

**FOR IFW FILES:**

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

**FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

**Certificates of Correction Branch (CofC)  
Randolph Square – 9D10-A  
Palm Location 7580**

Note: Please check Claim 7 (renumbered Claim 22)

**Tasneem Siddiqui**

**Certificates of Correction Branch**

**703-756-1814 & 703-756-1593**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

☐ **Approved**

**All changes apply.**

☐ **Approved in Part**

**Specify below which changes **do not** apply.**

☒ **Denied**

**State the reasons for denial below.**

**Comments:** Don't enter because the structure (Id) on page 12 of the original claim 22 (amended 7) is different from both corrected and uncorrected structures in the certificate of correction. \_\_\_\_\_

\_\_\_\_\_  
\_\_\_\_\_

/Harold Pyon/  
1761

**SPE**

**Art Unit**



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[www.uspto.gov](http://www.uspto.gov)

Patent No. : 7967872 B2  
Application No.: 12/677450  
Inventor(s) : Nicolas DAUBRESSE et al.  
Issued : 06/28/2011  
Attorney Docket No.: 05725.1833

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.323.

According to the Examiner about the error in claim 7, structure (Id). Don't enter because the structure (Id) on page 12 of the original claim 22 (amended 7) is different from both corrected and uncorrected structures in the certificate of correction.

In view of the foregoing, your request, in this matter, is hereby denied.

Tasneem Siddiqui  
For Mary Diggs (Supervisor)  
Decisions & Certificates of Correction Branch  
(703) 756-1593 or (703) 756-1814  
Date: 08/02/2011

Address: Deborah M. Herzfeld  
Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.  
901 New York Avenue, N.W.  
Washington, D.C. 20001-4413

ts



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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

**MAILED**

**SEP 22 2011**

**OFFICE OF PETITIONS**

Applicant: Daubresse, et al.

Appl. No.: 12/677,450

International Filing Date: September 8, 2008

Title: AZO QUINOLINIUM COMPRISING A DISULPHIDE/THIOL UNIT, COMPOSITIONS CONTAINING SAME, PROCESS FOR DYEING KERATIN FIBRES AND DEVICE

Attorney Docket No.: 05725.1833-00000

Pub. No.: US 2010/0263139 A1

Pub. Date: December 21, 2010

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on December 15, 2010, for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication contains material errors wherein the preliminary amendment to the specification filed with the application on March 10, 2010 was not included in the publication.

37 CFR 1.221 (b) is applicable “only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable.” A material mistake must affect the public’s ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.<sup>1</sup>

The error noted by requestor with respect to the preliminary amendment is not an Office error. The patent application publication does not include a mistake regarding the failure to include the preliminary amendment to the specification because patent application publications are not required to include preliminary amendments. See 37 CFR 1.215(a). The “failure to include an amendment is not an Office error.” See MPEP 1130(b). The publication accurately reflected the specification as filed.

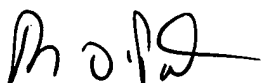
<sup>1</sup>Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

37 C.F.R. 1.215(a) states that the patent application publication may also be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under § 1.125(b), amendments to the abstract under § 1.121(b), amendments to the claims that are reflected in a complete claim listing under § 1.121(c), and amendments to the drawings under § 1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. (emphasis added) 37 CFR 1.215(c) states that applicant may file an amended copy of the application for publication purposes, but such amendments, including a substitute specification, must be submitted in compliance with the Office electronic filing system requirements, and within one month of the mailing date of the first Office communication that includes a confirmation number for the application, or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

Applicant is reminded of his duty to conduct a reasonable inquiry before filing a paper before the Office. See MPEP 410.

Applicants' request for a corrected patent application publication on December 9, 2010, may constitute a "failure to engage in reasonable efforts to conclude processing or examination of the application." See 1.704(c). This determination will be made on or after a mailing of a Notice of Allowance.

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709.



Mark Polutta  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/677,470	03/10/2010	Wataru Hisada	04632.0144	1770
22852 7590 07/20/2011 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER PATEL, HARSHAD R	
			ART UNIT 2855	PAPER NUMBER
			MAIL DATE 07/20/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON DC 20001-4413**

**In re Application of  
HISADA et al.  
Application No.: 12/677,470  
Filed: 10 March 2010  
Attorney Docket No.: 04632.0144  
For: APPARATUS FOR MEASURING A  
FLOW RATE OF A POWDER**

**: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)**

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed 12 July 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PPH pilot program and petition to make special require:

1. The U.S. application is
  - a. a Paris Convention application which either
    - i. validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
  - b. a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
    - i. validly claims priority to an application filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
    - iii. contains no priority claim, or
  - c. a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
    - i. validly claims priority to an application filed in the JPO, or

- ii. validly claims priority to a PCT application that contains no priority claims, or
  - iii. contains no priority claim;
- 2. Applicant must submit a copy of:
  - a. The allowable/patentable claim(s) from the JPO application(s);
  - b. An English translation of the allowable/patentable claim(s) and
  - c. A statement that the English translation is accurate;
- 3. Applicant must:
  - a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s) and
  - b. Submit a claims correspondence table in English;
- 4. Examination of the U.S. application has not begun;
- 5. Applicant must submit:
  - a. Documentation of prior office action:
    - i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claim(s) or
    - ii. if the allowable/patentable claims(s) are from a "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
    - iii. if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form;
  - b. An English language translation of the JPO Office action from (5)(a)(i)-(ii) above
  - c. A statement that the English translation is accurate;
- 6. Applicant must submit:
  - a. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
  - b. Copies of the documents except U.S. patents or U.S. patent application publications (unless already submitted in this application);

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Inquiries concerning this decision should be directed to Lee W. Young at 571-272-4549.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

This application will be forwarded to the examiner for action on the merits commensurate with this decision once this application's formality reviews have been completed.



Lee W. Young  
TQAS, Technology Center 2800 – Semiconductors  
Electrical & Optical Systems & Components



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PHILLSBURY WINTHROP SHAW PITTMAN, LLP  
P.O. BOX 10500  
MCLEAN, VA 22102

**MAILED**  
**SEP 23 2011**  
**OFFICE OF PETITIONS**

Applicants: Schichtel, et al.  
Appl. No.: 12/677,495  
International Filing Date: September 5, 2008  
Title: COMPOSITION BASED ON PHOSPHATIC RAW MATERIALS AND PROCESS FOR THE PREPARATION THEREOF  
Attorney Docket: 033377-0385571  
Pub. No.: US 2010/0269735 A1  
Pub. Date: October 28, 2010

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on December 17, 2010, for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication contains a material error wherein the claims filed with the application do not coincide with the claims included in the publication, as the Office published the translated claims that were included in the international application, not the claims as filed.

37 CFR 1.221 (b) is applicable “only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable.” A material mistake must affect the public’s ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.<sup>1</sup>

The error noted by requestor with respect to the preliminary amendment is not an Office error.

1) The patent application publication does not include a mistake regarding the failure to include the preliminary amendment to the specification because patent application publications are not required to include preliminary amendments. See 37 CFR 1.215(a). The “failure to include an amendment is not an Office error.” See MPEP 1130(b). The publication accurately reflected the specification as filed.

<sup>1</sup>Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

2) The translated specification and claims are the application papers. Applicants "preliminary amendment" received on March 10, 2010 is not in compliance with 37 CFR 1.121 and 37 CFR 1.125.

37 C.F.R. 1.215(a) states that the patent application publication may also be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under § 1.125(b), amendments to the abstract under § 1.121(b), amendments to the claims that are reflected in a complete claim listing under § 1.121(c), and amendments to the drawings under § 1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. (emphasis added) 37 CFR 1.215(c) states that applicant may file an amended copy of the application for publication purposes, but such amendments, including a substitute specification, must be submitted in compliance with the Office electronic filing system requirements, and within one month of the mailing date of the first Office communication that includes a confirmation number for the application, or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

Applicant is reminded of his duty to conduct a reasonable inquiry before filing a paper before the Office. See MPEP 410.

Applicants' request for a corrected patent application publication on December 17, 2010, may constitute a "failure to engage in reasonable efforts to conclude processing or examination of the application." See 1.704(c). This determination will be made on or after a mailing of a Notice of Allowance.

It would greatly benefit the Office if **applicant did not provide copies of papers**, which were previously submitted and/or **a complete copy of the pre-grant publication**, as it unnecessarily increases the cost to the Office. See 37 CFR 1.4(b). A request for corrected publication need only point out what was printed incorrectly in the application, where the error occurs in the publication and where the correct text or drawing is found in the application papers. Marked up relevant copies of the applications papers and the pre-grant publication may facilitate processing of the request, where it is not readily apparent where the error occurs. If it is not clear why the error is a material error, further explanation may be warranted.

The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221 (a). Such a request for republication "must include a copy of the application compliance with the Office's electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18 (d) and the processing fee set forth in § 1.17 (i)." If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18 (d) will be refunded. The processing fee will be retained.

A guide for filing a request for a Pre-Grant Publication, such as a request for republication, may be found on the link below:

<http://www.uspto.gov/patents/process/file/efs/guidance/index.jsp>

OR

[http://www.uspto.gov/ebc/portal/efs/pgpub\\_quickstart.pdf](http://www.uspto.gov/ebc/portal/efs/pgpub_quickstart.pdf)

Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system, as a "Pre-Grant Publication".

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709.



Mark Polutta  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/677,496	03/10/2010	Jac-Hui Choi	29137.587.00	1062

30827 7590 07/18/2011  
MCKENNA LONG & ALDRIDGE LLP  
1900 K STREET, NW  
WASHINGTON, DC 20006

EXAMINER
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WITHERSPOON, SIKARL A

ART UNIT	PAPER NUMBER
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1621

MAIL DATE	DELIVERY MODE
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07/18/2011

PAPER

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JUL 18 2011

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MCKENNA LONG & ALDRIDGE LLP  
1900 K STREET, NW  
WASHINGTON, DC 20006

In re Application of	:	DECISION ON REQUEST TO
CHOI ET AL.	:	PARTICIPATE IN PATENT
Application No. 12/677,496	:	PROSECUTION HIGHWAY
Filed: March 10, 2010	:	PROGRAM AND PETITION
Attorney Docket No. 29137.587.00	:	TO MAKE SPECIAL UNDER
	:	37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed November 22, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application is (a) a Paris Convention application which either (i) validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed with KIPO, or (ii) validly claims priority under 35 U.S.C. 119(a)/365(a) to a PCT application that contains no priority claims, or (b) a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application (i) validly claims priority under 35 U.S.C. 365(b) to an application filed with KIPO, or (ii) validly claims priority under 35 U.S.C. 365(b) to a PCT application that contains no priority claims, or (iii) contains no priority claim, or (c) a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application (i) validly claims priority under 35 U.S.C. 365(b) to an application filed with KIPO, or (ii) validly claims priority under 35 U.S.C. 365(b) to a PCT application that contains no priority claims, or (iii) contains no priority claim;
- (2) The KIPO application(s) has at least one claim that was determined by KIPO to be allowable;
- (3) All the claims in each U.S. application for which a request for participation in the PPH pilot program is made must sufficiently correspond or be amended to sufficiently correspond to the allowable claims in the KIPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions (which are relevant to patentability) from each of the KIPO application(s) containing the allowable claims that are the basis for the request;
- (6) Applicant must submit a copy of the allowable claims from the KIPO application(s);
- (7) Applicant must submit a claim correspondence table; and

(8) Applicant must submit an information disclosure statement (IDS) listing the documents cited by the KIPO examiner in the KIPO office action (unless such an IDS has already been filed in the U.S. application).

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Cecilia Tsang at 571-272-0562.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system at the <http://www.uspto.gov/ebc/index.html>.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.



Cecilia Tsang

Supervisory Patent Examiner  
TC 1600



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FSB FisherBroyles, a Limited Liability Partnership  
The Pinnacle Building  
3455 Peachtree Road, NE Fifth Floor  
Atlanta GA 30326

**MAILED**

**JUL 15 2011**

PCT LEGAL ADMINISTRATION

In re Application of: :  
SHALWITZ, Robert :  
U.S. Application No.: 12/677,512 :  
PCT No.: PCT/US2010/020817 :  
International Filing Date: 12 January 2010 :  
Priority Date: 12 January 2009 :  
Attorney's Docket No.: 00668.P012U2 :  
For: METHODS FOR TREATING VASCULAR LEAK :  
SYNDROME :

PETITION UNDER  
37 CFR 1.497(d)  
TO CORRECT INVENTORSHIP

This decision is issued in response to applicant's "Request for Correction of Inventorship under 37 CFR 1.48(a)" filed 01 December 2010, which is being treated as a Request under 37 CFR 1.497(d).

**BACKGROUND**

On 12 January 2010, applicant filed international application PCT/US2010/020817 which claimed a priority date of 12 January 2009. The international application named Robert Shalwitz as the sole applicant/inventor. The deadline for submission of the basic national fee was to expire thirty months from the priority date, i.e., 12 July 2011.

On 10 March 2010, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. 371. Filed with the Transmittal Letter were, the requisite basic national fee, a declaration executed by Robert Shalwitz; and a preliminary amendment.

On 01 December 2010, applicant filed a declaration executed by: Robert Shalwitz and Kevin G. Peters and the present request to Correct Inventorship under 37 CFR 1.497(d).

**DISCUSSION**

As defined in 37 CFR 1.9(a)(3), a U.S. national stage application must first comply with the requirements of 35 U.S.C. 371(c) to constitute a "nonprovisional" application, therefore, applicants' request will be treated under 37 CFR 1.497(d). The present submission seeks to correct the inventorship so as to add an inventor (Kevin G. Peters) to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicant must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17;

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter); and

(4) any new oath or declaration required by paragraph (f) of this subsection.

Applicant has submitted a statement from the persons being added (Kevin G. Peters) as an inventor in compliance with 37 CFR 1.497(d)(1). The \$130 processing fee required under 37 CFR 1.497(d)(2) has been submitted. Additionally, applicant has submitted a statement of consent by the assignee, along with a copy of the Assignment document by which the assignee obtained its interest in the present application. Lastly, applicant has submitted a declaration executed by Robert Shalwitz and Kevin G. Peters. Therefore, applicant's request to correct inventorship under 37 CFR 1.497(d) is granted.

#### **CONCLUSION**

The request under 37 CFR 1.497(d) is **GRANTED**.

Kevin G. Peters will be added as inventors herein.

The application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.



Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3298



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

**MAILED**

**DEC 22 2010**

**PCT LEGAL ADMINISTRATION**

Bio Intellectual Property Services (BIO IPS) LLC  
8509 Kernon Ct.  
Lorton, VA 22079

In re Application of	:	
DABRE et al.	:	
U.S. Application No.: 12/677,532	:	
PCT No.: PCT/IB2008/053716	:	PETITION UNDER
Int. Filing Date: 13 September 2008	:	37 CFR 1.47(a)
Priority Date: 27 September 2007	:	
Attorney Docket No.: WH-50	:	
For: RHEIN OR DIACEREIN	:	
COMPOSITIONS	:	

This decision is issued in response to applicants' "Petition under 37 CFR 1.47(a)" filed 13 October 2010 to accept the application without the signature of joint-inventor, Cyril Estanove. The petition fee has been submitted. Additionally, the declaration filed 04 October 2010 is being treated as a Request under 37 CFR 1.42.

**BACKGROUND**

On 13 September 2008, applicants filed international application PCT/IB2008/053716 which claimed a priority date of 27 September 2007. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 19 March 2009. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 14 March 2010.

On 11 March 2010, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a copy of the international application.

On 03 May 2010, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 04 October 2010, applicants submitted an executed declaration.

On 13 October 2010, applicants filed the present petition under 37 CFR 1.47(a).

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1), (3) and (4) have been satisfied.

As to item (2), petitioner states that Cyril Estanove cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

A review of the present petition reveals that petitioner has not provided an acceptable showing that a diligent effort was made to locate the nonsigning inventor, Cyril Estanove. The petition alleges that inventor Cyril Estanove cannot be found or located, however, no documentary evidence to support the attempt(s) was provided with the petition.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to the legal representative and when such papers were sent and that the legal representative has subsequently refused to execute the application. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration. Therefore, item (2) has not been satisfied.

Regarding item (4) above, an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor has been submitted with the present petition. Additionally, the declaration is executed by H. Francois Pruvost as the "legal representative" of the deceased inventor, Francois Pruvost. The declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b).

### CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel.: 703-308-6314  
Facsimile: 703-308-6459



UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

Bio Intellectual Property Services (BIO IPS) LLC  
8509 Kernon Ct.  
Lorton, VA 22079

**MAILED**

**JUN 20 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of	:	
DABRE et al.	:	
U.S. Application No.: 12/677,532	:	
PCT No.: PCT/IB2008/053716	:	PETITION UNDER
Int. Filing Date: 13 September 2008	:	37 CFR 1.47(a)
Priority Date: 27 September 2007	:	
Attorney Docket No.: WH-50	:	
For: RHEIN OR DIACEREIN	:	
COMPOSITIONS	:	

This decision is issued in response to applicants' "Response to Decision on Petition under 37 CFR 1.47(a)" filed 22 March 2011 to accept the application without the signature of joint-inventor, Cyril Estanove. Additionally, the declaration is being treated as a Request under 37 CFR 1.42.

The procedural background for this application was set forth in detail in the decision mailed by this Office on 22 December 2010.

**DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor.

In the Decision mailed 22 December 2010, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice for failing to satisfy all the requirements of a grantable petition. Specifically, applicants did not provide adequate proof that nonsigning inventor (Cyril Estanove) refused to execute the application or could not be reached after diligent effort.

Regarding item (2), the petition asserts that the nonsigning inventor has refused to execute the declaration. Before a refusal to execute the application can be claimed, section 409.03(d) of the MPEP requires that the nonsigning inventor be provided with a copy of the complete application, including specification, drawings and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made."

Here, the evidence submitted to demonstrate Cyril Estanove's refusal to execute the application papers is contained in the Declaration of O.M. (Sam) Zaghmout included in the petition, and the exhibits thereto. These materials provide the required firsthand statement regarding the delivery to the nonsigning inventor of a copy of the complete application, and the nonsigning inventor's refusal to execute the application, with documentary evidence supporting the statement. Item (2) is therefore satisfied.

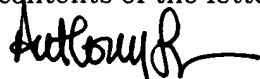
As to item (4), the previous decision indicated the oath or declaration submitted with the 13 October 2010 petition was acceptable under 37 CFR 1.42 and complied with 37 CFR 1.497(a)-(b). However, further inspection reveals that said declaration is defective pursuant to 37 CFR 1.497(a)(3) which requires that the declaration "identify each inventor and the residence and country of citizenship of each inventor." Specifically, the declaration submitted failed to include the citizenship of the nonsigning inventor, Cyril Estanove. Applicants are reminded that all the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR 1.64.<sup>1</sup> Therefore, a newly executed declaration is required.

#### CONCLUSION

The renewed petition filed under 37 CFR 1.47(a) is **DISMISSED** without prejudice and the previously filed declaration is **NOT ACCEPTED**.

A proper response (i.e., an oath or declaration compliant with 37 CFR 1.497(a) and (b)) must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to file a proper response will result in **ABANDONMENT** of the application.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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<sup>1</sup>37 CFR 1.64(b) states (in part): If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, 1.47, or § 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is required to state (emphasis added).



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Bio Intellectual Property Services (BIO IPS) LLC  
8509 Kernon Ct.  
Lorton, VA 22079

**MAILED**

**OCT 25 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of :  
DABRE et al. :  
U.S. Application No.: 12/677,532 :  
PCT No.: PCT/IB2008/053716 :  
Int. Filing Date: 13 September 2008 :  
Priority Date: 27 September 2007 :  
Attorney Docket No.: WH-50 :  
For: RHEIN OR DIACEREIN :  
COMPOSITIONS :

**DECISION ON PETITION  
UNDER 37 CFR 1.42 & 1.47(a)**

This decision is issued in response to applicants' "Response to Decision on Petition under 37 CFR 1.47(a)" filed 20 September 2011 to accept the application without the signature of joint-inventor, Cyril Estanove. The petition fee has been submitted. Additionally, the declaration filed 20 September 2011 is being treated as a Request under 37 CFR 1.42.

**BACKGROUND**

On 13 September 2008, applicants filed international application PCT/IB2008/053716 which claimed a priority date of 27 September 2007. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 19 March 2009. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 14 March 2010.

On 11 March 2010, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a copy of the international application.

On 03 May 2010, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 04 October 2010, applicants submitted an executed declaration.

On 13 October 2010, applicants filed a petition under 37 CFR 1.47(a). In a decision dated 22 December 2010, applicants' petitions under 37 CFR 1.42 and 1.47 were dismissed without prejudice.

On 22 March 2011, applicants filed the renewed petitions under 37 CFR 1.42 and 1.47. In a decision dated 20 June 2011, applicants' petitions under 37 CFR 1.42 and 1.47 were dismissed without prejudice.

On 20 September 2011, applicants filed the present renewed petitions under 37 CFR 1.42 and 1.47.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1) and (3) have been satisfied.

Regarding item (2), the petition asserts that the nonsigning inventor has refused to execute the declaration. Before a refusal to execute the application can be claimed, section 409.03(d) of the MPEP requires that the nonsigning inventor be provided with a copy of the complete application, including specification, drawings and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made."

Here, the evidence submitted to demonstrate Cyril Estanove's refusal to execute the application papers is contained in the Declaration of O.M. (Sam) Zaghmout included in the petition, and the exhibits thereto. These materials provide the required firsthand statement regarding the delivery to the nonsigning inventor of a copy of the complete application, and the nonsigning inventor's refusal to execute the application, with documentary evidence supporting the statement. Item (2) is therefore satisfied.

Regarding item (4) above, an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor has been submitted with the present petition. Additionally, the declaration is executed by H. Francois Pruvost as the "legal representative" of the deceased inventor, Francois Pruvost. The declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b).

### CONCLUSION

The petition under 37 CFR 1.47(a) is GRANTED.

The request for status under 37 CFR 1.42 is ACCEPTED.

The application has an international filing date of 13 September 2008 under 35 U.S.C. 363 and a date of 20 September 2011 under 35 U.S.C. 371(c)(1),(c)(2) and (c)(4).

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.



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Fax: (571) 273-0459



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United States Patent and Trademark Office  
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LADAS & PARRY LLP  
1040 Avenue of the Americas  
NEW YORK NY 10018-3738

**MAILED**  
**FEB 14 2012**  
**OFFICE OF PETITIONS**

In re Application of :  
Krohn : DECISION ON PETITION  
Application No. 12/677,558 :  
Filed: March 11, 2010 :  
Atty. Dkt. No.: U 018025-8 :

This decision is in response to the petition under 37 CFR 1.137(b), filed January 25, 2012.

The petition is **GRANTED**.

The application became abandoned August 23, 2011 for failure to timely submit a proper reply to the Office action mailed July 22, 2011. The Office action set a one month shortened statutory period of time for reply. This decision precedes Notice of Abandonment.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition has been carefully reviewed and found in compliance with the requirements set forth above.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See, In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the \$1,345.00 extension of time fee submitted with the petition was subsequent to the maximum extendable period for reply, this fee is unnecessary. Petitioner may request a refund by writing to the Finance Office, Refund Section. A copy of this decision should accompany any written request for reply.

This application is being forwarded to Group Art Unit 1634 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3205.

*/ALESIA M. BROWN/*

Alesia M. Brown  
Attorney Advisor  
Office of Petitions

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE JAPAN PATENT OFFICE (JPO) AND THE USPTO

Application No:	12677610	Filing date:	06-07-2010
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First Named Inventor:	Osamu Honmou
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Title of the Invention:	Cell Growth Method and Pharmaceutical Preparation for Tissue Repair and Regeneration
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**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT  
HTTP://WWW.USPTO.GOV/EBC/EFSS\_HELP.HTML**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/JP2008/002503

**The international date of the corresponding PCT application(s) is/are:** 09/10/2010

## I. List of Required Documents:

a. **A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**

☐

Is attached.

☒

Is not attached because the document is already in the U.S. application.

b. **A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**

☐

Is attached.

☒

Is not attached because the document is already in the U.S. application.

c. **English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM  
BETWEEN THE JPO AND THE USPTO**

(continued)

Application No.: 12677610

First Named Inventor: Osamu Honmou

- d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

☐

Is attached

☒

Has already been filed in the above-identified U.S. application on \_\_\_\_\_

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)

☐

Are attached.

☒

Have already been filed in the above-identified U.S. application on \_\_\_\_\_

**II. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
1	1	US claim 1 relates to Article 34 PCT claim 1
3	2	US claim 3 relates to Article 34 PCT claim 2
4	3	US claim 4 relates to Article 34 PCT claim 3
5	4	US claim 5 relates to Article 34 PCT claim 4
7	7	US claim 7 relates to Article 34 PCT claim 7
8	8	US claim 8 relates to Article 34 PCT claim 8
9	9	US claim 9 relates to Article 34 PCT claim 9
10	10	US claim 10 relates to Article 34 PCT claim 10
11	11	US claim 11 relates to Article 34 PCT claim 11
12	12	US claim 12 relates to Article 34 PCT claim 12
39	11	US claim 39 relates to Article 34 PCT claim 11
40	5	US claim 40 relates to Article 34 PCT claim 5
41	13	US claim 41 relates to Article 34 PCT claim 13
42	14	US claim 42 relates to Article 34 PCT claim 14
43	15	US claim 43 relates to Article 34 PCT claim 15
44	37	US claim 44 relates to Article 34 PCT claim 37
45	38	US claim 45 relates to Article 34 PCT claim 38

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature /Kendrew H. Colton/	Date 08-12-2011
Name (Print/Typed) Kendrew H. Colton	Registration Number 30368



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P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**FITCH, EVEN, TABIN & FLANNERY  
P.O. BOX 18415  
WASHINGTON DC 20036**

**MAILED**

**JAN 31 2012**

**OFFICE OF PETITIONS**

**In re Application of  
NONMOU, et al  
Application No.: 12/677,610  
Filed: June 7, 2010  
Attorney Docket No.: 8867-98078  
For: CELL GROWTH METHOD AND  
PHARMACEUTICAL PREPARATION  
FOR TISSUE REPAIR AND  
REGENERATION**

**: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)**

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed on August 12, 2011, to make the above-identified application special.

The request and petition are **DISMISSED**.

**Discussion**

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must have an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, Australia, Austria, KIPO, NPI, Russia, Spain, Sweden, Finland, China, or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);

(5) Examination of the U.S. application has not begun;

(6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate if the latest international work product is not in the English language;

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

(8) Applicant is required to submit a claims correspondence table in English which indicates how all the claims in the U.S. application correspond to the claims indicated as having novelty, inventive step and industrial applicability in the latest international work product.

Requirements (1, 2), (5) and (8) above are considered to have been met. However, the request to participate in the PPH pilot program and petition fail to meet requirement (3), (4), (6) and (7).

Regarding the requirement of condition (3), applicant has not submitted a copy of the claims from the that have novelty, inventive step and industrial applicability along with an English translation and a statement that the translation is accurate.

Regarding the requirement of condition (4), since applicant has not submitted a translation from the PCT applicant, it cannot be determined if the claims from the JPO sufficiently correspond to the U.S. application.

Regarding the requirement of condition (6), applicant has failed to submit a translation statement for the international work product in the JPO application.

Regarding the requirement of condition (7), applicant has failed to submit a listing of the documents cited by the PCT examiner in the international work product.

Applicant is given **ONE** opportunity within a time period of **ONE MONTH or THIRTY DAYS**, whichever is longer, from the mailing date of this decision to correct the deficiencies. **NO EXTENSION OF TIME UNDER 37 CFR 1.136 IS PERMITTED.** If the deficiencies are not corrected with the time period given, the application will await action in its regular turn.

Response must be filed via the Electronic Filing System (EFS) using the document description: Petition to make special under Patent Pros Hwy. Any preliminary amendments and IDS submitted with the PPH documents must be separately indexed as a preliminary amendment and IDS, respectively.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

/Diane Goodwyn/  
Diane Goodwyn  
Petitions Examiner  
Office of Petitions

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Osamu HONMOU et al. Confirmation No.: 1939  
Serial No.: 12/677,610 Petitions Examiner: Diane Goodwyn  
Filed: March 11, 2010 Group Art Unit: 1651  
Atty. Dkt. No.: 8867/98078  
For: CELL GROWTH METHOD AND  
PHARMACEUTICAL PREPARATION FOR TISSUE  
REPAIR AND REGENERATION

**SUBMISSION AND REQUEST FOR RECONSIDERATION OF DECISION ON  
PETITION**

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22314

Sir:

Applicants respond to the January 31, 2012 Decision on Request to participate in the PPH based on favorable determination during the PCT stage. Applicants respectfully solicit early and favorable consideration of this paper and entry in the PPH.

1. Applicants previously submitted a translation of the PCT claims as amended under Article 34. Upon present information and belief the translation is accurate.
2. Applicants previously submitted the PCT documentation to show PCT claims 1-5, 7-15 and 37-38 define novel inventions having inventive step. Claims 1-5 and 37-38 have industrial applicability as well. The PCT documentation includes the International Preliminary Report on Patentability. The PCT documentation from WIPO was filed herein. The WIPO document of interest was in Japanese and in English, and both are of record herein. The WIPO English translation of record reports:

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY		INTERNATIONAL APPLICATION NO.
		PCT/JP2008/002503
Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	
1. Statement		
Novelty (N)	Claims 1-5, 7-15, 37, 38	YES
	Claims 16-36	NO
Inventive step (IS)	Claims 1-5, 7-15, 37, 38	YES
	Claims 16-36	NO
Industrial applicability (IA)	Claims 1-5, 7-38	YES
	Claims	NO

3. Amended claim 1, amended claims 4 and 5, canceled claims 2, 6, and 16-38, and new claims 39-45 related to PCT claims (article 34). Claims 1, 3, 4, 5 and 40 relate to PCT article 34 claims 1-5. Claims 7-12 relate to PCT claims 7-12. New claims 39-45 relate to PCT claims 11, 13-15 and 37-38. New claim 44 includes subparts (a)-(c) that relate to PCT claims 16-18, and retains the PCT claim 37 language in order to provide a U.S. claim correlating with the subject matter of PCT claim 37 (which referred to PCT claims 16-18 now subparts (a)-(c)).

Attention is respectfully invited to the Request for Participation in the PCT-PPH Pilot Program document filed August 12, 2011.

It is respectfully submitted that the U.S. claims sufficiently correspond with the PCT claims (Article 34).

4. The International Search Report ("ISR") is of record. See Submission regarding Information Disclosure Statement, with enclosures, filed with the application herein.

5. The ISR cited these patent documents:

JP 2005-531322A,

JP 2006-055106A,

JP 2006-034118A,

JP 2006-136281A, and

WO 2006/54448A1.

These patent documents are of record herein. See Submission regarding Information Disclosure Statement, with enclosures, filed with the application herein.

6. The ISR cited one non-patent literature document:

Mori et al., Effects of Heparin and its 6-O and its 2-O-desulfated derivatives with low anticoagulant activity on proliferation of human neural stem/progenitor cells, J. Biosci. Bioeng. 2005, Jul. vpol. 100(1), pp. 54-61.

This non-patent literature is of record herein. See Submission regarding Information Disclosure Statement, with enclosures, filed with the application herein.

7. The International Preliminary Report on Patentability is of record. Attention is invited to the July 8, 2010 Information Disclosure Statement. It was initially filed in Japanese and the July 8, 2010 IDS provided the WIPO English language translation. It is noted that the translation was also provided with application when initially filed. This is confirmed by PAIR.

6. The International Preliminary Report on Patentability cited the following documents:

- Document 1: JP 2005-531322 A (Instituto Cientifico y Tecnologico de Navarra, S.A.), 20 October 2005 & WO 2004/005494 A1 & US 2006/0110368 A1 & EP 1972684 A1
- Document 2: JP 2006-055106 A (National Institute of Advanced Industrial Science and Technology), 02 March 2006 & WO 2006/022091 A1
- Document 3: JP 2006-034118 A (Kaneka Corp.), 09 February 2006, (Family: none)
- Document 4: JP 2006-136281 A (Olympus Corp.), 01 June 2006, (Family: none)
- Document 5: MORI, H. et al., Effects of heparin and its 6-O-and 2-O-desulfated derivatives with low anticoagulant activity on proliferation of human neural stem/progenitor cells. J Biosci Bioeng. 2005 Jul, vol. 100 (1), pages 54-61

**Conclusion**

Applicants request favorable action and such notice is courteously solicited.

If there are any questions, the Petitions Examiner is encouraged to telephone the undersigned.

To the extent necessary, Applicant hereby requests any required extension of time not otherwise requested and hereby authorizes the Commissioner to charge any required fees not otherwise authorized, including application processing, extension, and extra claims fees, to Deposit Account 06-1135, regarding our order number 8867/98078.

Respectfully submitted,

**FITCH, EVEN, TABIN & FLANNERY**

\_\_\_\_/Kendrew H. Colton/\_\_\_\_\_  
Kendrew H. Colton, Reg. No. 30,368

Please send official correspondence to:  
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**FITCH, EVEN, TABIN & FLANNERY  
P.O. BOX 18415  
WASHINGTON DC 20036**

**MAILED**

**MAR 15 2012**

**OFFICE OF PETITIONS**

**In re Application of  
HONMOU, et al  
Application No.: 12/677,610  
Filed: June 7, 2010  
Attorney Docket No.: 8867-98078  
For: CELL GROWTH METHOD AND  
PHARMACEUTICAL PREPARATION  
FOR TISSUE REPAIR AND  
REGENERATION**

**: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)**

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed on August 12, 2011, and renewed on February 29, 2012, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must have an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, Australia, Austria, KIPO, NPI, Russia, Spain, Sweden, Finland, China, or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);

(5) Examination of the U.S. application has not begun;

(6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate if the latest international work product is not in the English language;

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

(8) Applicant is required to submit a claims correspondence table in English which indicates how all the claims in the U.S. application correspond to the claims indicated as having novelty, inventive step and industrial applicability in the latest international work product.

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

This application is being referred to the examiner for action on the merits commensurate with this decision.

/Diane Goodwyn/  
Diane Goodwyn  
Petitions Examiner  
Office of Petitions



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Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450

**KENYON & KENYON LLP  
1500 K STREET N.W.  
SUITE 700  
WASHINGTON DC 20005**

**MAILED  
APR 18 2012  
OFFICE OF PETITIONS**

In re Application of	: DECISION ON REQUEST TO
Shuchi EZAKI et al.	: PARTICIPATE IN PPH PROGRAM
Application No. 12/677,622	: AND PETITION TO MAKE SPECIAL
Filed: March 11, 2010	: UNDER 37 CFR 1.102(a)
Atty. Docket No.: 12916/18	:
For: VALVE OPERATING APPARATUS FOR INTERNAL COMBUSTION ENGINE	

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed January 26, 2012 to make the above-identified application special.

The petition and request are **GRANTED**.

A grantable request to participate in the PPH (patent prosecution highway) program and petition to make special require:

1. The U.S. application is a Paris convention application that either validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more application filed in the JPO or to a PCT application that contains no priority claims, or is a national stage application under the PCT that either validly claims priority to an application filed in the JPO or to a PCT application that contains no priority claims, or that contains no priority claim, or is a bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application that validly claims priority to an application filed in the JPO, to a PCT application that contains no priority claims, or contain no priority claim;
2. Applicant must ensure all the claims in the U.S. application sufficiently correspond or amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application and submit a claim correspondence table in English;
3. Examination of the U.S. application has not begun;

4. Applicant must submit a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claim(s), or if the allowable/patentable claim(s) are from a "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal, or if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form, and an English language translation of the JPO Office action if submitted; and

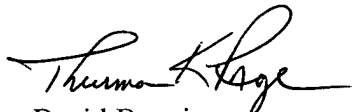
5. Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action, unless already submitted in this application, and copies of the documents except U.S. patents or U.S. patent application publications, unless already submitted in this application.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Robert DeWitty, Petition Attorney, Office of Petitions at 571-272-8427.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

This application will be forwarded to Technology Center Art Unit 3748 for action commensurate with this decision.

A handwritten signature in black ink, appearing to read "David Bucci", with a stylized flourish at the end.

David Bucci  
Petitions Examiner  
Office of Petitions

10 SEP 2010



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Washington, D.C. 20231  
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Perry & Currier Inc.  
1300 Yonge Street  
Suite 500  
Toronto ON M4T1X3

In re Application of	:	
WONG, et al.	:	DECISION ON PETITION
Serial No.: 12/677,637	:	
PCT No.: PCT/CA2007/001604	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 13 September 2007	:	
Priority Date: None	:	
Atty Docket No.: P1975US00	:	
For: BILLING PROFILE MANAGER	:	

This decision is in response to applicant's petition under 37 CFR 1.47(a) filed 09 July 2010 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 13 September 2007, applicant filed international application PCT/CA2007/001604. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 13 March 2010.

On 11 March 2010, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, among other items, payment of the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 12 May 2010, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 09 July 2010, applicant filed the present petition under 37 CFR 1.47(a). Applicant is advised that in situations like the present where at least one of the inventors has signed an oath or declaration but one or more of the remaining inventors has not the proper course is a petition under 37 CFR 1.47(a). The present petition has thus been considered pursuant to that regulation. Further, the USPTO is not able to charge fees to an applicant's credit card which are not specifically identified by the applicant. As such, the \$200.00 petition fee will be charged to deposit account number 50-3750.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1 and 3.

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature."

In the present case, it is clear that attempts were made to present the inventors in question with a complete set of application papers. However, it is not possible at this time to construe the inventor's subsequent silence as a refusal as no signature was required for receipt of the Federal Express parcels. The affidavit of Mr. T. Andrew Currier does state that voice mail messages were left at numbers presumably to be those of the inventors however, it does not specifically provide a confirmation that the outgoing messages on the answering machines were those of the inventors. Applicant should confirm the above in any request for reconsideration.

Regarding item (4), the declaration as filed does not comply with 37 CFR 1.497.

The Manual of Patent Examining Procedure (MPEP) Section 201.03 explains:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

The declaration filed 09 July 2010 contains three supplemental sheets "1 of 1." Thus, it appears that the inventors were not provided with complete declarations for signature or only returned the signature pages. Either scenario renders the documents non-compliant.

In light of the above, it is not possible to grant applicant's petition at this time.

### CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration or electronically filed utilizing the USPTO's EFS-Web electronic filing system.

A handwritten signature in black ink, appearing to read 'D. Putonen', is written over the printed name and title.

Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: 571-272-3294



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1300 Yonge Street  
Suite 500  
Toronto ON M4T1X3

**MAILED**

**DEC 15 2010**

**PCT LEGAL ADMINISTRATION**

In re Application of	:	
WONG, et al.	:	DECISION ON PETITION
Serial No.: 12/677,637	:	
PCT No.: PCT/CA2007/001604	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 13 September 2007	:	
Priority Date: None	:	
Atty Docket No.: P1975US00	:	
For: BILLING PROFILE MANAGER	:	

This decision is in response to applicant's renewed petition under 37 CFR 1.47 filed 08 November 2010 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 10 September 2010, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(a). Applicant was afforded two months to file any request for reconsideration and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 08 November 2010, applicant filed the present renewed petition.

**DISCUSSION**

As detailed in the decision mailed 10 September 2010, a petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant previously satisfied items 1 and 3.

With the filing of the renewed petition and accompanying documentation applicant has satisfied the two additional items and it is proper to grant applicant's renewed petition at this time.

**CONCLUSION**

For the reasons above, applicant's renewed petition under 37 CFR 1.47(a) and request for status under 37 CFR 1.42 are **GRANTED**.

Application No.: 12/677,637

2

The application has an international filing date of 13 September 2007 under 35 U.S.C. 363, and will be given a date of **08 November 2010** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(c), a notice of the filing of this application will be forwarded to the non-signing inventors at their last known addresses of record. A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the DO/EO/US for processing in accordance with this decision.

A handwritten signature in black ink, appearing to read 'D. Putonen', is positioned above the printed name and title.

Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: 571-272-3294



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P.O. Box 1450  
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[www.uspto.gov](http://www.uspto.gov)

Mr. Vincent Chi Chiu Wong  
6468 Rallymaster Heights  
Mississauga, Ontario  
L5W 1P9  
CANADA

MAILED

DEC 15 2010

PCT LEGAL ADMINISTRATION

In re Application of  
WONG, et al.  
Serial No.: 12/677,637  
PCT No.: PCT/CA2007/001604  
Int. Filing Date: 13 September 2007  
Priority Date: None  
Atty Docket No.: P1975US00  
For: BILLING PROFILE MANAGER

Dear Mr. Wong:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor. As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternately, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, the law firm of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294

Counsel of Record:  
Perry & Currier Inc.  
1300 Yonge Street  
Suite 500  
Toronto ON M4T1X3



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**NOV 08 2011**

**OFFICE OF PETITIONS**

GARDNER GROFF GREENWALD & VILLANUEVA PC  
2018 POWERS FERRY ROAD, SUITE 800  
ATLANTA, GA 30339

In re Application of :  
Jose Maria Cid-Nunez et al :  
Application No. 12/677,691 : **DECISION ON PETITION**  
Filed: June 3, 2010 :  
Attorney Docket No. 24F01.1-230 :

This is a decision on the petition, filed October 19, 2011, which is being treated under 37 CFR 1.8(c), requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to timely respond to the Office action of January 19, 2011, which set a shortened statutory period three (3) month period for reply. No extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, a reply was due on or before April 19, 2011.

Petitioner states that a timely reply was submitted via electronic transmission via EFS-Web on April 19, 2011, which includes the amendment and response to Office action. Petitioner has submitted a copy of the previously submitted correspondence, which bears a certificate of electronic transmission via EFS-Web dated April 19, 2011.

The file record does not include the originally submitted papers. Failure to receive correspondence which includes a certificate of electronic transmission is addressed in 37 CFR 1.8(c).

The petition satisfies the above requirement(s) of 37 CFR 1.8(c). Accordingly, the holding of abandonment for failure to timely file a reply to the Office action of January 19, 2011 is hereby withdrawn and the application restored to pending status.

Telephone inquiries related to this communication should be directed to Irvin Dingle at (571) 272-3210. This matter is being referred to Technology Center AU 1625 for appropriate action in the normal course of business on the reply received with this petition.

Irvin Dingle  
Petitions Examiner  
Office of Petitions



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ALEXANDRIA, VA 22313-1450  
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SHELL OIL COMPANY  
P O BOX 2463  
HOUSTON, TX 77252-2463

**MAILED**  
**JUN 06 2011**  
PCT LEGAL ADMINISTRATION

In re Application of SMITH et al :  
U.S. Application No.: 12/677,708 :  
PCT Application No.: PCT/EP2008/062113 :  
Int. Filing Date: 12 September 2008 : **DECISION**  
Priority Date Claimed: 13 September 2007 :  
Attorney Docket No.: TS6892(US) :  
For: MOBILE UNIT FOR THE CONSTRUCTION :  
OF ELONGATED TUBULAR BODIES :

This is in response to applicant's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 01 April 2011.

**BACKGROUND**

On 12 September 2008, applicant filed international application PCT/EP2008/062113, which claimed priority of an earlier European Patent Office application filed 13 September 2007. A copy of the international application was communicated to the USPTO from the International Bureau on 19 March 2009. The thirty-month period for paying the basic national fee in the United States expired on 15 March 2010.

On 11 March 2011, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 04 May 2010, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 05 July 2010, international application PCT/EP2008/062113 became abandoned as to the United States for failure to timely respond to the Notification of Missing Requirements.

On 01 April 2011, applicant filed the present petition under 37 CFR 1.137(b).

### DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 12 September 2008, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 01 April 2011.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

  
Bryan Lin  
PCT Legal Examiner  
PCT Legal Office

Telephone: 571-272-3303  
Facsimile: 571-273-0459



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SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON DC 20037

**MAILED**  
**FEB 28 2012**  
**OFFICE OF PETITIONS**

In re Application of :  
Goncalves Jota et al. :  
Application No. 12/677,768 : **ON PETITION**  
Filed: 01/07/2011 :  
Attorney Docket No. Q117992 :

This is in response to the PETITION FOR ACCEPTANCE OF COLOR DRAWINGS UNDER 37 C.F.R. § 1.84, filed in the United States Patent and Trademark Office (USPTO) on March 11, 2010, which is treated as a petition under 37 CFR 1.84(a)(2).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled, "Renewed Petition under 37 CFR 1.84(a)(2)". No further petition fee is required for a renewed petition.

37 CFR 1.84(a)(2) states that the Office will accept color drawings only after granting a petition explaining why color drawings are necessary. The petition must include:

- (i) The fee set forth in 1.17(h);
- (ii) Three (3) sets of color drawings;<sup>1</sup>
- (iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

<sup>1</sup> The requirement for three (3) sets of color drawings is not applicable to color drawings submitted via EFS-Web. Therefore, only one set of color drawings is necessary when filing via EFS-Web. See MPEP 502.05(VIII)(C).

The petition is not accompanied by an amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings.

In addition, MPEP 608.02 states that a petition to accept color drawings will only be granted where the Office "has determined that a color drawings or photograph is the only practical medium by which to disclose in a printed utility patent the subject matter to be patented."

The Office has determined, however, that color drawings or photographs are not the only practical medium by which to disclose in a printed utility patent the subject matter to be patented. MPEP 608.02, Section IX, DRAWINGS SYMBOLS provide graphic symbols that should be used to indicate various materials where the material is an important feature of the invention.

As such, color drawings or photographs are not necessary for an understanding of the invention sought to be patented. The petition is therefore dismissed.

Further correspondence with respect to this matter should be addressed as follows:

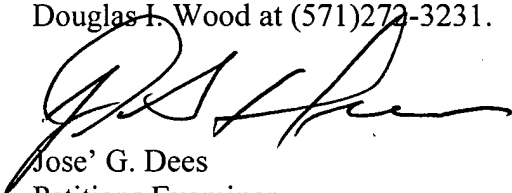
By mail:                      Mail Stop Petitions  
                                    Commissioner for Patents  
                                    PO Box 1450  
                                    Alexandria VA 22313-1450

By FAX:                      571-273-8300  
                                    Attn: Office of Petitions

A reply may also be filed via EFS-Web.

The application is being forwarded to Group Art Unit 2857.

Telephone inquiries regarding this decision should be directed to Senior Petitions Attorney Douglas L. Wood at (571)272-3231.



Jose' G. Dees  
Petitions Examiner  
Office of Petitions

24 AUG 2010



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WINSTEAD PC  
P.O. BOX 50784  
DALLAS TX 75201

In re Application of :  
BEVEC, Dorian, et al. :  
Application No.: 12/677,780 :  
PCT No.: PCT/EP2008/008036 :  
Int. Filing Date: 09 September 2008 :  
Priority Date: 11 September 2007 :  
Attorney Docket No.: 47012-P266WOUS :  
For: USE OF BETA-MELANOTROPIN AS :  
A THERAPEUTIC AGENT, EG FOR :  
THE TREATMENT OF AIDS OR :  
ALZHEIMER :

DECISION

This decision is in response to applicants' petition under 37 CFR 1.182, filed in the United States Patent and Trademark Office on 22 June 2010.

**BACKGROUND**

On 17 June 2010, the Office mailed Notification, indicating that applicants had supplied conflicting national phase information for this application.

On 22 June 2010, applicants filed this petition under 37 CFR 1.182 and indicated that the application was a national phase entry of PCT/EP2008/008036.

**DISCUSSION**

Applicant indicates that this application was intended to be the national phase of PCT/EP2008/008036. Applicant has paid the required petition fee. The indications in this application will be corrected to indicate that this is a national phase of PCT/EP2008/008036.

**CONCLUSION**

For the reasons discussed above, applicant's petition under 37 CFR 1.182 is **GRANTED**.

Application No. 12/677,780

-2-

This application is being returned to the National Stage Processing Branch of the Office of Patent Application Processing for further action consistent with this decision.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292



UNITED STATES PATENT AND TRADEMARK OFFICE

**MAILED**

DEC 20 2010

PCT LEGAL ADMINISTRATION

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Alexandria, VA 22313-1450  
www.uspto.gov

JONES DAY  
222 EAST 41<sup>ST</sup> ST  
NEW YORK NY 10017

In re Application of	:	
LI et al.	:	DECISION
Application No.: 12/677,789	:	
PCT No.: PCT/US2008/010615	:	
Int. Filing Date: 11 September 2008	:	
Priority Date: 11 September 2007	:	
Attorney's Docket No.: 11267-008-999	:	
For: CYANOAMINOQUINOLONES AND	:	
TETRAZOLOAMINOQUINOLONES AS	:	
GSK-3 INHIBITORS	:	

This decision is in response to applicants' submission filed 03 September 2010, which has properly been treated as a petition under 37 CFR 1.181.

### **BACKGROUND**

On 11 September 2008, applicants filed international application PCT/US2008/010615 which designated the U.S. and claimed a priority date of 11 September 2007. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 19 March 2009. The thirty-month period for paying the basic national fee in the United States expired at midnight on 11 March 2010.

On 11 March 2010, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee.

On 12 April 2010, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that a declaration of inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 05 August 2010, applicants filed, *inter alia*, a declaration of inventors.

On 18 August 2010, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating, *inter alia*, that the declaration filed 05 August

2010 was not in compliance with 37 CFR 1.497(a)-(b) because there is a difference in names of the second inventor between the declaration of inventors (Anna Katrin SZARDENINGS) and the published international application (Katrin SZARDENINGS).

On 03 September 2010, applicants filed the instant submission, which has properly been treated as a petition under 37 CFR 1.181.

### DISCUSSION

As noted in the NOTIFICATION OF DEFECTIVE RESPONSE mailed 18 August 2010, there is a difference in names of the second inventor between the declaration of inventors (Anna Katrin SZARDENINGS) and the published international application (Katrin SZARDENINGS). Because this difference in names would be more than a mere typographical error, a transliteration error, or a phonetic misspelling of applicant's legal name, a proper petition under 37 CFR 1.182 would be required in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of \$400 as well as a statement from the inventor.

The petition states that the name on the published international application was incorrectly listed. However, a review of the international application reveals that the second inventor was only identified as Katrin SZARDENINGS in the international application. A petition under 37 CFR 1.182 is required even if the inventor's first name (Anna) was inadvertently omitted during the international phase.

### CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

Applicant is hereby given the time limit of **TWO (2) MONTHS** from the mail date of this communication in order to file a proper response. Extensions of time may be obtained under 37 CFR 1.136(a).

**Failure to timely file a proper response to this decision in a timely manner will result in abandonment of the application with regards to national stage prosecution in the United States.**

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT

Application No.: 12/677,789

-3-

Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301



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MAR 28 2011

PCT LEGAL ADMINISTRATION

JONES DAY  
222 EAST 41<sup>ST</sup> ST  
NEW YORK NY 10017

In re Application of	:	
LI et al.	:	DECISION
Application No.: 12/677,789	:	
PCT No.: PCT/US2008/010615	:	
Int. Filing Date: 11 September 2008	:	
Priority Date: 11 September 2007	:	
Attorney's Docket No.: 11267-008-999	:	
For: CYANOAMINOQUINOLONES AND	:	
TETRAZOLOAMINOQUINOLONES AS	:	
GSK-3 INHIBITORS	:	

This decision is in response to applicants' petition under 37 CFR 1.182 filed 18 March 2011.

**BACKGROUND**

On 11 September 2008, applicants filed international application PCT/US2008/010615 which designated the U.S. and claimed a priority date of 11 September 2007. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 19 March 2009. The thirty-month period for paying the basic national fee in the United States expired at midnight on 11 March 2010.

On 11 March 2010, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee.

On 12 April 2010, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that a declaration of inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 05 August 2010, applicants filed, *inter alia*, a declaration of inventors.

On 18 August 2010, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating, *inter alia*, that the declaration filed 05 August 2010 was not in compliance with 37 CFR 1.497(a)-(b) because there is a difference in names of

the second inventor between the declaration of inventors (Anna Katrin SZARDENINGS) and the published international application (Katrin SZARDENINGS).

On 03 September 2010, applicants filed a submission including an explanation of the difference in names in the name of the second inventor which was properly treated as a petition under 37 CFR 1.181.

On 20 December 2010, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.181. The decision also indicated that the difference in names was more than a mere typographical error, a transliteration error, or a phonetic misspelling of applicant's legal name, and that a proper petition under 37 CFR 1.182 would be required in order to resolve the matter.

On 18 March 2011, applicants filed the instant petition under 37 CFR 1.182.

#### **DISCUSSION**

The petition fee has been paid. The statement by Anna Katrin SZARDENINGS explains that her name as set forth in the declaration of inventors filed 05 August 2010 is her correct name and that she is an inventor of international application number PCT/US2008/010615. The inventor's name will be recorded as Anna Katrin SZARDENINGS in the instant application.

The declaration of inventors filed 05 August 2010 is in compliance with 37 CFR 1.497(a)-(b).

#### **CONCLUSION**

The petition under 37 CFR 1.182 is **GRANTED** for the reasons set forth above.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application in accordance with this decision including processing the application in the name of Bei LI and Anna Katrin SZARDENINGS as inventors.

/Daniel Stemmer/  
Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301



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FEB 10 2011

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PALO ALTO CA 94304

PCT LEGAL ADMINISTRATION

In re Application of	:	
LI, Ronald, et al.	:	
Application No.: 12/677,790	:	
PCT No.: PCT/US2008/076084	:	CORRECTED DECISION
Int. Filing Date: 11 September 2008	:	
Priority Date: 12 September 2007	:	ON PETITION UNDER
Docket No.: 060933-1001	:	
For: COMPOSITIONS AND METHODS	:	37 CFR 1.47(a)
FOR IMPROVING THE FUNCTIONAL	:	
EFFICACY OF STEM CELL-DERIVED	:	
CARDIOMYOCYTES	:	

This is a decision correcting the 04 February 2011. That decision incorrectly listed the application number as 12/667,790, rather than 12/677,790.

**BACKGROUND**

On 28 April 2010, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors was required.

On 29 November 2010, applicants filed a petition under 37 CFR 1.47(a).

On 04 February 2011, the Office mailed Decision On Petition containing a typographical error in the application number listed in the header.

**DISCUSSION**

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1) and (4) have been met. The petition fee has been paid. The declaration complies with 37 CFR 1.497(a)-(b) and 1.47.

Item (2) has not been satisfied. Applicants have demonstrated actual receipt of a complete copy of the application papers, including the declaration by the inventor. Applicants have not sent a complete copy of the application papers to his last known address. Applicants

have not detailed efforts to locate a current residential address for the inventor nor have you attempted to call the inventor. Documentary evidence of the attempts to locate should be provided.

Item (3) has not been satisfied. The last known address provided for the inventor does not appear to be a residential address. MPEP 605.03.

### **CONCLUSION**

For the above reasons, applicant's petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

To the extent that the 04 February 2011 decision listed an incorrect application number it is **VACATED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Extensions of time under 37 CFR 1.136(a) are available. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292



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JUN 01 2011

FOLEY & LARDNER LLP  
975 PAGE MILL ROAD  
PALO ALTO CA 94304

PCT LEGAL ADMINISTRATION

In re Application of

LI, Ronald, et al.

Application No.: 12/677,790

PCT No.: PCT/US2008/076084

Int. Filing Date: 11 September 2008

Priority Date: 12 September 2007

Docket No.: 060933-1001

For: COMPOSITIONS AND METHODS

FOR IMPROVING THE FUNCTIONAL

EFFICACY OF STEM CELL-DERIVED

CARDIOMYOCYTES

DECISION

ON PETITION UNDER

37 CFR 1.47(a)

This decision responds to applicants' renewed petition under 37 CFR 1.47(a), filed with the United States Patent and Trademark Office on 24 March 2011.

**BACKGROUND**

On 10 February 2011, the Office mailed Decision On Petition dismissing applicants' petition without prejudice.

On 24 March 2011, applicants filed a renewed petition under 37 CFR 1.47(a).

**DISCUSSION**

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1), (3) and (4) have been met. The petition fee has been paid. Applicants state the last known residential address of the non-signing inventor. The declaration complies with 37 CFR 1.497(a)-(b) and 1.47.

Item (2) has not been satisfied. Applicants successfully delivered a complete copy of the application papers to the inventor on 07 March 2011, but only gave him until 10 March 2011 to respond. This petition was filed on 24 March 2011. A reasonable time period for response is considered one month. It is not clear why they package from applicants was refused or by whom it was refused. A followup statement indicating that a signed declaration has still not been received is appropriate.

**CONCLUSION**

For the above reasons, applicant's petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Extensions of time under 37 CFR 1.136(a) are available. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292



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SEP 22 2011

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PALO ALTO CA 94304

PCT LEGAL ADMINISTRATION

In re Application of  
LI, Ronald, et al.  
Application No.: 12/677,790  
PCT No.: PCT/US2008/076084  
Int. Filing Date: 11 September 2008  
Priority Date: 12 September 2007  
Docket No.: 060933-1001  
For: COMPOSITIONS AND METHODS  
FOR IMPROVING THE FUNCTIONAL  
EFFICACY OF STEM CELL-DERIVED  
CARDIOMYOCYTES

DECISION

ON PETITION UNDER

37 CFR 1.47(a)

This decision responds to applicants' renewed petition under 37 CFR 1.47(a), filed with the United States Patent and Trademark Office on 27 July 2011.

**BACKGROUND**

On 01 June 2011, the Office mailed Decision On Petition dismissing applicants' petition without prejudice.

On 27 July 2011, applicants filed a renewed petition under 37 CFR 1.47(a).

**DISCUSSION**

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1), (3) and (4) were previously satisfied. Item (2) has now been satisfied.

**CONCLUSION**

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including accordation of a 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) date of **29 November 2010**.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292



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SEP 22 2011

PCT LEGAL ADMINISTRATION

Chung-wah Siu  
Flat D, G/F, Block 3, Windsor Villa  
33 Sha Tseng Road  
Tong Yan Sun Tsuen, Yuen Long, NT  
Hong Kong, SAR

In re Application of  
LI, Ronald, et al.  
Application No.: 12/677,790  
PCT No.: PCT/US2008/076084  
Int. Filing Date: 11 September 2008  
Priority Date: 12 September 2007  
Docket No.: 060933-1001  
For: COMPOSITIONS AND METHODS FOR IMPROVING THE FUNCTIONAL  
EFFICACY OF STEM CELL-DERIVED CARDIOMYOCYTES

Dear Mr. Siu:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. The counsel for the applicant is listed below. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292

FOLEY & LARDNER LLP  
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PALO ALTO CA 94304



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DEC 07 2010

PCT LEGAL ADMINISTRATION

Motorola, Inc.  
Patent Operations Law Department  
600 North US Highway 45  
IL93-W2-55BB  
Libertyville IL 60048-5343

In re Application of PRASAD  
Application No.: 12/677,833  
PCT No.: PCT/US08/75771  
Int. Filing Date: 10 September 2008  
Priority Date: 13 September 2007  
Attorney Docket No.: CML05253CHA  
For: METHOD AND SYSTEM FOR PRESENTING  
ADVERTISEMENTS

:  
: DECISION ON PETITION  
:  
: UNDER 37 CFR 1.182  
:  
:  
:

This is a decision on applicant's petition under 37 CFR 1.182 in above referenced application filed in the United States Patent and Trademark Office on 04 October 2010.

**BACKGROUND**

On 12 March 2010, applicant filed a transmittal letter concerning a filing under 35 U.S.C. 371 accompanied by the basic national fee along with an executed declaration. The published international application identified the sole inventor as KRISHNA PRASAD. The declaration identified the sole inventor as KRISHNA PRASAD PANJE and was executed as such.

On 19 July 2010, a decision on the submission was mailed to applicant indicating that the declaration was not acceptable.

On 04 October 2010, applicant filed the instant petition under 37 CFR 1.182.

**DISCUSSION**

A review of the application file reveals that the given name of the applicant as listed on the published international application is "KRISHNA PRASAD." The declaration, filed on 12 March 2010 is signed by "KRISHAN PRASAD PANJE". The executed declaration is not in compliance with 37 CFR 1.497(a) and (b) as the declaration does not name the inventive entity identified in the published international application.

Petitioner acknowledges that applicant did not file a request under PCT Rule 92bis to change the name of the inventor. Applicant now files a petition under 37 CFR 1.182 to change the inventor's family name to PANJE. Applicants' present petition included payment of the required petition fee. However, the response does not include the required statement *from the inventor* confirming his/her correct name and indicating that the listing of KRISHNA PRASAD on the international application PCT/US08/75771 occurred without deceptive intent. Such statement(s) must confirm the correct name of the inventor, explain how the discrepancy in the inventor's name occurred, and state that the discrepancy occurred without deceptive intent. Accordingly, on the present record, correction of the name of the inventor from KRISHNA PRASAD to KRISHNA PRASAD PANJE is not appropriate. The declaration filed 12 March 2010 therefore remains defective for failure to properly identify the inventor of record herein. See MPEP §605.04(c).

The petition under 37 CFR 1.182 to change the respective inventor's name to is DISMISSED without prejudice.

### **CONCLUSION**

For the reasons set forth above, the petition under 37 CFR 1.182 is **DISMISSED without prejudice.** The declaration of inventor submitted by applicant on 12 March 2010 is not in compliance with 37 CFR 1.497(a) and (b) and is unacceptable.

Any request for reconsideration on the merits must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any such response must include the statement required for a grantable petition under 37 CFR 1.182 regarding the change of the inventor's name. Failure to file a proper response in a timely manner will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Cynthia M. Kratz/  
Cynthia M. Kratz  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Motorola Mobility, Inc  
600 North US Highway 45  
W2-55BB  
Libertyville IL 60048-5343

In re Application of PRASAD  
Application No.: 12/677,833  
PCT No.: PCT/US08/75771  
Int. Filing Date: 10 September 2008  
Priority Date: 13 September 2007  
Attorney Docket No.: CML05253CHA  
For: METHOD AND SYSTEM FOR PRESENTING  
ADVERTISEMENTS

:  
: DECISION ON PETITION  
:  
: UNDER 37 CFR 1.182  
:  
:  
:

This is a decision on applicant's petition under 37 CFR 1.182 in above referenced application filed in the United States Patent and Trademark Office on 31 January 2011.

**BACKGROUND**

On 12 March 2010, applicant filed a transmittal letter concerning a filing under 35 U.S.C. 371 accompanied by the basic national fee along with an executed declaration. The published international application identified the sole inventor as KRISHNA PRASAD. The declaration identified the sole inventor as KRISHNA PRASAD PANJE and was executed as such.<sup>1</sup>

On 19 July 2010, a decision on the submission was mailed to applicant indicating that the declaration was not acceptable.

On 04 October 2010, applicant filed the instant petition under 37 CFR 1.182. On 7 December 2010, a decision dismissing the petition was mailed, indicating that a statement from the inventor confirming the correction of his name was needed.

**DISCUSSION**

Applicant previously paid the required petition fee. The renewed petition under 37 CFR 1.182 to change the inventor's family name to PANJE is accompanied by the required statement from the inventor confirming his correct name KRISHNA PRASAD PANJE. The error in the published international application occurred inadvertently and without deceptive intent. Accordingly, the correction of the name of the inventor from KRISHNA PRASAD to KRISHNA PRASAD PANJE is GRANTED. The declaration filed 12 March 2010 is acceptable and noted for the record.

The petition under 37 CFR 1.182 to change the respective inventor's name to KRISHNA

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<sup>1</sup> A review of the application file reveals that the given name of the applicant as listed on the published international application is "KRISHNA PRASAD." The declaration, filed on 12 March 2010 is signed by "KRISHAN PRASAD PANJE". The executed declaration is not in compliance with 37 CFR 1.497(a) and (b) as the declaration does not name the inventive entity identified in the published international application.

Application No.: 12/677,833

2

PRASAD PANJE is **GRANTED.**

### **CONCLUSION**

Applicant's request under 37 CFR 1.182 to correct the Inventor's name to KRISHNA PRASAD PANJE is **GRANTED.**

The application will be forwarded to the U.S. Designated/Elected Office for further processing in accordance with this decision. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is 12 March 2010.

/Cynthia M. Kratz/  
Cynthia M. Kratz  
Attorney Advisor  
Office of PCT Legal Administration

Telephone: (571) 272-3286  
Facsimile: (571) 273-0459

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE EUROPEAN PATENT OFFICE (EPO) AND THE USPTO

Application No:	12/677,843	Filing date:	12-03-2010
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First Named Inventor:	Raymond George KIRBY
-----------------------	----------------------

Title of the Invention:	PRODUCT FEEDING APPARATUS
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**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBC/EF5\\_HELP.HTML](http://www.uspto.gov/EBC/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/GB2008/003133

**The international date of the corresponding PCT application(s) is/are:** 15 September 2008

## I. List of Required Documents:

- a. **A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**

☐

Is attached

☒

Is not attached because the document is already in the U.S. application.

- b. **A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**

☐

Is attached.

☒

Is not attached because the document is already in the U.S. application.

- c. **English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

- d. **(1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.**

☐

Is attached

☒

Has already been filed in the above-identified U.S. application on 12 March 2010

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)**

☐

Are attached.

☒

Have already been filed in the above-identified U.S. application on 12 March 2010

(continued)

Application No.:	12/677,843
First Named Inventor:	Raymond George KIRBY

[illegible]

#### IV. Payment of Fees:

Signature <b>/Barry A. Stein/</b>	Date <b>2010-09-30</b>
Name (Print/Typed) <b>Barry A. Stein</b>	Registration Number <b>25,257</b>

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant ( i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/677,843	09/30/2010	Raymond George Kirby	S1011/20257	3523
3000 7590 11/18/2010 CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD. 11TH FLOOR, SEVEN PENN CENTER 1635 MARKET STREET PHILADELPHIA, PA 19103-2212			EXAMINER RADA, RINALDI I	
			ART UNIT 3721	PAPER NUMBER
			NOTIFICATION DATE 11/18/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@crbcp.com



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Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

CAESAR, RIVISE, BERNSTEIN,  
COHEN & POKOTILOW, LTD.  
11TH FLOOR, SEVEN PENN CENTER  
1635 MARKET STREET  
PHILADELPHIA PA 19103-2212

In re Application of	:	
KIRBY, RAYMOND GEORGE et al	:	DECISION ON REQUEST TO
Application No. 12/677,843	:	PARTICIPATE IN PATENT
Filed: Sep. 30, 2010	:	PCT/PROSECUTION HIGHWAY
Attorney Docket No: S1011/20257	:	PROGRAM AND PETITION
For: PRODUCT FEEDING APPARATUS	:	37 CFR 1.102(d)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed Sep. 30, 2010 to make the above-identified application special.

The request and petition are GRANTED.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications filed in the JPO, EPO, KIPO or USPTO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the PCT application(s) latest international work product (the written opinion or the IPER) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the PCT application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of the latest international work product from the PCT application containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

In light of the petition being properly submitted, the request to participate in the PPH program and the petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application.

All other inquiries concerning the examination or status of the application should be directed to Rinaldi Rada, the SPE of Art Unit 3721, and (571)272-4467 for Class 53/246 and also accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

This application will be forwarded and docketed to an examiner for action on the merits commensurate with this decision.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen, at 571-272-4856.

The petition is **granted**.

/Henry C. Yuen/

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Henry C. Yuen, Special Programs Examiner  
Technology Center 3700 – Mechanical Engineering,  
Manufacturing and Products  
571-272-4856



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MAILED  
MAR 7 0 2011

OSTROLENK FABER GERB & SOFFEN  
1180 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-8403

PCT LEGAL ADMINISTRATION

In re Application of :  
BIAGGI, Jean-Pascal, et al. :  
Application No.: 12/677,870 :  
PCT No.: PCT/FR2008/051586 :  
Int. Filing Date: 05 September 2008 : DECISION  
Priority Date: 12 September 2007 :  
Attorney's Docket No.: P/4393-27 (V 14956) :  
For: INSTALLATION FOR TRANSFERRING :  
A FLUID BETWEEN A TANKER AND :  
A FIXED STRUCTURE :

This decision is in response to applicants' "Petition For Reconsideration of Refusal of Refund Request," filed in the United States Patent and Trademark Office on 07 January 2011.

**BACKGROUND**

On 12 March 2010, applicants filed a transmittal letter to the United States Designated/Elected Office, accompanied by the basic national fee, search fee, examination fee, a preliminary amendment and authorization to charge any additional required fees.

On 11 May 2010, applicants filed a declaration of the inventors.

On 24 August 2010, the Office mailed Notification of Acceptance (Form PCT/DO/EO/903) and filing receipt and charged excess claims fees in the amount of \$2210 effective 12 March 2010.

On 17 November 2010, applicants filed a Request for Refund, asserting there were no excess claims and requesting a refund of the \$2210.

On 02 December 2010, your request was denied. It indicated that as claim 12 states "according to any one of the preceding claims," it is a multiple dependent claim.

On 07 January 2011, applicants filed this petition requesting refund of the \$2210 in fees.

**DISCUSSION**

As set forth in MPEP 1893.01(c):

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that is effective to cancel claims and/or eliminate

multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492(d)-(e) and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492(f). A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. MPEP §607 and §608.

Applicants filed a preliminary amendment with the initial national phase filing. That amendment reduced the number of claims, but an additional \$2210 in claims fees were still required. The fees were owed, payment was authorized, and the fees were properly charged.

Applicants argue that their intent to remove the multiple dependency was stated in the remarks accompanying the preliminary amendment and that they have now filed a preliminary amendment to accomplish their original intent. As stated in the above quotation, a subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid.

#### **CONCLUSION**

For the above reasons, applicants' petition to refund the additional claim fees is **DISMISSED** without prejudice.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/677,889	03/12/2010	Shuhei Nakatani	P38117	3763

52123	7590	08/11/2010
GREENBLUM & BERNSTEIN, P.L.C.		
1950 ROLAND CLARKE PLACE		
RESTON, VA 20191		

EXAMINER	
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ART UNIT	PAPER NUMBER
2629	

NOTIFICATION DATE	DELIVERY MODE
08/11/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com



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P.O. Box 1450  
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GREENBLUM & BERNSTEIN, P.L.C.  
1950 ROLAND CLARKE PLACE  
RESTON VA 20191

In re Application of	:	
NAKATANI, SHUHEI et al.	:	DECISION ON REQUEST TO
Application No. 12/677,889	:	PARTICIPATE IN PATENT
Filed: March 12, 2010	:	PROSECUTION HIGHWAY
Attorney Docket No. P38117	:	PROGRAM AND PETITION
	:	TO MAKE SPECIAL UNDER
	:	37 CFR 1.102(d)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed May 19, 2010 to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
- (7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Doris To at 571-272-7629.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

/Doris To/

---

Doris To  
Quality Assurance Specialist  
Technology Center 2600  
Communications



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/677,900	03/12/2010	Masao Mori	144796	3858

25944 7590 11/08/2010  
OLIFF & BERRIDGE, PLC  
P.O. BOX 320850  
ALEXANDRIA, VA 22320-4850

EXAMINER	
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ART UNIT	PAPER NUMBER
1616	

NOTIFICATION DATE	DELIVERY MODE
11/08/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com  
jarmstrong@oliff.com



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OLIFF & BERRIDGE, PLC  
P.O. BOX 320850  
ALEXANDRIA VA 22320-4850

NOV 08 2010

In re Application of	:	
MORI, MASAO et. al.	:	DECISION ON REQUEST TO
Application No. 12/677,900	:	PARTICIPATE IN PCT-PATENT
Filed: March 12, 2010	:	PROSECUTION HIGHWAY PILOT
Attorney Docket No. 144796	:	PROGRAM AND PETITION
	:	TO MAKE SPECIAL UNDER
	:	37 CFR 1.102(d)

This is a decision on the request to participate in the PCT-Patent Prosecution Highway (PPH) Pilot program and the petition under 37 CFR 1.102(d), filed May 27, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT- PPH Pilot program and petition to make special require:

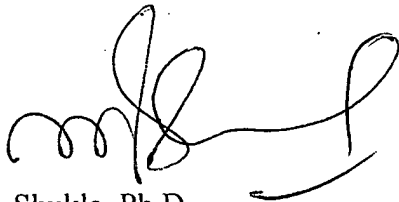
- (1) The U.S. application is a national stage entry of the corresponding JPO PCT application;
- (2) The latest work product in the international phase of the PCT application corresponding to the US application, namely the WO/ISA, or the WO/IPEA, or the IPER, indicates at least one claim in the PCT claim has novelty, inventive step and industrial applicability.
- (3) Applicant must submit a copy of the allowable/patentable claim(s) from the corresponding PCT application(s) along with an English translation thereof;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the PCT application;
- (5) Examination of the U.S. application has not begun;
- (6) Unless already filed in the U.S. application for which participation in the PCT-PPH pilot program is requested, applicant must submit a copy of the latest international work product, WO/ISA, or WO/IPEA or IPER, which indicated that the claim(s) has/have novelty, inventive step and industrial applicability along with an English translation thereof;
- (7) Applicant must submit an IDS listing the documents cited international work product, WO/ISA, or WO/IPEA or IPER along with copies of documents except U.S. patents or U.S. patent application publications; and

The request to participate in the PCT-PPH Pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Ram R. Shukla at 571-272-0735.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system at the <http://www.uspto.gov/ebc/index.html>.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

A handwritten signature in black ink, appearing to be 'R. Shukla', with a stylized, flowing script.

Ram R. Shukla, Ph.D.  
Supervisory Patent Examiner  
TC 1600

**RAM R. SHUKLA, PH.D.**  
**SUPERVISORY PATENT EXAMINER**

15 SEP 2010



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Alexandria, VA 22313-1450  
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23409  
MICHAEL BEST & FRIEDRICH LLP  
100 E. Wisconsin Avenue  
Suite 3300  
Milwaukee, WI 53202

In re Application of  
COUTTS *et al*  
U.S. Application No.: 12/677,925  
PCT No.: PCT/AU2008/001358  
Int. Filing Date: 12 September 2008  
Priority Date: 14 September 2007  
Attorney Docket No.: 074373-9004-US00  
For: COMMUNICATIONS DEVICE,  
SYSTEM AND METHOD

## DECISION

This decision is in response to the petition under 37 CFR 1.182 filed 22 July 2010.

## BACKGROUND

On 12 March 2010, applicants filed papers to enter the national stage of PCT/US2008/001358 using the USPTO EFS-Web system. The application was processed as the national stage of PCT/US2008/001358 by the USPTO as requested.

On 01 July 2010, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee must be provided. Applicants were given two months to respond with extensions of time available pursuant to 37 CFR 1.136(a).

On 22 July 2010, applicants filed a response to the Form PCT/DO/EO/905 which was accompanied by, *inter alia*, an executed declaration, a \$130.00 surcharge fee, and a petition under 37 CFR 1.182 to change the underlying PCT application in the above-identified national stage application to PCT/AU2008/001358.

On 11 August 2010, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 1.495 (Form PCT/DO/EO/903) and filing receipt. Both forms listed the PCT number as PCT/US2008/001358.

## DISCUSSION

Applicants petition to correct the PCT number to PCT/AU2008/001358. The \$400.00 petition fee has been paid.

A review of the above-captioned application file verifies that the wrong PCT number was designated when filing the application electronically using the USPTO EFS-Web system.

The PCT number was listed as PCT/US2008/001358 by applicants when filing electronically with the USPTO. However, all other indications on the transmittal letter including the name of the inventor, the title, and the international filing date correspond to PCT/AU2008/001358. WIPO records also indicate that the title, international filing date and inventors correspond to PCT/AU2008/001358. Moreover, applicants included an ADS listing the PCT number as PCT/AU2008/001358, along with a copy of the International Application and International Search Report for PCT/AU2008/001358.

Thus, it is clear that the subject application was intended to be filed as the national stage of PCT/AU2008/001358 but that a mistake was made on the international application number when filing electronically.

#### **CONCLUSION**

Applicants' petition under 37 CFR 1.182 is **GRANTED**.

USPTO records have been changed to reflect that the above-captioned application is the national stage of PCT/AU2008/001358.

The Form PCT/DO/EO/903 and filing receipt mailed 11 August 2010 are both **VACATED**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision.

  
James Thomson  
Attorney Advisor

Office of PCT Legal Administration

Tel.: (571) 272-3302



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FISH & RICHARDSON P.C. (NY)  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440-1022

**MAILED**

**NOV 15 2011**

**OFFICE OF PETITIONS**

In re Application of Bertolla et al. :  
Application No. 12/677,943 :  
Int'l Filing Date: October 6, 2008 :  
Attorney Docket No. 28216-0002US1 :  
Pub. No.: US 2011/0027877 A1 :  
Pub. Date: February 3, 2011 :

Decision on Request

This is a decision on the request for a corrected patent application publication under 37 C.F.R. § 1.221(b) filed February 28, 2011.

The request is **dismissed**.

Applicants request the application be republished because of the cover page of the patent application publication only identifies three of the four inventors.

37 C.F.R. § 1.221(b) states,

[Relief under 37 C.F.R. § 1.221 is warranted] only when the Office makes a material mistake which is apparent from Office records.... Any request for corrected publication or revised patent application publication other than provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable.

A mistake is only a "material" mistake if the mistake affects the public's ability to appreciate the technical disclosure of the patent application publication, determine the scope of the patent application publication, or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.<sup>1</sup>

The mistake identified in the instant request is not a material Office mistake as required under 37 C.F.R. § 1.221(b). Specifically, the omission of an inventor's name does not affect the public's ability to appreciate the technical disclosure of the patent application publication,

<sup>1</sup> See Changes to Implement Eighteen-Month Publication of Patent Applications; Final Rule, 65 Fed. Reg. 57023, 57038 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office 63, 75 (Oct. 10, 2000). See also Section 1130 of the Manual of Patent Examining Procedure (8th ed., Rev. 8, July 2010).

determine the scope of the patent application publication, or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. *See* MPEP § 1130(B). Therefore, relief under 37 C.F.R. § 1.221(b) is unwarranted and the request is dismissed.

Applicants are advised that a “request for republication of an application previously published” may be filed under 37 C.F.R. § 1.221(a). The request must include a copy of the application, which complies with the Office’s electronic filing system requirements set forth in 37 C.F.R. § 1.18(d), and the required processing fee set forth in 37 C.F.R. § 1.17(i).

If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in 37 C.F.R. § 1.18(d) will be refunded. However, the processing fee will be retained.

Guidance for filing a request for a Pre-Grant Publication, such as a request for republication, may be found at the links below:

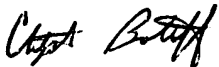
<http://www.uspto.gov/patents/process/file/efs/guidance/index.jsp>

[http://www.uspto.gov/ebc/portal/efs/pgpub\\_quickstart.pdf](http://www.uspto.gov/ebc/portal/efs/pgpub_quickstart.pdf)

Any request for republication under 37 C.F.R. § 1.221(a), must be submitted via the EFS system as a “Pre-Grant Publication” and questions or any request for reconsideration of the instant decision should be addressed as follows:

By mail to:     Mail Stop PGPUB  
                    Commissioner for Patents  
                    P.O. Box 1450  
                    Alexandria, Va. 22313-1450

Telephone inquiries regarding this communication should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Christopher Bottorff  
Petitions Examiner  
Office of Petitions



# UNITED STATES PATENT AND TRADEMARK OFFICE

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Address: COMMISSIONER FOR PATENTS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/677,955	07/22/2010	Masamichi Ippommatsu	REIM 1000-1	4261
22470 7590 10/26/2010 HAYNES BEFFEL & WOLFELD LLP P O BOX 366 HALF MOON BAY, CA 94019			EXAMINER GIONTA, ALLISON	
			ART UNIT 1777	PAPER NUMBER
			MAIL DATE 10/26/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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October 26, 2010

BC

In re application of	:	DECISION ON REQUEST TO
Masamichi Ippommatsu et.al.	:	PARTICIPATE IN PATENT
Serial No. 12/677,955	:	PROSECUTION HIGHWAY
Filed: March 12, 2010	:	PROGRAM AND
For: ADSORPTION COLUMN FOR	:	PETITION TO MAKE SPECIAL
PURIFYING BODY FLUID	:	UNDER 37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program filed September 22, 2010.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO, note where the JPO application with similar claims is not the same application from which the U.S. application claims priority that the applicant must identify the relationship between the JPO application with similar claims and the JPO priority application;

(2) Applicant must submit a copy of:

- a. The allowable/patentable claim(s) from the JPO application(s) or if a copy of the allowable/patentable claims is available via the Dossier Access System (DAS) applicant may request the USPTO to obtain a copy from DAS; however, if the USPTO is unable to obtain a copy from the DAS, the applicant will be required to submit a copy;
- b. An English translation of the allowable/ patentable claim(s), if applicable; and
- c. A statement that the English translation is accurate, if applicable;

(3) Applicant must:

- a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s); and
- b. Submit a claims correspondence table in English;

(4) Examination of the U.S. application has not begun;

(5) Applicant must submit:

- a. Documentation of prior office action:

- i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claims(s) or
- ii. if the allowable/patentable claim(s) are from "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
- iii. if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form; Further, if a copy of the documents from a or b is available via the Dossier Access System (DAS), applicant may request the USPO obtain a copy from the DAS; however, if the USPTO is unable to obtain a copy of the DAS, the applicant will be required to submit a copy;
- b. An English language translation of the JPO Office action from (5)(a)(i)-(ii) above if applicable; and
- c. A statement that the English translation is accurate; and

(6) Applicant must submit:

- a. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
- b. Copies of documents except U.S. patents or U.S. patent application publications (unless already submitted in this application).

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Blaine Copenheaver, Quality Assurance Specialist, at (571) 272-1156.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/eac/index.html>.

/Blaine Copenheaver/

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Blaine Copenheaver  
Quality Assurance Specialist  
Technology Center 1700



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P.O. BOX 9133  
CONCORD, MA 01742-9133

**MAILED**

**AUG 17 2011**

**OFFICE OF PETITIONS**

Applicant: Spoors, et al.  
Appl. No.: 12/678,003  
International Filing Date: September 17, 2008  
Title: PROCESS FOR THE PREPARATION OF RENIN INHIBITORS  
Attorney Docket No.: 3964.1024-003  
Pub. No.: US 2010/0256400 A1  
Pub. Date: October 7, 2010

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on November 29, 2010, for the above-identified application.

The request is dismissed.

Applicant requests that the application be republished because the patent application publication contains a material error in dependent claim 4 wherein  $\text{-CO}_2\text{H}$  is misprinted as  $\text{-CO/H}$ .

37 CFR 1.221 (b) is applicable: "only when the Office makes a **material mistake** which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable" A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.<sup>1</sup>

The instant request does not identify a material mistake in the publication made by the Office under 37 CFR 1.221(b). The typographical error in dependent claim 4, wherein " $\text{-CO}_2\text{H}$ " is misprinted as " $\text{-CO/H}$ " is a typographical error, which is clear to one of ordinary skill in the art. Additionally, the error is not a material Office error because the claim was correctly published in the PCT application as WO 2009/038719. The misprint does not affect the public's ability to appreciate the technical disclosure of the patent application publication, or determine the scope of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. The error also does not affect the use of the patent application publication as a prior art reference.

<sup>1</sup>Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

The applicant is advised that a “request for republication of an application previously published” may be filed under 37 CFR 1.221(a). Such a request for republication “must include a copy of the application compliance with the Office’s electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i).” If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

A guide for filing a request for a Pre-Grant Publication, such as a request for republication, may be found on the link below:

<http://www.uspto.gov/patents/process/file/efs/guidance/index.jsp>

[http://www.uspto.gov/ebc/portal/efs/pgpub\\_quickstart.pdf](http://www.uspto.gov/ebc/portal/efs/pgpub_quickstart.pdf)

Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system, as a “Pre-Grant Publication.”

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709.



Mark Polutta  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy



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**NOV 09 2011**

**PCT LEGAL ADMINISTRATION**

FISH & RICHARDSON P.C. (DA)  
P.O. BOX 1022  
MINNEAPOLIS MN 55440-1022

In re Application of	:	
JAIN, et al.	:	DECISION ON PETITION
U.S. Application No.: 12/678,047	:	
PCT No.: PCT/US2008/076316	:	UNDER 37 CFR 1.497(d)
Int. Filing Date: 12 September 2008	:	
Priority Date: 12 September 2007	:	
Atty Docket No.: 24310-0013US1	:	
For: WIRELESSLY ACCESSING BROADBAND	:	
SERVICES USING INTELLIGENT COVERS	:	

This decision is in response to applicant's petition to add an inventor under 37 CFR 1.497(d) filed 26 October 2011 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 12 September 2008, applicant filed international application PCT/US2008/076316 which claimed priority to a previous application filed 12 September 2007. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 12 March 2010.

On 12 March 2010, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by among other items, payment of the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 01 August 2011, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 27 September 2011, applicant responded with a signed declaration.

On 05 October 2011, applicant was mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) informing applicant that the field declaration was non-compliant as it listed an inventor not listed on the published international application. Applicant was afforded one month or the extendable time from the Form PCT/DO/EO/905 mailed 01 August 2011 to respond.

On 26 October 2011, applicant filed the petition under 37 CFR 1.497(d) discussed herein.

### DISCUSSION

A request under 37 CFR 1.497(d) [formally, 37 CFR 1.48] to correct an error in naming inventorship requires:

- (1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;
- (3) the fee set forth in 37 CFR 1.17(h); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

A review of the filed petition and accompanying documents finds that applicant has satisfied all four items detailed above and it is proper to grant applicant's petition at this time.

### CONCLUSION

For the reasons discussed above, the request under 37 CFR 1.497(d) is **GRANTED**.

A review of the application papers reveals that applicant has now completed all the requirements of 35 U.S.C. 371 for entry into the national stage.

This application has an international application filing date of 12 September 2008 and will be given a date of **27 September 2011** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294



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MAR 16 2011

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SUITE 2040  
MILWAUKEE WI 53202-4497

PCT LEGAL ADMINISTRATION

In re Application of: MURPHY, Peter  
U.S. Application No.: 12/678,064  
PCT No.: PCT/NZ2008/000242  
International Filing Date: 15 September 2008  
Priority Date: 14 September 2007  
Attorney's Docket No.: 550639.00012  
For: A BATH

DECISION  
(37 CFR 1.47(b))

This decision is issued in response to the "Petition Under 37 C.F.R. § 1.47(b)" filed on 06 January 2011. Petitioner has paid the required \$200 petition fee.

**BACKGROUND**

On 15 September 2008, applicant filed international application PCT/NZ2008/000242. The application claimed a priority date of 14 September 2007, and it designated the United States. On 19 March 2009, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 14 March 2010.

On 12 March 2010, materials requesting entry into the national stage in the United States were filed in the USPTO including, among other materials, payment of the basic national fee.

On 08 July 2010, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 06 January 2011, petitioner filed the "Petition Under 37 C.F.R. § 1.47(b)" considered herein (with required extension fee). The petition requests acceptance of the application without the signature of the inventor of record, whom petitioner asserts has refused to execute the application.

**DISCUSSION**

A grantable petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be

reached after diligent effort; (3) a statement of the last known addresses of the non-signing inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; (5) proof of proprietary interest in the application; and (6) a showing that the petition is necessary to preserve the rights of the parties or to prevent irreparable damages.

Regarding item (1), petitioner has submitted payment of the required \$200 petition fee. Item (1) is therefore satisfied.

Regarding item (2), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute the application papers, "[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." nonsigning inventor's attorney." The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.

Here, petitioner has provided the statement of Gregory James West-Walker, with accompanying documents, setting forth the efforts made to obtain the signature of the non-signing inventor. Specifically, the statement indicates that a request for signature was forwarded to the non-signing inventor by email, that the inventor responded to this email (confirming that it was the correct email address, but not providing the signed declaration), that a follow-up email clarifying the signature request was sent to the inventor by email, and that the inventor did not respond to this email or to subsequent emails directed to the same email address. However, the record does not provide a showing that a request for signature accompanied by a copy of the complete application was provided to the inventor, as required before it can be concluded that the inventor has refused to execute the present application (the petition indicates that a copy of the declaration, not the complete application, was included with the signature request provided to the inventor). Petitioner must provide supplemental materials demonstrating that a request for signature on the declaration, accompanied by a copy of the complete application (description, claims, and drawings) has been provided to the non-signing inventor and that the inventor has refused to provide the requested declaration in response to such request. Based on the above, item (2) of a grantable petition is not satisfied on the present record.

Regarding item (3), the petition includes a statement of the last known email address for the non-signing inventor; however, it does not include an express statement of the last known residence address of the non-signing inventor, as required (see MPEP section 409.03(e)). Item (3) is therefore not satisfied.

Regarding item (4), the petition was accompanied by a declaration signed on behalf of the inventor by a Managing Director of 37 CFR 1.47(b) applicant Kohler New Zealand, Ltd. ("Kohler"). Item (4) is therefore satisfied.

Regarding item (5), section 409.03(f) of the MPEP states the following:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Here, the petition does not assert that the application has been expressly assigned to the 37 CFR 1.47(b) applicant by the non-signing inventor. Rather, petitioner's assertion of proprietary interest is based on the terms of the inventor's employment. With respect to such a claim, the MPEP states the following:

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer ( 37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

The present petition includes a copy of the employment agreement between the inventor and Kohler, and such employment agreement includes a provision assigning to Kohler any intellectual property rights in any invention created by the inventor during his employment. The petition also includes a statement from John Bourke, Managing Director of Kohler, stating that the inventor was a member of the product design team responsible for the development of new bathroom products, including the product described in the present patent. However, petitioner has not provided a statement from a person with firsthand knowledge of the facts specifically confirming that the invention underlying the present application was made by the employee during his employment with Kohler, as required. Accordingly, on the present record, item (5) of a grantable petition is not satisfied.

Regarding item (6), the petition includes the required express statement that granting of the present petition is necessary to preserve the rights of the 37 CFR 1.47(b) applicant and to prevent irreparable damage. Item (6) is therefore satisfied.

Based on the above, petitioner has failed to satisfy all the requirements for a grantable petition.

### **CONCLUSION**

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for

reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)" and must include the materials required to satisfy items (2), (3), and (5) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296



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MILWAUKEE WI 53202-4497

**MAILED**  
**JUL 07 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of: MURPHY, Peter	:	
U.S. Application No.: 12/678,064	:	DECISION ON RENEWED
PCT No.: PCT/NZ2008/000242	:	PETITION UNDER
International Filing Date: 15 September 2008	:	37 CFR 1.47(b)
Priority Date: 14 September 2007	:	
Attorney's Docket No.: 550639.00012	:	
For: A BATH	:	

This decision is issued in response to the "Renewed Petition Under 37 C.F.R. § 1.47(b)" filed on 16 May 2011. No additional petition fee is required.

**BACKGROUND**

The procedural background for the present application was set forth in the decision mailed on 16 March 2011. The decision dismissed without prejudice the petition under 37 CFR 1.47(b), finding that petitioner had not satisfied all the requirements of a grantable petition. Specifically, petitioner had not provided an acceptable showing that the inventor refuses to execute the application or cannot be reached after diligent effort, a statement of the last known residence address of the non-signing inventor, and an acceptable showing of petitioner's proprietary interest in the application.

On 16 May 2011, petitioner filed the renewed petition considered herein.

**DISCUSSION**

With respect to the inventor's refusal to execute the application, the renewed petition includes supplemental materials indicating that a request for signature, accompanied by a copy of the complete application, was forwarded to the two last known addresses of the non-signing inventor, but that both requests were returned as undeliverable. Because the addresses were no longer current and the materials were therefore not received by the inventor, these mailings do not provide further support for a conclusion that the inventor has refused to execute the application. The present record therefore remains inadequate to demonstrate that the inventor has refused to execute the application. As indicated in the previous decision, before it can be concluded that the inventor has refused to execute the application, petitioner must provide supplemental materials demonstrating that a request for signature on the declaration, accompanied by a copy of the complete application (description, claims, and drawings) has been

provided to the non-signing inventor and that the inventor has refused to provide the requested declaration in response to such request.

It is noted that, in the alternative, petitioner may submit a showing that the non-signing inventor cannot now be reached or located after diligent effort, if appropriate. The requirements for such a showing are set forth in MPEP section 409.03(d)(1), which states as follows:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. [...]

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

In order to satisfy the above requirements, petitioner would be required to supplement the present record with additional materials including a firsthand statement, with supporting documents, setting forth the details of further efforts made to obtain current contact information for the non-signing inventors and contact them at such current addresses. Such efforts must include, but not be limited to, an internet search (with the results of such search being made of record herein).

In view of the above, petitioner has failed to provide the required showing that the non-signing inventor has refused to execute the application or cannot be located after diligent effort. Accordingly, this element of a grantable petition under 37 CFR 1.47(b) remains unsatisfied.

With respect to the last known address requirement, the present renewed petition includes a statement of the last known residence addresses of the non-signing inventor. This element of a grantable petition is therefore satisfied.

With respect to the showing of proprietary interest, the renewed petition includes a statement from John Hatrick-Smith providing firsthand confirmation that the invention underlying the present application was made by the inventor during his employment with the 37 CFR 1.47(b) applicant, Kohler New Zealand, Ltd. (Kohler). This statement, in combination with the materials filed with the original petition, provides an acceptable showing of Kohler's proprietary interest in the application. The proprietary interest element of a grantable petition under 37 CFR 1.47(b) is therefore now satisfied.

Based on the above, the renewed petition satisfies two of the three outstanding elements of a grantable petition. However, because petitioner has not satisfied the final element of a grantable petition, the renewed petition is appropriately dismissed.

**CONCLUSION**

The renewed petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.47(b)" and must include the materials required to satisfy the final outstanding element of a grantable petition, that is, the additional materials required for an acceptable showing that the non-signing inventor has refused to execute the application or cannot be located after diligent effort, as discussed above, in the previous decision, and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296



UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 22 2011

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MILWAUKEE WI 53202-4497

PCT LEGAL ADMINISTRATION

In re Application of: MURPHY, Peter :  
U.S. Application No.: 12/678,064 :  
PCT No.: PCT/NZ2008/000242 :  
International Filing Date: 15 September 2008 :  
Priority Date: 14 September 2007 :  
Attorney's Docket No.: 550639.00012 :  
For: A BATH :

DECISION ON SECOND  
RENEWED PETITION UNDER  
37 CFR 1.47(b)

This decision is issued in response to the "Second Renewed Petition Under 37 C.F.R. § 1.47(b)" filed 07 December 2011. No additional petition fee is required.

**BACKGROUND**

The procedural background for the present application was set forth in the decisions mailed on 16 March 2011 and 07 July 2011. The decisions dismissed without prejudice the petition under 37 CFR 1.47(b), finding that petitioner had failed to satisfy all the requirements of a grantable petition.

On 07 December 2011, applicant filed the "Second Renewed Petition Under 37 C.F.R. § 1.47(b)" considered herein, with required three-month extension fee.

**DISCUSSION**

The present renewed petition is accompanied by a declaration executed by the previously non-signing sole inventor who was the subject of the petition under 37 CFR 1.47(b), Peter MURPHY. This declaration is acceptable in compliance with 37 CFR 1.497.

Based on the submission of an acceptable declaration executed by the previously non-signing sole inventor, applicant's petition under 37 CFR 1.47(b) is appropriately dismissed as moot.

**CONCLUSION**

Based on the submission of an acceptable declaration executed by the sole inventor, the petition under 37 CFR 1.47(b) filed herein is **DISMISSED AS MOOT**.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 07 December 2011.

/RichardMRoss/

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**MAILED**

**MAR 28 2011**

**OFFICE OF PETITIONS**

In re Application of	:	
Anand Chellappa et al.	:	DECISION ON PETITION
Application No. 12/678,069	:	TO WITHDRAW
Filed: July 8, 2010	:	FROM RECORD
Attorney Docket No. 37929-81001	:	

This is a decision on the request to withdraw as attorney of record under 37 CFR § 1.36(b), filed February 15, 2011.

The request is **NOT APPROVED**.

The request cannot be approved because it lacks the name of the first inventor or the assignee of record that is associated with the address listed in the request. Therefore, the change of correspondence address is considered improper.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71*, or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

*An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

A courtesy copy of this decision is being mailed to the address on the request. However, all future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4584.

/JoAnne Burke/  
JoAnne Burke  
Petitions Examiner  
Office of Petitions

cc: Marlan D. Walker  
2050 Main Street, Suite 600  
Irvine, CA 92614



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P.O. BOX 747  
FALLS CHURCH VA 22040-0747

**MAILED**

**MAR 06 2012**

**PCT LEGAL ADMINISTRATION**

In re Application of	:	
YAMATA	:	
Application No.: 12/678,082	:	DECISION ON PETITION
PCT No.: PCT/JP2008/066914	:	
Int. Filing Date: 12 September 2008	:	UNDER 37 CFR 1.181
Priority Date: 14 September 2007	:	
Atty Docket No.: 0020-5836PUS1	:	
For: HERBICIDAL COMPOSITION	:	

This decision is in response to applicant's "REQUEST FOR CORRECTED NOTICE OF ACCEPTANCE" filed 26 April 2011 in the United States Patent and Trademark Office (USPTO). The request is being treated as a petition under 37 CFR 1.181 to assign a 35 U.S.C. 371 date of 27 April 2010. No petition fee is required.

On 22 April 2011, applicant was mailed a Form PCT/DO/EO/903 which identified the 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date as 12 March 2010 and the date of completion of all 35 U.S.C. 371 requirements as 27 April 2010. Applicant was concurrently mailed a filing receipt which listed the "filing or 371 (c) date" as "03/12/2010." Applicant seeks correction to 27 April 2010.

A review of the application file finds that the last of the 35 U.S.C. 371 requirements, the executed declaration of the inventor, was filed on 27 April 2010. As such it is proper to **GRANT** applicant's petition at this time.

The Form PCT/DO/EO/903 mailed 22 April 2011 is hereby **VACATED**.

The application has an international filing date of 12 September 2008 under 35 U.S.C. 363 and will be given a date of **27 April 2010** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision; including the mailing of a corrected Form PCT/DO/EO/903 and Official Filing Receipt.

Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294



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P.O. Box 1022  
Minneapolis, MN 55440-1022

**MAILED**

JAN 07 2011

PCT LEGAL ADMINISTRATION

In re Application of :  
JAIN *et al* :  
U.S. Application No.: 12/678,085 :  
PCT No.: PCT/US2008/076319 :  
Int. Filing Date: 12 September 2008 :  
Priority Date: 12 September 2007 :  
Docket No.: 24310-0014US1 :  
For: RECEIVING BROADCAST SIGNALS :  
USING INTELLIGENT COVERS FOR :  
MOBILE DEVICES :

**DECISION**

This is a decision on the request to add an inventor filed 29 October 2010. This request is treated under 37 CFR 1.497(d).

**BACKGROUND**

On 30 June 2010, a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) stating that applicants must furnish an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and additional claim fees were mailed. Applicants were given two months to respond with extensions of time available.

On 30 August 2010, applicants filed a declaration executed by two inventors, Deepak JAIN and Tuan Quoc DAO, along with a one-month extension fee, a surcharge fee and authorization to charge any required fees to Deposit Account No. 06-1050.

On 08 September 2010, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed stating that current declaration does not comply with 37 CFR 1.497(a) and (b) because the international publication listed only one inventor on the international application. Applicants were given one month to respond, or any time remaining on the Form PCT/DO/EO/905, whichever was longer.

On 29 October 2010, applicants filed the subject response to correct the inventorship which was accompanied by, *inter alia*, a two-month extension and fee; a \$130.00 processing fee; a statement by the inventor being added; and a consent of the assignee.

**DISCUSSION**

Applicants request to correct the inventorship in the subject application by adding

Tuan Quoc DAO as an inventor. 37 CFR 1.497(d) applies when the inventorship in a national stage application filed under 35 U.S.C. 371 differs from that set forth in the international application (see 37 CFR 1.48(f)(1)).

37 CFR 1.497(d) states, in part:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(l); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

Applicants filed the required statement by the inventor being added, Tuan Quoc DAO. The processing fee of \$130.00 has been paid. Applicants also submitted a consent of assignee signed by Deepak JAIN as the President of DEVICEFIDELITY, Inc. the assignee. The position of President is presumed to have the authority to sign for an organization. See MPEP § 324. The reel and frame number of the assignment was provided. A review of the application shows that an assignment to KL MED Co. Ltd. was also recorded in the subject application.

Therefore, all the requirements of 37 CFR 1.497(d) are complete.

### CONCLUSION

Applicants' request to add Tuan Quoc DAO as an inventor under 37 CFR 1.497(d) is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 12 September 2008, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 30 August 2010.

The surcharge fee of \$65.00 was submitted with the initial filing and again with the response filed 30 August 2010. The second surcharge fee of \$65.00 has been refunded.

This application is being forwarded to the United States Designated/Elected

Office for further processing in accordance with this decision.

A handwritten signature in black ink, appearing to read "James Thomson". The signature is fluid and cursive, with the first name "James" and last name "Thomson" clearly distinguishable.

James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302



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Cleveland, OH 44115

**MAILED**

**APR 26 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of :  
WASNIEVSKI DA SILVA *et al* :  
U.S. Application No.: 12/678,095 :  
PCT No.: PCT/BR2008/000277 :  
Int. Filing Date: 10 September 2008 :  
Priority Date: 12 September 2007 :  
Attorney Docket No.: DANN 200009US01 :  
For: REFRIGERATION MODULE AND :  
REFRIGERATION SYSTEM :

**DECISION**

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 28 February 2011.

**BACKGROUND**

On 27 August 2010, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed requesting additional claim fees, an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee. Applicants were given two months to respond. Extensions of time under 37 CFR 1.136(a) were available.

On 28 February 2011, applicants filed the subject petition which was accompanied by, *inter alia*, a \$200.00 petition fee; a \$130.00 surcharge fee; a four-month-extension fee of \$1,730.00; a declaration signed by three of the four named inventors on behalf of the nonsigning inventor; a statement of facts by Lucimeri Skora Gerstner; and documentary evidence in support of the petition.

**DISCUSSION**

Applicants claim that co-inventor, Taciani MEURER DUARTE, could not be reached and have filed the subject petition under 37 CFR 1.47(a).

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuse to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventor.

Items (1), (3) and (4) of 37 CFR 1.47(a)<sup>1</sup> are satisfied.

Regarding item (2), section 409.03(d)(I) of the MPEP discusses situations where an inventor cannot be reached and states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement.

Here, applicants provided a statement by Mr. Gerstner and included documentary evidence in support of the statement as required. Mr. Gerstner lays out the steps taken to contact the nonsigning inventor which included sending documents by registered mail, courier and attempting to contact the nonsigning inventor by email. However, applicants have not provided enough evidence to demonstrate that a diligent effort was made to locate Mr. MEURER DUARTE. Specifically, Mr. Gerstner states in paragraph 11 of his statement that:

I do not know the telephone number, e-mail address or any other contact information or alternative mailing address for the nonsigning inventor, Taciani Meurer Duarte, even after searching for such information.

Applicants must explain exactly what type of search was made to locate the nonsigning inventor and what were the parameters of such a search.<sup>2</sup> Copies of such searches with accompanying English translations, if applicable, should be provided that support a finding that the nonsigning inventor could not be found or reached as required by the MPEP. Applicants should also consider contacting former employers and/or co-workers to determine if they have any knowledge of the whereabouts of the nonsigning inventor. These efforts are not extraordinary and are required to show that a diligent effort was made to contact Mr. MEURER DUARTE.

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<sup>1</sup> Applicants submitted a \$200.00 petition fee. The last known address of the nonsigning inventor was provided. A declaration signed by three of the four inventors on behalf of the nonsigning inventor was provided. This declaration complies with 37 CFR 1.497(a) and (b).

<sup>2</sup> For example, an address search for Mr. MEURER DUARTE in Brazil using Google, etc.

For these reasons, item (2) of 37 CFR 1.47(a) is not yet complete.

**CONCLUSION**

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302



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Cleveland, OH 44115

**MAILED**

NOV 30 2011

PCT LEGAL ADMINISTRATION

In re Application of :  
WASNIEVSKI DA SILVA *et al* :  
U.S. Application No.: 12/678,095 :  
PCT No.: PCT/BR2008/000277 :  
Int. Filing Date: 11 September 2008 :  
Priority Date: 12 September 2007 :  
Attorney Docket No.: DANN 200009US01 :  
For: REFRIGERATION MODULE AND :  
REFRIGERATION SYSTEM :

**DECISION**

This decision is in response to applicants' renewed petition under 37 CFR 1.47(a) filed 17 October 2011.

**BACKGROUND**

On 26 April 2011, a decision dismissing applicants' petition under 37 CFR 1.47(b) was mailed. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 17 October 2011, applicants filed a renewed response which was accompanied by, *inter alia*, a four-month extension, a supplemental statement by Lucimeri Skora Gerstner and documentary evidence in support of the petition.

**DISCUSSION**

Applicants claim that co-inventor, Taciani MEURER DUARTE, could not be reached.

As previously noted, a petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventor.

Items (1), (3) and (4) of 37 CFR 1.47(a) were completed in the initial petition.

Regarding item (2) of 37 CFR 1.47(a), the prior decision noted that applicants did not provide enough evidence to demonstrate that a diligent effort was made to locate

Mr. MEURER DUARTE. Applicants were requested to explain in detail what type of search was made to locate the nonsigning inventor. Documentary evidence that support a finding that the nonsigning inventor could not be found or reached should be submitted.

In the renewed response, applicants provided a supplemental statement of facts by Mr. Gerstner listing the steps taken to obtain the signature of the nonsigning inventor. These steps included contacting friends and acquaintances, contacting former employers, contacting the inventor's mother, and searching for Mr. MEURER DUARTE using the internet. Sufficient documentary evidence was provided.

A review of the evidence shows that applicants made a diligent effort to locate the nonsigning inventor. These efforts meet the requirements listed in of MPEP § 409.03(d)(I). Item (2) of 37 CFR 1.47(a) is now satisfied.

All the requirements of 37 CFR 1.47(a) are complete.

#### **CONCLUSION**

Applicants' renewed petition under 37 CFR 1.47(a) is hereby **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 11 September 2008<sup>1</sup> under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 28 February 2011.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record and will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing



James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302

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<sup>1</sup> The international filing date was listed as 10 September 2008 on the Form PCT/DO/EO/905 mailed 27 August 2010 and on the prior decision. USPTO records have been updated to show an international filing date of 11 September 2008.



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Taciani Meurer Duarte  
Rua Rudolfo Jacob Schaeffer, 257 - apto. 303  
89110-609 São José SC,  
BR-Brazil

In re Application of  
WASNIEVSKI DA SILVA *et al*  
U.S. Application No.: 12/678,095  
PCT No.: PCT/BR2008/000277  
Int. Filing Date: 11 September 2008  
Priority Date: 12 September 2007  
Attorney Docket No.: DANN 200009US01  
For: REFRIGERATION MODULE AND  
REFRIGERATION SYSTEM

**MAILED**

**NOV 30 2011**

PCT LEGAL ADMINISTRATION

Dear Mr Meurer Duarte:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. The counsel for the applicant is listed below. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

  
James Thomson  
Attorney Advisor

Office of PCT Legal Administration

Tel.: (571) 272-3302

FAY SHARPE LLP  
1228 Euclid Avenue, 5<sup>th</sup> Floor  
The Halle Building  
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**BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH VA 22040-0747**

**MAILED  
MAR 12 2012  
OFFICE OF PETITIONS**

**In re Application of  
Jong-Ho Jeon et al  
Application No.: 12/678,109  
Filed: March 12, 2010  
Attorney Docket No.: 3563-0128PUS1  
For: NON-AQUEOUS ELECTROLYTE  
LITHIUM SECONDARY BATTERY**

**: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)**

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed February 2, 2012, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PPH program and petition to make special require:

1. The U.S. application is

- a. a Paris Convention application which either
  - i. validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the KIPO, or
  - ii. validly claims priority under 35 U.S.C. 119(a)/365(a) to a PCT application that contains no priority claims,
- or
- b. a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
  - i. validly claims priority under 35 U.S.C. 365(b) to an application filed in the KIPO, or
  - ii. validly claims priority under 35 U.S.C. 365(b) to a PCT application that contains no priority claims, or
  - iii. contains no priority claim,

- or
- c. a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
  - i. validly claims priority under 35 U.S.C. 365(b) to an application filed in the KIPO, or
  - ii. validly claims priority under 35 U.S.C. 365(b) to a PCT application that contains no priority claims, or
  - iii. contains no priority claim;
- 2. Applicant must submit a copy of:
  - a. The allowable/patentable claim(s) from the KR application(s);
  - b. An English translation of the allowable/patentable claim(s), and
  - c. A statement that the English translation is accurate (if the claims were published in a language other than English);
- 3. Applicant must:
  - a. Ensure that all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the KR application(s), and
  - b. Submit a claims correspondence table in English;
- 4. Examination of the U.S. application has not begun;
- 5. Applicant must submit:
  - a. A copy of all the office actions (which are relevant to patentability), excluding "Decision to Grant a Patent" from each of the KR application(s) containing the allowable/patentable claim(s);
  - b. An English language translation of the KIPO office action; and
  - c. A statement that the English translation is accurate (if the office actions are not in the English language);
- 6. Applicant must submit:
  - a. An IDS listing the documents cited by the KIPO examiner in the KIPO office action (unless already filed in this application); and
  - b. Copies of all the documents cited in the KIPO office action, except U.S. patents or U.S. patent application publications (unless already filed in this application);

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Karen Creasy at (571) 272-3208.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

This application will be forwarded to the examiner for action on the merits commensurate with this decision.

A handwritten signature in black ink, appearing to read "Diane Goodwyn", with a stylized flourish at the end.

Diane Goodwyn  
Petitions Examiner  
Office of Petitions



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ROBERT A. PARSONS  
4000 N. CENTRAL AVENUE, SUITE 1220  
PHOENIX AZ 85012

**MAILED**

**DEC 15 2010**

**PCT LEGAL ADMINISTRATION**

In re Application of: STRAGER, Marcel  
Application No.: 12/678126  
PCT Application No.: PCT/US2005/042477  
International Filing Date: November 22, 2005  
Attorney Docket No.: 3518-A17PCUS  
For: BRAKE ENERGY RECOVERY SYSTEM

DECISION ON PETITION  
UNDER 37 CFR 1.137(b)

This decision is in response to applicant's "Petition for revival of an international application for patent designating the U.S. abandoned unintentionally under 37 CFR 1.137(b)" filed on March 12, 2010.

**BACKGROUND**

On November 22, 2005, international application no. PCT/US2005/042477 was filed, claiming a priority date of November 23, 2004.

The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was May 23, 2007. This application became abandoned with respect to the United States at midnight on May 23, 2007 for failure to pay the required basic national fee.

On March 12, 2010, applicant submitted in the United States Patent and Trademark Office (USPTO) a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371, which was accompanied by, *inter alia*, the basic national fee, petition fee, and a petition under 37 CFR 1.137(b).

**DISCUSSION**

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by:

- (1) The required reply, unless previously filed;
- (2) The petition fee as set forth in 37 CFR 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The

Director may require additional information where there is a question whether the delay was unintentional; and,

(4) Any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The required reply in a national stage application abandoned for failure to pay the basic national fee, pursuant to 35 U.S.C. 371(c) and 37 CFR 1.495, may be met by the submitting the basic national fee.

In this application, no terminal disclaimer is required. Petitioner has provided:

- (1) The required reply by submitting the basic national fee;
- (2) The petition fee set forth in 37 CFR 1.17(m); and
- (3) The proper statement under 37 CFR 1.137(b)(3).

Accordingly, the petition is deemed to satisfy the requirements under 37 CFR 1.137(b).

#### **DECISION**

The petition under 37 CFR 1.137(b) is GRANTED.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing.



Tamara Grayson  
PCT Special Program Examiner  
Office of PCT Legal Administration  
(571) 272-6728



Boris Milef  
PCT Legal Examiner  
Office of PCT Legal Administration



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MAR 04 2011

PCT LEGAL ADMINISTRATION

PEPPER HAMILTON LLP  
ONE MELLON CENTER, 50TH FLOOR  
500 GRANT STREET  
PITTSBURGH, PA 15219

In re Application of BREMNER	:	
U.S. Application No.: 12/678,128	:	
PCT Application No.: PCT/GB2008/003111	:	DECISION
Int. Filing Date: 15 September 2008	:	
Priority Date Claimed: 13 September 2007	:	
Attorney Docket No.: 136724.00601	:	
For: ANALOG-TO-DIGITAL CONVERTER	:	

This is in response to applicant's petition under 37 CFR 1.47(b) filed 19 January 2011.

**BACKGROUND**

On 15 September 2008, applicant filed international application PCT/GB2008/003111, which claimed priority of an earlier United Kingdom application filed 13 September 2007. A copy of the international application was communicated to the USPTO from the International Bureau on 19 March 2009. The thirty-month period for paying the basic national fee in the United States expired on 14 March 2010.

On 12 March 2010, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 23 August 2010, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 19 January 2011, applicant filed the present petition under 37 CFR 1.47(b).

**DISCUSSION**

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or

declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

The petition states that sole inventor Duncan Bremner refuses to sign the application papers. The petition adequately demonstrates that a bona fide attempt was made to present a copy of the application papers to Bremner for signature and that Bremner received such papers (see affidavit of Johanna McCormick, ¶5, and Exhibit C). Furthermore, the petition sufficiently illustrates that Bremner refuses to sign. In particular, Bremner's failure to respond to the correspondence delivered to him constitutes a constructive refusal to cooperate. Thus, it can be concluded with reasonable certainty that Bremner refuses to join in the application.

With regard to item (3) above, the petition states the last known address of the nonsigning inventor.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has been provided.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, the petition includes a copy of an agreement to assign the present invention to ITI Scotland Limited signed by the inventor. The agreement specifies that the inventor agrees to assign inventions made during the inventor's employment with ITI Scotland Limited. The petition includes the statement of David Middleton, the person with firsthand knowledge of the present invention being made by Bremner during Bremner's employment with ITI Scotland Limited. Thus, it can be concluded with reasonable certainty that ITI Scotland Limited has sufficient proprietary interest in the present application.

With regard to item (6) above, an adequate statement regarding preservation of the rights of the parties and/or prevention of irreparable damage has been provided.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(b) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 15 September 2008, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 19 January 2011.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.



Bryan Lin  
PCT Legal Examiner  
PCT Legal Office

Telephone: 571-272-3303  
Facsimile: 571-273-0459



UNITED STATES PATENT AND TRADEMARK OFFICE

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MAR 04 2011

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Duncan Bremner  
Braedine  
Johnshill  
Lochwinnoch  
Scotland PA12 4EL  
UNITED KINGDOM

PCT LEGAL ADMINISTRATION

In re Application of BREMNER  
U.S. Application No.: 12/678,128  
PCT Application No.: PCT/GB2008/003111  
Int. Filing Date: 15 September 2008  
Priority Date Claimed: 13 September 2007  
For: ANALOG-TO-DIGITAL CONVERTER

Dear Duncan Bremner:

You are named as the inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 118. Should a patent be granted, you will be designated as the inventor.

As the named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost set forth in 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you choose to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

*Bryan Lin*

Bryan Lin  
PCT Legal Examiner  
PCT Legal Office  
Telephone: 571-272-3303  
Facsimile: 571-273-0459

PEPPER HAMILTON LLP  
ONE MELLON CENTER, 50TH FLOOR  
500 GRANT STREET  
PITTSBURGH, PA 15219  
Attorney Docket No.: 136724.00601

## REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE KOREAN INTELLECTUAL PROPERTY OFFICE (KIPO) AND THE USPTO

Application No:	12678147	Filing date:	July 19, 2011
First Named Inventor:	Mark Zdeblick		
Title of the Invention: Volume Sensing			

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBS/DFS\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/US2010/027261

**The international date of the corresponding PCT application(s) is/are:** March 13, 2010

### I. List of Required Documents:

- a. **A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**

☒

Is attached.

☐

Is not attached because the document is already in the U.S. application.

- b. **A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**

☐

Is attached.

☒

Is not attached because the document is already in the U.S. application.

- c. **English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

## REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM BETWEEN THE KIPO AND THE USPTO

Application No.:	12678147
First Named Inventor:	Mark Zdeblick

- ☐ Is attached
- ☒ Has already been filed in the above-identified U.S. application on 10-06-2010

- ☐ Are attached. 10-06-2010
- Have already been filed in the above-identified U.S. application on

[illegible]

Signature	/Bret E. Field, Reg. No. 37,620/	Date	09-22-2011
Name (Print/Typed)	Bret E. Field	Registration Number	37,620

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



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Alexandria, VA 22313-1450  
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Proteus Biomedical, Inc.  
Bozicevic, Field & Francis LLP  
1900 University Avenue, Suite 200  
East Palo Alto CA 94303

**MAILED**  
**MAR 22 2012**  
**OFFICE OF PETITIONS**

In re Application of  
Mark Zdeblick  
Application No.: 12/678,147  
Filed: July 19, 2011  
Attorney Docket No.: PRTS-141 (PRO-138)  
For: Volume Sensing

: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed on September 22, 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- 1) The U.S. application must have an eligible relationship to one or more PCT applications where the ISA or IPEA are Australia, Austria, China, EPO, Finland, JPO, Korea, NPI, Russia, Spain, Sweden and the USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;

(4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);

(5) Examination of the U.S. application has not begun;

(6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate if the latest international work product is not in the English language;


(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PCT-PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at 571-272-4618.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

This application will be forwarded to the examiner for action on the merits commensurate with this decision.

  
Thurman Page  
Petitions Examiner  
Office of Petitions



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DEC 06 2010

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SALIWANCHIK LLOYD & SALIWANCHIK  
A PROFESSIONAL ASSOCIATION  
PO Box 142950  
GAINESVILLE FL 32614

PCT LEGAL ADMINISTRATION

In re Application of :  
GRUBER, Jens, et al. :  
Application No.: 12/678,150 :  
PCT No.: PCT/EP2008/007580 :  
Int. Filing Date: 12 September 2008 :  
Priority Date: 14 September 2007 :  
Docket No.: BB.260 :  
For: DOWN REGULATION OF THE GENE :  
EXPRESSION BY MEANS OF :  
NUCLEIC ACID-LOADED :  
VIRUS-LIKE PARTICLES :

DECISION  
ON PETITION UNDER  
37 CFR 1.47(a)

This is a decision on applicants' Petition Under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 13 September 2010.

**BACKGROUND**

On 12 May 2010, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that, *inter alia*, an oath or declaration and the surcharge for late filing of the search fee, examination fee or oath or declaration were required.

On 13 September 2010, applicants filed a petition under 37 CFR 1.47(a), a declaration and the fee for a two month extension of time.

**DISCUSSION**

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1) and (3) have been met. The petition fee has been paid. Applicant states the last known address of Gabriela Jansen, legal representative of deceased inventor Wolfgang Lüke, as Am Berg Fidel 115, 48153 Münster, Germany.

Item (2) has not been satisfied. Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the

refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. MPEP 409.03(d). Here counsel for Ms. Jansen sets forth that they are advising her not to execute the declaration. However, it is not clear from the letter, nor has it been set forth in a statement of facts by someone with firsthand knowledge, that Ms. Jansen was presented with a complete copy of the application papers and declaration. Copies of documentary evidence supporting the presentation should be supplied.

Item (4) may contain a transliteration or typographical error. Applicant identifies the legal representative as "Gabriela Jansen," but her counsel identifies her as "Gabriele Jansen." If the declaration contains a typographical or transliteration error, it can be corrected by a statement to that effect identifying the correct spelling of the name. MPEP 1893.01(e).

### **CONCLUSION**

For the above reasons, applicant's petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Extensions of time under 37 CFR 1.136(a) are available. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292



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A PROFESSIONAL ASSOCIATION  
PO Box 142950  
GAINESVILLE FL 32614

**MAILED**

**SEP 26 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of	:	
GRUBER, Jens, et al.	:	DECISION
Application No.: 12/678,150	:	
PCT No.: PCT/EP2008/007580	:	ON PETITION UNDER
Int. Filing Date: 12 September 2008	:	
Priority Date: 14 September 2007	:	37 CFR 1.47(a) AND
Docket No.: BB.260	:	
For: DOWN REGULATION OF THE GENE	:	REQUEST FOR STATUS
EXPRESSION BY MEANS OF	:	
NUCLEIC ACID-LOADED	:	UNDER 37 CFR 1.42
VIRUS-LIKE PARTICLES	:	

This is a decision on applicants' renewed Petition Under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 12 February 2011.

**BACKGROUND**

On 06 December 2010, the Office mailed Decision On Petition, dismissing applicants' petition under 37 CFR 1.47(a) without prejudice and setting a two month period for reply.

On 12 February 2011, applicants filed a renewed petition under 37 CFR 1.47(a), a declaration and a statement under MPEP 1893.01(e).

On 23 February 2011, applicants filed a second statement under MPEP 1893.01(e).

**DISCUSSION**

Applicants have received a signed declaration from the legal representative of the deceased inventor Lüke. As such, the petition under 37 CFR 1.47(a) is moot. However, this submission is now a request for status under 37 CFR 1.42.

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

The 13 September 2010 and 07 February 2011 declarations list the inventors and their citizenships and the legal representative and the legal representative's citizenship, residence and postal address, satisfying 37 CFR 1.42 and 37 CFR 1.497(a)-(b).

Applicants state identifies the legal representative is "Gabriele Jansen," and that the spelling of her name as "Gabriela Jansen" was a typographical error.

**CONCLUSION**

For the above reasons, applicant's petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**. The request for status under 37 CFR 1.42 is **GRANTED**.

This application is being forwarded to the National Stage Processing Division of the Office of Patent Application Processing for further action consistent with this decision.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292

Doc Code: PET.AUTO Document Description: Petition automatically granted by EFS-Web		PTO/SB/140 U.S. Patent and Trademark Office Department of Commerce
Electronic Petition Request	<b>PETITION TO WITHDRAW AN APPLICATION FROM ISSUE AFTER PAYMENT OF THE ISSUE FEE UNDER 37 CFR 1.313(c)</b>	
Application Number	12678159	
Filing Date	15-Mar-2010	
First Named Inventor	Haruki Toda	
Art Unit	2824	
Examiner Name	TUAN NGUYEN	
Attorney Docket Number	354665US2PCT	
Title	RESISTANCE-CHANGING MEMORY DEVICE	
<p>An application may be withdrawn from issue for further action upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary.</p> <p>APPLICANT HEREBY PETITIONS TO WITHDRAW THIS APPLICATION FROM ISSUE UNDER 37 CFR 1.313(c).</p> <p>A grantable petition requires the following items:</p> <p>(1) Petition fee; and</p> <p>(2) One of the following reasons:</p> <p>(a) Unpatentability of one or more claims, which must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;</p> <p>(b) Consideration of a request for continued examination in compliance with § 1.114 (for a utility or plant application only); or</p> <p>(c) Express abandonment of the application. Such express abandonment may be in favor of a continuing application, but not a CPA under 37 CFR 1.53(d).</p>		
<p>Petition Fee</p> <p><input type="checkbox"/> Applicant claims SMALL ENTITY status. See 37 CFR 1.27.</p> <p><input type="checkbox"/> Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).</p> <p><input type="checkbox"/> Applicant(s) status remains as SMALL ENTITY.</p> <p><input checked="" type="checkbox"/> Applicant(s) status remains as other than SMALL ENTITY</p>		
Reason for withdrawal from issue		

- ☐ One or more claims are unpatentable
- ☒ Consideration of a request for continued examination (RCE) (List of Required Documents and Fees)
- ☐ Applicant hereby expressly abandons the instant application (any attorney/agent signing for this reason must have power of attorney pursuant to 37 CFR 1.32(b)).

RCE request, submission, and fee.

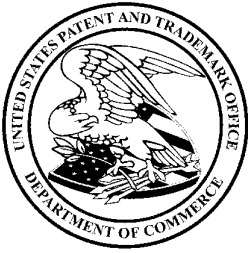
- ☐ I certify, in accordance with 37 CFR 1.4(d)(4) that:
- ☐ The RCE request, submission, and fee have already been filed in the above-identified application on
- ☒ Are attached.

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

I certify, in accordance with 37 CFR 1.4(d)(4) that I am:

- ☒ An attorney or agent registered to practice before the Patent and Trademark Office who has been given power of attorney in this application.
- ☐ An attorney or agent registered to practice before the Patent and Trademark Office, acting in a representative capacity.
- ☐ A sole inventor
- ☐ A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors
- ☐ A joint inventor; all of whom are signing this e-petition
- ☐ The assignee of record of the entire interest that has properly made itself of record pursuant to 37 CFR 3.71

Signature	/surinder sachar/
Name	Surinder Sachar
Registration Number	34423



## UNITED STATES PATENT AND TRADEMARK OFFICE

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Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Decision Date : January 26, 2012

In re Application of :

Haruki Toda

DECISION ON PETITION

UNDER CFR 1.313(c)(2)

Application No : 12678159

Filed : 15-Mar-2010

Attorney Docket No : 354665US2PCT

This is an electronic decision on the petition under 37 CFR 1.313(c)(2), filed January 26, 2012 , to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid in this application cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

This application file is being referred to Technology Center AU 2824 for processing of the request for continuing examination under 37 CFR 1.114 .

Office of Petitions



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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA VA 22314

In re Application of  
ITADANI et al  
Application No.: 12/678,191  
PCT No.: PCT/JP2008/66600  
Int. Filing Date: 12 September 2008  
Priority Date: 12 September 2007  
Attorney Docket No.: 356214US0XPCT  
For: EXTRUDED POLYPROYLENE...  
PRODUCING THE SAME

**MAILED**  
**OCT 07 2010**  
**PCT LEGAL ADMINISTRATION**  
**DECISION**

This decision is in response to applicants' "NOTIFICATION OF ERROR UNDER MPEP §1893.01(e)," which is being treated as a petition under 37 CFR 1.181, filed on 02 July 2010 indicating that the executed declaration filed on contains the correct spelling of the first inventor's name **Toru ITADANI**.

The published PCT application contained a typographical error because **Toru ITADANI** was misspelled as Toru ITATANI.

**BACKGROUND**

On 15 March 2010, applicants filed in the United States Patent and Trademark Office (PTO) a Transmittal Letter (Form PTO-1390) accompanied by, *inter alia*, the basic national fee. Applicant, however, did not satisfy the requirement set forth by 35 U.S.C. 371(c)(4) because no executed oath or declaration was filed at that time.

On 11 May 2010, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905).

On 25 May 2010, applicants filed an executed declaration.

On 24 June 2010, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916).

On 02 July 2010, applicants responded with the current petition, which states that the executed Declaration, with the first named inventor listed as **Toru ITADANI** is his correct spelling.

**DISCUSSION**

The correct name of the first joint-inventor is "**Toru ITADANI**" as filed in the executed declaration on 25 May 2010, and not as it appeared in the publication of the international application. The petition states that his name was incorrectly spelled in the international application because of a typographical error but now has been corrected. Accordingly, the correct name, **Toru ITADANI**, now appears in the declaration as filed on 25 May 2010 to the USPTO.

**DECISION**

For the reasons above, the petition under 37 CFR 1.181 is **GRANTED** that the correct spelling of the first joint inventor is **Toru ITADANI**.



Rafael Bacares

PCT Legal Examiner

PCT Legal Office

Telephone: (571) 272-3276

Facsimile: (571) 273-0459



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,200	03/15/2010	Bin Chul Ihm	2101-3795	6321
35884 7590 12/06/2010 LEE, HONG, DEGERMAN, KANG & WAIMEY 660 S. FIGUEROA STREET Suite 2300 LOS ANGELES, CA 90017				
			EXAMINER GHAYOUR, MOHAMMAD H	
			ART UNIT 2611	PAPER NUMBER
			NOTIFICATION DATE 12/06/2010	DELIVERY MODE ELECTRONIC

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ip.lhlaw@gmail.com  
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LEE, HONG, DEGERMAN, KANG & WAIMEY  
660 S. FIGUEROA STREET  
Suite 2300  
LOS ANGELES CA 90017

In re Application of	:	
IHM, BIN CHUL, et al.	:	DECISION ON REQUEST TO
Application No. 12/678,200	:	PARTICIPATE IN PATENT
Filed: March 15, 2010	:	PROSECUTION HIGHWAY
Attorney Docket No.: 2101-3795	:	PROGRAM AND PETITION
	:	TO MAKE SPECIAL UNDER
	:	37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed October 19, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the KIPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the KIPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the KIPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions from each of the KIPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
- (6) Applicant must submit an IDS listing the documents cited by the KIPO examiner in the KIPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Kenneth Wieder at 571-272-2986.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

/Kenneth A. Wieder/

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Kenneth Wieder  
Quality Assurance Specialist  
Technology Center 2600  
Communications

Doc Code: PPH.PCT.652

Document Description: Petition to make special under PCT-Patent Pros Hwy

PTO/SB/20PCT-JP (05-10)

Approved for use through 01/31/2012. OMB 0651-0058

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

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**REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION  
HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE JAPAN PATENT OFFICE (JPO) AND THE  
USPTO**

Application No:	12/678,223	Filing date:	September 5, 2008
First Named Inventor:	Jonathan Joachim Jodry		
Title of the Invention:	Processes for Production of 2-Bromo-2,2-Difluoroethanol and 2-(Alkylcarbonyloxy)-1,1-Difluoroethanesulfonic Acid Salt		

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE  
SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT  
HTTP://WWW.USPTO.GOV/EBC/EF5\_HELP.HTML**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE  
ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/JP2008/066041

**The international date of the corresponding PCT application(s) is/are:** September 5, 2008

**I. List of Required Documents:**

**a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**



Is attached.



Is not attached because the document is already in the U.S. application.

**b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**



Is attached.



Is not attached because the document is already in the U.S. application.

**c. English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

[Page 1 of 2]

This collection of information is required by 35 U.S.C. 119, 37 CFR 1.55, and 37 CFR 1.102(d). The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.

# **REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM BETWEEN THE JPO AND THE USPTO**

(continued)

Application No.:	12/678,223
First Named Inventor:	Jonathan Joachim Jodry
<p>d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.</p> <p><input checked="" type="checkbox"/> Is attached</p> <p><input checked="" type="checkbox"/> Has already been filed in the above-identified U.S. application on <u>March 15, 2010</u></p> <p>(2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)</p> <p><input checked="" type="checkbox"/> Are attached.</p> <p><input checked="" type="checkbox"/> Have already been filed in the above-identified U.S. application on <u>March 15, 2010</u></p>	

**II. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
1	1	Same or similar scope
2	2	Same or similar scope
3	3	Same or similar scope
4	4	Same or similar scope
5	5	Same or similar scope
6	6	Same or similar scope
7	7	Same or similar scope
8	8	Same or similar scope
9	9	Same or similar scope
10	10	Same or similar scope
11	11	Same or similar scope
12	12	Same or similar scope
13	13	Same or similar scope
15	15	Same or similar scope

III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.

*Yes. Claim 14 has been canceled in the Second Preliminary Amendment.*

Signature <i>Mary R. Bram</i>	Date <b>August 17, 2011</b>
Name (Print/Typed) <b>J.D. Evans/Mary R. Bram</b>	Registration Number <b>26,269/59,556</b>



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,223	09/28/2010	Jonathan Joachim Jodry	038788.62380US	6520
23911	7590	10/07/2011		
CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			EXAMINER WITHERSPOON, SIKARL A	
			ART UNIT	PAPER NUMBER
			1621	
			MAIL DATE	DELIVERY MODE
			10/07/2011	PAPER

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P.O. BOX 14300  
WASHINGTON, DC 20044-4300

In re Application of	:	DECISION ON REQUEST TO
JODRY ET AL.	:	PARTICIPATE IN PATENT
Application No. 12/678,223	:	PROSECUTION HIGHWAY
Filed: September 28, 2010	:	PROGRAM AND PETITION
Attorney Docket No. 038788.62380US	:	TO MAKE SPECIAL UNDER
	:	37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Cooperation Treaty - Patent Prosecution Highway (PCT-PPH) program and the petition under 37 CFR 1.102(a), filed August 17, 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH program and petition to make special require:

- (1) The U.S. application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national stage application that claims domestic/foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application;
- (2) The latest work product in the international phase of the PCT application corresponding to the U.S. application, namely the WO/ISA, or the WO/IPEA, or the IPER, indicates at least one claim in the PCT application has novelty, inventive step and industrial applicability;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to one or more of those claims indicated as having novelty, inventive step and industrial applicability and free of any observation described in Box VIII in the latest work product of the corresponding PCT application;
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of latest international work product, WO/ISA, or WO/IPEA or IPER, which indicated that the claim(s) has/have novelty, inventive step and industrial applicability along with an English translation thereof if the copy of the latest international work product is not in the English language;
- (6) Applicant must submit the claims from the corresponding PCT application which were indicated as having novelty, inventive step and industrial applicability in the latest work product

of the PCT application along with an English translation thereof and a statement that the English translation is accurate if the claims are not in the English language;

(7) Applicant must submit a claim correspondence table in English; and

(8) Applicant must submit an IDS listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the PCT application along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PCT-PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Cecilia Tsang at 571-272-0562.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system at the <http://www.uspto.gov/eac/index.html>.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

/Cecilia Tsang/  
Cecilia J. Tsang  
Supervisory Patent Examiner  
TC 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,223	09/28/2010	Jonathan Joachim Jodry	038788.62380US	6520
23911 7590 10/11/2011 CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			EXAMINER WITHERSPOON, SIKARL A	
			ART UNIT 1621	PAPER NUMBER
			MAIL DATE 10/11/2011	DELIVERY MODE PAPER

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In re Application of	:	DECISION ON REQUEST TO
JODRY et al.	:	PARTICIPATE IN PATENT
Application No. 12/678,223	:	PROSECUTION HIGHWAY
Filed: September 28, 2010	:	PROGRAM AND PETITION
Attorney Docket No. 038788.62380US	:	TO MAKE SPECIAL UNDER
	:	37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Cooperation Treaty - Patent Prosecution Highway (PCT-PPH) program and the petition under 37 CFR 1.102(a), filed August 17, 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH program and petition to make special require:

- (1) The U.S. application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national stage application that claims domestic/foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application;
- (2) The latest work product in the international phase of the PCT application corresponding to the U.S. application, namely the WO/ISA, or the WO/IPEA, or the IPER, indicates at least one claim in the PCT application has novelty, inventive step and industrial applicability;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to one or more of those claims indicated as having novelty, inventive step and industrial applicability and free of any observation described in Box VIII in the latest work product of the corresponding PCT application;
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of latest international work product, WO/ISA, or WO/IPEA or IPER, which indicated that the claim(s) has/have novelty, inventive step and industrial applicability along with an English translation thereof if the copy of the latest international work product is not in the English language;
- (6) Applicant must submit the claims from the corresponding PCT application which were indicated as having novelty, inventive step and industrial applicability in the latest work product

of the PCT application along with an English translation thereof and a statement that the English translation is accurate if the claims are not in the English language;

(7) Applicant must submit a claim correspondence table in English; and

(8) Applicant must submit an IDS listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the PCT application along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PCT-PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Cecilia Tsang at 571-272-0562.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system at the <http://www.uspto.gov/ebc/index.html>.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

/Cecilia Tsang/  
Cecilia J. Tsang  
Supervisory Patent Examiner  
TC 1600



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Browdy and Neimark, PLLC  
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Suite 1100  
Washington DC 20006

PCT LEGAL ADMINISTRATION

In re Application of: ABE, Hirohisa, et al.	:	
U.S. Application No.: 12/678,234	:	
PCT No.: PCT/EP2008/066611	:	DECISION ON PETITION UNDER
International Filing Date: 13 September 2008	:	37 CFR 1.137(b)
Priority Date: 14 September 2007	:	
Attorney's Docket No.: ABE8	:	
For: VEHICLE SEAT	:	

The petition for revival under 37 CFR 1.137(b) filed 28 February 2011 in the above-captioned application is hereby **GRANTED** as follows:

The present application became abandoned at midnight on 29 June 2010 due to applicants' failure to submit a proper response to the "Notification Of Missing Requirements" (Form PCT/DO/EO/905) mailed 29 April 2010. Such Notification required submission of an oath or declaration in compliance with 37 CFR 1.497, the surcharge for filing the oath or declaration later than thirty months after the priority date, and the search and examination fees.

The present petition was accompanied by the petition fee and the "required reply" in the form of an executed declaration in compliance with 37 CFR 1.497 and payment of the required surcharge and fees. In addition, the petition includes a statement that "the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional," satisfying the requirement of 37 CFR 1.137(b)(3).

Based on the above, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the present national stage application is appropriately granted.

This application is being referred to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 28 February 2011.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296

03 SEP 2010



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P.O. BOX 3001  
BRIARCLIFF MANOR NY 10510

In re Application of	:	
Adams	:	
Application No.: 12/678,346	:	DECISION
PCT No.: PCT/IB2008/053456	:	
Int. Filing Date: 27 August 2008	:	ON
Priority Date: 04 September 2007	:	
Attorney Docket No.: 008978US2	:	PETITION
For: Dual Mode Ultrasound Transducer	:	

The petition to revive under 37 CFR 1.137(b) filed on 16 March 2010 in the above-captioned application is hereby **GRANTED** as follows:

Petitioner states that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 C.F.R. § 1.137(b) was unintentional." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has paid the petition fee. The required reply has been filed. No terminal disclaimer is required. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the national stage in the United States of America.

Inspection of the declaration filed on 16 March 2010 reveals that it is directed toward prior provisional application 60/969,816, rather than the instant application (as identified by U.S. national stage serial number or by international application number). Hence, it is not acceptable for purposes of compliance with 37 CFR 1.497(a) and (b).

This application is being returned to the Office of Patent Application Processing for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283



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RENNER OTTO BOISSELLE & SKLAR, LLP  
1621 EUCLID AVENUE  
NINETEENTH FLOOR  
CLEVELAND OH 44115

In re Application of:	:	
BLANKENBORG, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 12/678,364	:	37 CFR 1.47(a)
PCT No.: PCT/NL2008/050609	:	
International Filing Date: 17 September 2008	:	
Priority Date: 17 September 2007	:	
Attorney Docket No.: PATEPO120WOUS	:	
For: METHOD AND DEVICE FOR DE-	:	
ACIDIFYING PAPER	:	

This decision is issued in response to applicants' petition under 37 CFR 1.47(a) filed 16 July 2010, and supplemented on 19 July 2010. Applicants have paid the required petition fee.

**BACKGROUND**

On 17 September 2008, applicants filed international application PCT/NL2008/050609. The international application claimed a priority date of 17 September 2007, and it designated the United States. On 26 March 2009, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 17 March 2010.

On 16 March 2010, applicants' filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and an unexecuted declaration.

On 05 May 2010, the United States Elected/Designated Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) requiring submission of a properly executed oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date.

On 16 July 2010, applicants filed a response to the Notification Of Missing Requirements (with required one-month extension fee). The response included a partially executed declaration and the petition under 37 CFR 1.47(a) considered herein. The petition requests acceptance of the application without the signature of co-inventor Maaïke Jacobine Esther VAN ROOSMALEN, whom applicants assert has refused to execute the declaration.

On 19 July 2010, applicant filed supplemental materials which were intended to be included with the original petition.

### DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have provided the required petition fee, and the petition states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by one of the two inventors of record, and the declaration includes an unsigned signature block for the non-signing inventor, Maaïke Jacobine Esther VAN ROOSMALEN. This declaration may be accepted as having been executed by the signing inventor on his own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute the application papers, "[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, as evidence of the inventor's refusal to execute the declaration, applicants have provided a statement from Gerald Megens, with accompanying exhibits. The statement provides firsthand evidence that a copy of the declaration was forwarded to the non-signing inventor via email and that, in response, the inventor subsequently telephoned Mr. Megens and refused to execute the declaration. However, the materials do not provide an acceptable showing that inventor was provided with a copy of the complete application, as required by the MPEP before it can be concluded that the inventor has refused to execute the present application. Before it can be concluded that the inventor has refused to execute the application, applicants must provide adequate supplemental materials, including a firsthand statement (with documentary support)

confirming that a request for signature, accompanied by a copy of the complete application, has been delivered to the non-signing inventor and that the inventor has refused to provide the requested signature in response to such request.

Based on the above, item (4) of a grantable petition under 37 CFR 1.47(a) is not satisfied on the present record.

### **CONCLUSION**

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy item (4) of a grantable petition, as discussed above and in the MPEP. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application.  
Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard M. Ross  
Attorney Advisor  
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NOV 17 2010

**PCT LEGAL ADMINISTRATION**

RENNER OTTO BOISSELLE & SKLAR, LLP  
1621 EUCLID AVENUE  
NINETEENTH FLOOR  
CLEVELAND OH 44115

In re Application of:	:	
BLANKENBORG, et al.	:	DECISION ON RENEWED
U.S. Application No.: 12/678,364	:	PETITION UNDER
PCT No.: PCT/NL2008/050609	:	37 CFR 1.47(a)
International Filing Date: 17 September 2008	:	
Priority Date: 17 September 2007	:	
Attorney Docket No.: PATEPO120WOUS	:	
For: METHOD AND DEVICE FOR DE-	:	
ACIDIFYING PAPER	:	

This decision is issued in response to applicants' "Renewed Petition Under 37 CFR §1.47(a)" filed 05 October 2010. No additional petition fee is required.

**BACKGROUND**

The procedural background for the present application was set forth in the decision mailed 09 August 2010. The decision dismissed without prejudice applicants' petition under 37 CFR 1.47(a), finding that applicants had not satisfied all the requirements of a grantable petition. Specifically, applicants had failed to provide an acceptable showing that the non-signing inventor refuses to execute the application or cannot be located after diligent effort.

On 05 October 2010, applicants filed the renewed petition considered herein.

**DISCUSSION**

The renewed petition filed by applicants on 05 October 2010 was accompanied by supplemental materials in support of the assertion that the inventor has refused to execute the present application. Specifically, applicants have provided a statement from Siang Lie Yeu, with supporting documents, confirming that the inventor was provided with a signature request accompanied by a copy of the complete application and that the inventor expressly indicated via email that he would not sign the declaration. These materials, in combination with those included with the original petition, provide an acceptable showing that the non-signing inventor has refused to execute the application. Applicants have therefore satisfied the final outstanding element of a grantable petition under 37 CFR 1.47(a). Accordingly, the petition is appropriately granted.

**CONCLUSION**

Applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

The application is accepted without the signature of non-signing co-inventor Maaïke Jacobine Esther VAN ROOSMALEN.

A notice of the acceptance of the application will be published in the Official Gazette, and a letter informing the non-signing inventor of the application will be forwarded to the address of the non-signing inventor, as set forth in the petition.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 16 July 2010.

/RichardMRoss/

Richard M. Ross  
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Maaïke Jacobine Esther VAN ROOSMALEN  
Markt 71a  
2611 GS Delft  
THE NETHERLANDS

**MAILED**

**NOV 17 2010**

**PCT LEGAL ADMINISTRATION**

In re Application of: BLANKENBORG, et al.  
U.S. Application No.: 12/678,364  
PCT No.: PCT/NL2008/050609  
International Filing Date: 17 September 2008  
Priority Date: 17 September 2007  
Attorney Docket No.: PATEPO120WOUS  
For: METHOD AND DEVICE FOR DE-ACIDIFYING PAPER

Dear Ms Van ROOSMALEN:

You are identified as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/RichardMRoss/

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Counsel Of Record:  
Heidi A. Boehlefeld  
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SUITE 1200  
WASHINGTON, DC 20005-4051

**MAILED**

**JAN 25 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of JORDAN et al	:	
U.S. Application No.: 12/678,378	:	
PCT Application No.: PCT/GB2008/003173	:	DECISION
Int. Filing Date: 19 September 2008	:	
Priority Date Claimed: 21 September 2007	:	
Attorney Docket No.: 010180.00074	:	
For: THIENOPYRIMIDINE COMPOUNDS	:	

This is in response to applicant's correspondence filed on 17 December 2010, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

**BACKGROUND**

On 19 September 2008, applicant filed international application PCT/GB2008/003173, which claimed priority of an earlier United Kingdom application filed 21 September 2007. A copy of the international application was communicated to the USPTO from the International Bureau on 26 March 2009. The thirty-month period for paying the basic national fee in the United States expired on 22 March 2010.

On 16 March 2010, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 03 May 2010, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 24 June 2010, applicant filed executed declarations.

On 10 December 2010, this Office mailed a communication which identified a discrepancy with regard to the name of one of the inventors.

On 17 December 2010, applicant filed the instant petition under 37 CFR 1.81.

### DISCUSSION

The declaration executed by fifth inventor lists the fifth inventor's given name as "Karine". However, the international application lists the fifth inventor's given name as "Karinne".

MPEP 1893.01(e) states in relevant part,

Where there has been no change of inventorship but the name of an inventor indicated in the international application during the international phase has changed such that the inventor's name is different from the corresponding name indicated in an oath or declaration submitted under 37 CFR 1.497, for example, on account of marriage, then a petition under 37 CFR 1.182 will be required to accept the oath or declaration with the changed name. See MPEP § 605.04(c). However, where the discrepancy between the name of the inventor indicated in the international application during the international phase and the name of the inventor as it appears in the oath or declaration submitted under 37 CFR 1.497 is the result of a typographical or transliteration error, then a petition under 37 CFR 1.182 will not be required. In such case, the Office should simply be notified of the error. Similarly, a typographical or transliteration error in the name of an inventor identified in a previously submitted oath or declaration may be corrected by simply notifying the Office of the error. A new oath or declaration is not required to correct such error. See MPEP § 201.03 and § 605.04(g).

The petition states that the given name of the fifth inventor is "Karine" as set forth in the declaration and that the discrepancy was the result of a typographical error in the international application. Applicant's explanation for the mistake is accepted.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 19 September 2008, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 24 June 2010.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a



Bryan Lin  
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**PCT LEGAL ADMINISTRATION**

LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD NJ 07090

In re Application of	:	
KRAMARSKY-WINTER et al.	:	
Application No.: 12/678,379	:	DECISION
PCT No.: PCT/IL2008/001236	:	
Int. Filing Date: 17 September 2008	:	
Priority Date: 17 September 2007	:	
Attorney Docket No.: REINHO 3.3-025	:	
For: METHOD FOR CORAL TISSUE	:	
CULTIVATION AND PROPAGATION	:	

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 26 August 2010 in the United States Patent and Trademark Office (USPTO). The petition is **DISMISSED** without prejudice.

**BACKGROUND**

On 17 September 2008, applicants filed international application PCT/IL2008/001236, which designated the United States and claimed a priority date of 17 September 2007. A copy of the international application was communicated from the International Bureau to the USPTO on 26 March 2009. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 March 2010.

On 16 March 2010, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 26 April 2010, the United States Designated/Elected Office (DO/EO/US) issued a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a two-month extendable period for response.

On 26 August 2010, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a two-month extension of time, a declaration of inventors, and a statement of facts by Shawn P. Foley with documentation in support thereof.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1), (3), and (4) have been satisfied.

Item (2) has not been satisfied. To establish a refusal to sign, it is required that the inventor be presented with the application papers (specification, including claims, drawings, and oath or declaration). See MPEP 409.03(d). "It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)." Here, it is not clear that Craig A. Downs was presented with a copy of the application papers. Although a copy of the specification including claims and drawings appears to have been sent via e-mail by Gillian Romano, there is no evidence that this e-mail was received by Mr. Downs. A copy of the application papers was also mailed by Mr. Foley via the United States Postal Service (USPS) using the Certified Mail Receipt service on 23 July 2010. However, this package was returned unclaimed. It is not clear why the package was unclaimed. It may be that Mr. Downs was on vacation or out of town. An inventor being out of town or on vacation is not an acceptable reason for filing under 37 CFR 1.47(a). (MPEP § 409.03(d), item I, states that the "fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.")

### CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT

Application No.: 12/678,379

-3-

Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
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PCT LEGAL ADMINISTRATION

LERNER, DAVID, LITTENBERG,  
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WESTFIELD NJ 07090

In re Application of	:	
KRAMARSKY-WINTER et al.	:	
Application No.: 12/678,379	:	DECISION
PCT No.: PCT/IL2008/001236	:	
Int. Filing Date: 17 September 2008	:	
Priority Date: 17 September 2007	:	
Attorney Docket No.: REINHO 3.3-025	:	
For: METHOD FOR CORAL TISSUE	:	
CULTIVATION AND PROPAGATION	:	

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 21 December 2010 in the United States Patent and Trademark Office (USPTO). The petition is **DISMISSED** without prejudice.

**BACKGROUND**

On 17 September 2008, applicants filed international application PCT/IL2008/001236, which designated the United States and claimed a priority date of 17 September 2007. A copy of the international application was communicated from the International Bureau to the USPTO on 26 March 2009. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 March 2010.

On 16 March 2010, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 26 April 2010, the United States Designated/Elected Office (DO/EO/US) issued a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a two-month extendable period for response.

On 26 August 2010, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a two-month extension of time, a declaration of inventors, and a statement of facts by Shawn P. Foley with documentation in support thereof.

On 21 October 2010, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.47(a).

On 21 December 2010, applicants filed the instant renewed petition under 37 CFR 1.47(a) with documentation in support thereof.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As noted in the decision mailed 21 October 2010, items (1), (3), and (4) have been satisfied.

Item (2) still has not been satisfied. To establish a refusal to sign, it is required that the inventor be presented with the application papers (specification, including claims, drawings, and oath or declaration). See MPEP 409.03(d). "It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)." It has not been established that non-signing inventor Craig A. Downs was presented with a copy of the application papers. The petition states that a copy of the application papers was sent to Mr. Downs on 17 November 2010. However, the copy of the cover letter accompanying the petition shows a letter sent to Mr. Downs dated 19 July 2010. A copy of the cover letter sent 17 November 2010 should be provided. Additionally, MPEP § 409.03(d) states in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

A statement of facts by the person who sent the application papers to Mr. Downs has not been provided.

### **CONCLUSION**

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

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Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
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PCT LEGAL ADMINISTRATION

LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD NJ 07090

In re Application of	:	
KRAMARSKY-WINTER et al.	:	
Application No.: 12/678,379	:	DECISION
PCT No.: PCT/IL2008/001236	:	
Int. Filing Date: 17 September 2008	:	
Priority Date: 17 September 2007	:	
Attorney Docket No.: REINHO 3.3-025	:	
For: METHOD FOR CORAL TISSUE	:	
CULTIVATION AND PROPAGATION	:	

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 28 February 2011 in the United States Patent and Trademark Office (USPTO). The petition is **GRANTED**.

**BACKGROUND**

On 17 September 2008, applicants filed international application PCT/IL2008/001236, which designated the United States and claimed a priority date of 17 September 2007. A copy of the international application was communicated from the International Bureau to the USPTO on 26 March 2009. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 March 2010.

On 16 March 2010, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 26 April 2010, the United States Designated/Elected Office (DO/EO/US) issued a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a two-month extendable period for response.

On 26 August 2010, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a two-month extension of time, a declaration of inventors, and a statement of facts by Shawn P. Foley with documentation in support thereof.

On 21 October 2010, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.47(a).

On 21 December 2010, applicants filed a renewed petition under 37 CFR 1.47(a) with documentation in support thereof.

On 31 January 2011, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.47(a).

On 28 February 2011, applicants filed the instant renewed petition under 37 CFR 1.47(a) including a statement of facts by Shawn P. Foley with documentation in support thereof.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As noted in the decision mailed 21 October 2010, items (1), (3), and (4) have been satisfied.

Item (2) has now been satisfied as well. It has been established that non-signing inventor Craig A. Downs was presented with a copy of the application papers. Mr. Downs' conduct constitutes a refusal to sign.

### **CONCLUSION**

For the reasons set forth above, applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to each of the non-signing inventors at their respective last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the

Application No.: 12/678,379

-3-

accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date and a 35 U.S.C. 371 date of **26 August 2010**.

/Daniel Stemmer/

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Legal Examiner  
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MAR 28 2011

PCT LEGAL ADMINISTRATION

Mr. Craig A. Downs  
488 Little Lake Lane  
Amherst, VA 24521

In re Application of  
KRAMARSKY-WINTER et al.  
Application No.: 12/678,379  
PCT No.: PCT/IL2008/001236  
Int. Filing Date: 17 September 2008  
Priority Date: 17 September 2007  
Attorney Docket No.: REINHO 3.3-025  
For: METHOD FOR CORAL TISSUE CULTIVATION AND PROPAGATION

Dear Mr. Downs:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/Daniel Stemmer/

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LERNER, DAVID, LITTENBERG,  
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10 AUG 2010

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35775  
DESIGN IP, P.C.  
5100 W. Tilghman Street, Suite 205  
Allentown, PA 18104

In re Application of :  
JAKES *et al* :  
U.S. Application No.: 12/678,415 :  
PCT No.: PCT/AT2008/000334 :  
Int. Filing Date: 16 September 2008 :  
Priority Date: 17 September 2007 :  
Attorney Docket No.: MAT-P0006 :  
For: APPARATUS FOR DETECTING THE :  
CONTENT OF A BOOK :

**DECISION ON  
PETITION  
UNDER 37 CFR 1.497(d)**

This is a decision on the request for correction of inventorship filed 02 June 2010 which is treated as a petition under 37 CFR 1.497(d).

**BACKGROUND**

On 16 March 2010, applicants filed papers to enter the national stage of PCT/AT2008/000334 which was accompanied by, *inter alia*, an executed declaration.

On 28 April 2010, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed stating that the current declaration did not comply with 37 CFR 1.497(a) & (b). The number of inventors recorded on the declaration was different from the number of inventors listed in the international application. Applicants were given two months to respond.

On 02 June 2010, applicants filed the subject request to correct inventorship which was accompanied by, *inter alia*, a statement from two inventors, a \$65.00 surcharge fee, a consent by the assignee, and authorization to charge any required fee to Deposit Account No. 50-3841.

**DISCUSSION**

Applicants request to add Vitus BOESCH and Sofie QUIDENUS as inventors in the above-captioned national stage application.

37 CFR 1.497(d) applies when the inventorship in a national stage application filed under 35 U.S.C. 371 differs from that set forth in the international application. 37 CFR 1.497(d) states, in part:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(l); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee.

Applicants provided a statement of the inventors being added. The \$130.00 processing fee has been charged to Deposit Account No. 50-3841 as authorized. A consent of assignee signed by the President of Quidenus GmbH was submitted. The position of President is presumed to have the authority to sign for a corporation. See MPEP § 324. A review of the application shows that an assignment to Quidenus GmbH was recorded in the subject application on 16 March 2010. The reel and frame number of the assignment required by 37 CFR 3.73(b) was provided in the consent.

All items of 37 CFR 1.497(d) are complete.

#### CONCLUSION

Applicants' request to add Vitus BOESCH and Sofie QUIDENUS as inventors in the above-captioned application pursuant to 37 CFR 1.497(d) is GRANTED.

The declaration filed 16 March 2010 is in compliance with 37 CFR 1.497(a)-(b).

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 16 September 2008 under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 16 March 2010.

This application is being forwarded to the DO/EO/US for further processing.



James Thomson  
Attorney Advisor

Office of PCT Legal Administration

Tel.: (571) 272-3302



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,424	03/16/2010	Hiroyuki Kumakura	144834	8355
<div>25944      7590      09/30/2010</div> <div>OLIFF &amp; BERRIDGE, PLC</div> <div>P.O. BOX 320850</div> <div>ALEXANDRIA, VA 22320-4850</div>				
			<div>EXAMINER</div> <div>ORLANDO, MICHAEL N</div>	
			<div>ART UNIT</div> <div>1791</div>	<div>PAPER NUMBER</div>
			<div>NOTIFICATION DATE</div> <div>09/30/2010</div>	<div>DELIVERY MODE</div> <div>ELECTRONIC</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com  
jarmstrong@oliff.com



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

CT

September 29, 2010

In re application of	:	DECISION ON REQUEST TO
Hiroyuki Kumakura	:	PARTICIPATE IN PATENT
Serial No. 12/678,424	:	PROSECUTION HIGHWAY
Filed: March 16, 2010	:	PROGRAM AND
For: ANISOTROPIC	:	PETITION TO MAKE SPECIAL
CONDUCTIVE ADHESIVE	:	UNDER 37 CFR 1.102(a)

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed July 30, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, USPTO or KIPO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) Applicant must submit a claims correspondence table in English and all the independent claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;
- (6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial

Application No. 12/678,424

applicability along with an English translation thereof if the latest international work product is not in the English language;

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications; and

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Christine Tierney/

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Christine Tierney  
Quality Assurance Specialist  
Technology Center 1700

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE EUROPEAN PATENT OFFICE (EPO) AND THE USPTO

Application No:	12/678,485	Filing date:	March 16, 2010
First Named Inventor:	Richard Fiebelkorn		

Title of the  
Invention: Smoking article with modified smoke delivery

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT  
[HTTP://WWW.USPTO.GOV/EBS/DFS\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

The corresponding PCT  
application number(s) is/are: PCT/EP2008/062429

The international filing date of the corresponding  
PCT application(s) is/are: September 18, 2008

## I. List of Required Documents:

- a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)



Is attached



Is not attached because the document is already in the U.S. application.

- b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).



Is attached.



Is not attached because the document is already in the U.S. application.

- c. English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM  
BETWEEN THE EPO AND THE USPTO**

(continued)

Application No.:	12/678,485
First Named Inventor:	Richard Fiebelkorn

- d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

☐

Is attached

☒Has already been filed in the above-identified U.S. application on March 16, 2010

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)

☐

Are attached.

☒Have already been filed in the above-identified U.S. application on March 16, 2010**II. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
1 and 24	1 and 24	Direct correspondence
2-4, 6, 11-12, 14, 20-21, 23	2-4, 6, 11-12, 14, 20-21, 23	Direct correspondence with clarifying changes made to US claims
5, 7-10, 15-19, 22	5, 7-10, 15-19, 22	Multiple dependency of PCT has been removed from US claims
13 and 49	13	US claim 49 was added for clarification, and US claim 13 depends from US claim 49
25	25	Direct correspondence with clarifying changes made to US claims
26 and 50	26	US claim 50 was added for clarification, and US claim 26 depends from US claim 50
27-28, 30, 32-35, 40-47	27-28, 30, 32-35, 40-47	Multiple dependency of PCT has been removed from US claims
29, 31, 48	29, 31, 48	Direct correspondence with clarifying changes made to US claims
36-39	36-39	Correction/clarification of dependency was made to US claims

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature <u>/Walter G. Hanchuk/</u>	Date <u>August 15, 2011</u>
Name (Print/Typed) <u>Walter G. Hanchuk</u>	Registration Number <u>35,179</u>

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant ( *i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.


# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference <b>MCR/54556PCT1</b>		<b>FOR FURTHER ACTION</b>	See Form PCT/PEAA16
International application No. <b>PCT/EP2008/062429</b>	International filing date (day/month/year) <b>18.09.2008</b>	Priority date (day/month/year) <b>20.09.2007</b>	
International Patent Classification (IPC) or national classification and IPC <b>INV. A24D102</b>			
Applicant <b>British American Tobacco (Investments) Ltd</b>			
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>4</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input checked="" type="checkbox"/> sent to the applicant and to the International Bureau a total of <u>7</u> sheets, as follows:</p> <p><input checked="" type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in electronic form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>			
<p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the report</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input checked="" type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>			
Date of submission of the demand <b>2009-07-20</b>		Date of completion of this report <b>03.11.2009</b>	
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399-0 Fax: +49 89 2399-4465		Authorized officer <b>Marzano Monterosso</b> Telephone No. +49 89 2399-2902	



**INTERNATIONAL PRELIMINARY REPORT  
ON PATENTABILITY**

International application No.  
PCT/EP2008/062429

**Box No. I Basis of the report**

1. With regard to the language, this report is based on
- ☒ the international application in the language in which it was filed
  - ☐ a translation of the international application into , which is the language of a translation furnished for the purposes of:
    - ☐ international search (under Rules 12.3(a) and 23.1(b))
    - ☐ publication of the international application (under Rule 12.4(a))
    - ☐ international preliminary examination (under Rules 55.2(a) and/or 55.3(a))
2. With regard to the **elements\*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):*

**Description, Pages**

1-16 as originally filed

**Claims, Numbers**

1-48 filed with telefax on

20-07-2009

**Drawings, Sheets**

1/3-3/3 as originally filed

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages
  - ☐ the claims, Nos.
  - ☐ the drawings, sheets/figs
  - ☐ the sequence listing (*specify*):
  - ☐ any table(s) related to sequence listing (*specify*):
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages
  - ☐ the claims, Nos.
  - ☐ the drawings, sheets/figs
  - ☐ the sequence listing (*specify*):
  - ☐ any table(s) related to sequence listing (*specify*):
5. ☐ This opinion has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 70.2 (e)).
6. ☐ Supplementary international search report(s) from Authority(ies) have been received and taken into account in drawing up this report (Rule 45bis.8(b) and (c)).

**INTERNATIONAL PRELIMINARY REPORT  
ON PATENTABILITY**

International application No.  
PCT/EP2008/062429

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**Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

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1. Statement

Novelty (N)	Yes: Claims	<u>1-48</u>
	No: Claims	
Inventive step (IS)	Yes: Claims	<u>1-48</u>
	No: Claims	
Industrial applicability (IA)	Yes: Claims	<u>1-48</u>
	No: Claims	

2. Citations and explanations (Rule 70.7):

see separate sheet

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**Box No. VII Certain defects in the international application**

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The following defects in the form or contents of the international application have been noted:

see separate sheet

**INTERNATIONAL PRELIMINARY  
REPORT ON PATENTABILITY  
(SEPARATE SHEET)**

International application No.

PCT/EP2008/062429

**Re Item V**

**Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1 Reference is made to the following documents:

D1 US 3 606 892 A (WILSON GERALD M) 21 September 1971 (1971-09-21)

D4 EP 1 475 003 A (JAPAN TOBACCO INC [JP]) 10 November 2004  
(2004-11-10)

2 Document D1, which is considered to represent the most relevant state of the art, discloses (cf. fig. 1, col. 3, l. 36-45) a smoking article from which the subject-matter of claim 1 differs in that the patch of material disposed between the wrapper and the tobacco rod includes a burn-enhancer.

The subject-matter of claim 1 is therefore new (Article 33(2) PCT).

The problem to be solved by the present invention may be regarded as tailoring the static burn rate and thus the number of puffs that can be taken from the latter part of the smoking article (see p. 3, l. 25-28).

The solution to this problem proposed in claim 1 of the present application is considered as involving an inventive step (Article 33(3) PCT) for the following reasons: the use of a burn-enhancer in the patch of material is not disclosed in any of the documents of the available prior art.

Burn-enhancers per se are known in the art (see e.g. D4, disclosing a wrapper with burn promoting agents), but the use of such burn-enhancers in the patch of material as disclosed in D1 in order to arrive to the claimed subject matter can be thought of only in presence of an inventive step.

3 For the same reasons as stated above the subject matter of corresponding independent method claim 24 is considered novel and inventive

4 Claims 2-23 and 25-48 are dependent on claims 1 and 24 respectively and as such also meet/s the requirements of the PCT with respect to novelty and inventive step.

**Re Item VII**

**Certain defects in the international application**

5 The features of the claims are not provided with reference signs placed in parentheses (Rule 6.2(b) PCT).

6 The description is not adapted to the new independent claims.

-1-

CLAIMS

1. A smoking article comprising:  
a tobacco rod;  
5 a wrapper around the tobacco rod; and  
a patch of material positioned between the tobacco rod and the wrapper and  
extending longitudinally along the tobacco rod from an intermediate point along the  
tobacco rod towards a mouth end of the tobacco rod, the material having structure  
such that the patch provides a path for smoke from tobacco upstream of the patch  
10 towards the mouth end that has less resistance to smoke flow than a path through the  
tobacco under the patch, and wherein the patch comprises at least one burn-enhancer  
to increase the static burn rate of the smoking article over the length comprising the  
patch.
- 15 2. A smoking article according to claim 1, in which the patch extends  
longitudinally from the intermediate point to the mouth end of the tobacco rod.
3. A smoking article according to claim 1, in which the patch extends  
longitudinally from the intermediate point to a second point between the intermediate  
20 point and the mouth end.
4. A smoking article according to claim 3, in which the second point is between  
1% and 40% of the total length of the tobacco rod from the mouth end.
- 25 5. A smoking article according to any one of claims 1 to 4, in which the patch  
extends longitudinally over substantially 10% to 90% of the total length of the tobacco  
rod.

-2-

6. A smoking article according to claim 5, in which the patch extends longitudinally over substantially 40% to 80% of the total length of the tobacco rod.
7. A smoking article according to any one of claims 1 to 6, in which the patch  
5 extends substantially around the whole circumference of the tobacco rod.
8. A smoking article according to any one of claims 1 to 6, in which the patch comprises one or more portions of material disposed around the circumference of the tobacco rod.
- 10
9. A smoking article according to any one of claims 1 to 8, in which the patch comprises a foam material.
10. A smoking article according to any one of claims 1 to 8, in which the patch  
15 comprises a corrugated material having corrugations that extend substantially longitudinally along the tobacco rod.
11. A smoking article according to claim 10, in which the corrugated material has a laminate structure comprising a corrugated layer and a non-corrugated layer.
- 20
12. A smoking article according to claim 11, in which the non-corrugated layer is positioned between the tobacco rod and the corrugated layer.
13. A smoking article according to claim 11, in which the non-corrugated layer is  
25 positioned between the corrugated layer and the paper wrapper.

-3-

14. A smoking article according to claim 10, in which the corrugated material has a laminate structure comprising a corrugated layer sandwiched between two non-corrugated layers.
- 5 15. A smoking article according to any one of claims 1 to 8, in which the patch comprises an embossed material having indentations that extend substantially longitudinally along the tobacco rod.
- 10 16. A smoking article according to any one of claims 1 to 8, in which the patch comprises a grooved material having grooves that extend substantially longitudinally along the tobacco rod.
17. A smoking article according to any one of claims 1 to 8, in which the patch comprises a fibrous sheet material.
- 15 18. A smoking article according to any one of claims 1 to 17, in which the patch has a different colour from the wrapper and/or the tobacco rod.
- 20 19. A smoking article according to any one of claims 1 to 18, in which the tobacco rod has a reduced weight of tobacco per unit length under the patch compared to upstream of the patch.
- 25 20. A smoking article according to claim 19, in which the reduced weight is created by trimming tobacco from the outside of the tobacco rod.
21. A smoking article according to claim 19, in which the reduced weight is created by trimming tobacco from a tobacco bead from which the tobacco rod is to be cut.

-4-

22. A smoking article according to any one of claims 1 to 21, in which the smoking article further comprises a filter unit attached to the mouth end of the tobacco rod.

23. A smoking article according to claim 22, in which the filter unit is provided with one or more ventilation holes.

24. A method of fabricating a smoking article comprising:  
providing a rod of tobacco;

disposing a patch of material over the rod of tobacco such that the patch extends longitudinally along the rod from an intermediate point along the rod towards a mouth end of the rod, the material having a structure and the patch being oriented such that, in the completed smoking article, the patch provides a path for smoke from tobacco upstream of the patch towards the mouth end that has less resistance to smoke flow than a path through the tobacco under the patch, wherein the patch comprises at least one burn-enhancer to increase the static burn rate of the smoking article over the length comprising the patch; and

wrapping a wrapper around the rod.

25. A method according to claim 24, in which disposing the patch of material comprises positioning the patch on the rod of tobacco before wrapping the wrapper around the rod.

26. A method according to claim 24, in which disposing the patch of material comprises adhering the patch to an inner surface of the paper wrapper before wrapping the wrapper around the rod.

-5-

27. A method according to any one of claims 24 to 26, in which the patch extends longitudinally from the intermediate point to the mouth end of the rod of tobacco.
28. A method according to any one of claims 24 to 26, in which the patch extends  
5 longitudinally from the intermediate point to a second point between the intermediate point and the mouth end.
29. A method according to claim 28, in which the second point is between 1% and 40% of the total length of the rod of tobacco from the mouth end.
- 10 30. A method according to any one of claims 24 to 29, in which the patch extends longitudinally over substantially 10% to 90% of the total length of the rod.
31. A method according to claim 30, in which the patch extends longitudinally  
15 over substantially 40% to 80% of the total length of the rod.
32. A method according to any one of claims 24 to 31, in which the patch extends substantially around the whole circumference of the rod of tobacco.
- 20 33. A method according to any one of claims 24 to 31, in which the patch comprises one or more portions of material disposed around the circumference of the rod of tobacco.
34. A method according to any one of claims 24 to 33, in which the patch  
25 comprises a foam material.

-6-

35. A method according to any one of claims 24 to 33, in which the patch comprises a corrugated material having corrugations, the patch being disposed such that the corrugations extend substantially longitudinally along the rod of tobacco.
- 5 36. A method according to claim 37, in which the corrugated material has a laminate structure comprising a corrugated layer and a non-corrugated layer.
37. A method according to claim 38, in which the patch is disposed such that the non-corrugated layer is positioned between the tobacco rod and the corrugated layer.
- 10 38. A method according to claim 38, in which patch is disposed such that the non-corrugated layer is positioned between the corrugated layer and the paper wrapper.
39. A method according to claim 37, in which the corrugated material has a laminate structure comprising a corrugated layer sandwiched between two non-corrugated layers.
- 15 40. A method according to any one of claims 24 to 33, in which the patch comprises an embossed material, the patch disposed such that indentations in the material extend substantially longitudinally along the rod of tobacco.
- 20 41. A method according to any one of claims 24 to 33, in which the patch comprises a grooved material, the patch disposed such that the grooves extend substantially longitudinally along the rod of tobacco.
- 25 42. A method according to any one of claims 24 to 33, in which the patch comprises a fibrous sheet material.

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43. A method according to any one of claims 24 to 42, in which the patch has a different colour from the paper wrapper and/or the rod of tobacco.
44. A method according to any one of claims 24 to 43, in which the rod of tobacco  
5 has a reduced weight of tobacco per unit length under the patch compared to upstream of the patch.
45. A method according to any of claims 24 to 44, comprising:  
trimming tobacco from the outside of the rod of tobacco over an area where the  
10 patch is to be disposed, thereby creating the reduced weight; and  
disposing the patch over the rod of tobacco so that the patch covers the area from which tobacco has been trimmed.
46. A method according to any of claims 24 to 44, comprising:  
15 trimming tobacco from the outside of a bead of tobacco over an area where the patch is to be disposed, thereby creating the reduced weight;  
cutting a rod of tobacco from the bead; and  
disposing the patch over the rod of tobacco so that the patch covers the area from which tobacco has been trimmed.
- 20 47. A method according to any one of claims 24 to 46, further comprising attaching a filter unit to the smoking article.
48. A method according to claim 47, in which the filter unit is provided with one  
25 or more ventilation holes.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,485	07/02/2010	Richard Fiebelkorn	17132-143US	9146
54205 7590 10/14/2011 CHADBOURNE & PARKE LLP 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER MAYES, DIONNE WALLS	
			ART UNIT 1747	PAPER NUMBER
			NOTIFICATION DATE 10/14/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents@chadbourn.com



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WG

OCT 14 2011

In re application of	:	DECISION ON REQUEST TO
Richard Fiebelkorn	:	PARTICIPATE IN PATENT
Serial No. 12/678,485	:	PROSECUTION HIGHWAY
Filed: July 2, 2010	:	PROGRAM AND
For: SMOKING ARTICLE WITH MODIFIED	:	PETITION TO MAKE SPECIAL
SMOKE DELIVERY	:	UNDER 37 CFR 1.102(a)

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed August 15, 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, KIPO or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;
- (6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial

Application No. 12/678,485

applicability along with an English translation thereof if the latest international work product is not in the English language; and

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Walter D. Griffin, Supervisory Patent Examiner, at (571) 272-1447.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

Walter D. Griffin/

---

Walter D. Griffin  
Supervisory Patent Examiner  
Technology Center 1700 --

## REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE KOREAN INTELLECTUAL PROPERTY OFFICE (KIPO) AND THE USPTO

Application No:	12/678,486	Filing date:	
First Named Inventor:			
Title of the Invention:			

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBS/DFS\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/US10/24495

**The international date of the corresponding PCT application(s) is/are:** February 17, 2010

### I. List of Required Documents:

- a. **A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**

☐

Is attached.

☒

Is not attached because the document is already in the U.S. application.

- b. **A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**

☐

Is attached.

☒

Is not attached because the document is already in the U.S. application.

- c. **English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

(continued)

Application No.:	
First Named Inventor:	

- 9

Is attached

October 25, 2010

- ☐

Has already been filed in the above-identified U.S. application on

- ☐

Are attached.

October 25, 2010

Have already been filed in the above-identified U.S. application on

## II. Claims Correspondence Table:

[illegible]

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature    /s/	Date    October 25, 2010
Name (Print/Typed)    Carl Oppedahl	Registration Number    32746



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,486	03/16/2010	Ioannis Milios	SNDN.P-007-NP	9167

57380 7590 01/26/2011

Oppedahl Patent Law Firm LLC  
P O Box 5940  
Dillon, CO 80435-5940

EXAMINER
----------

ASSOUAD, PATRICK J

ART UNIT	PAPER NUMBER
2858	

NOTIFICATION DATE	DELIVERY MODE
01/26/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket-oppedahl@oppedahl.com  
mail-log@oppedahl.com



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Alexandria, VA 22313-1450  
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**Oppedahl Patent Law Firm LLC  
P O Box 5940  
Dillon CO 80435-5940**

**In re Application of  
Ioannis MILIOS  
Application No.: 12/678,486  
Filed: 16 March 2010  
Attorney Docket No.: SNDN.P-007-NP  
For: BATTERY CELL PROTECTION  
AND CONDITIONING CIRCUIT AND  
SYSTEM**

**: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)**

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed 28 October 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, KIPO, or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;
- (6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability

along with an English translation thereof and a statement that the English translation is accurate if the latest international work product is not in the English language;

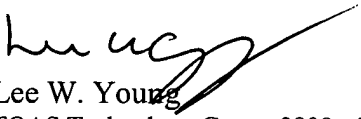
(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PCT-PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Lee W. Young at 571-272-4549.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

This application will be forwarded to the examiner for action on the merits commensurate with this decision once this application's formality reviews have been completed.

  
Lee W. Young  
TQAS Technology Center 2800 - Semiconductors,  
Electrical & Optical Systems & Components

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE KOREAN INTELLECTUAL PROPERTY OFFICE (KIPO) AND THE USPTO

Application No:	12/678500	Filing date:	03-SEP-2008
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First Named Inventor:	Perecman, Jack L.
-----------------------	-------------------

Title of the Invention:	Applicator Portion of a Lined Tape Applicator
----------------------------	---

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBS/EF5\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/US2008/075095

**The international date of the corresponding PCT application(s) is/are:** 3 September 2008

## I. List of Required Documents:

- a. **A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**



Is attached.



Is not attached because the document is already in the U.S. application.

- b. **A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**



Is attached.



Is not attached because the document is already in the U.S. application.

- c. **English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

## REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM BETWEEN THE KIPO AND THE USPTO

(continued)

Application No.:	12/678500
------------------	-----------

First Named Inventor:	Perecman, Jack L.
-----------------------	-------------------

- d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

Is attached

Has already been filed in the above-identified U.S. application on 11-08-10

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)**

Are attached.

Have already been filed in the above-identified U.S. application on 11-08-10

## II. Claims Correspondence Table:

[illegible]

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

## REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM BETWEEN THE KIPO AND THE USPTO

(continued)

Application No.:	12/678500
------------------	-----------

First Named Inventor:	Perecman, Jack L.
-----------------------	-------------------

## II. Claims Correspondence Table:

[illegible]

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature /Thomas M. Spielbauer/

Date **Nov. 12, 2010**

Name **Thomas M. Spielbauer**  
(Print/Typed)

Registration Number 58,492



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,500	06/24/2010	Jack L. Perecman	63602US004	9322

32692	7590	02/01/2011
3M INNOVATIVE PROPERTIES COMPANY		
PO BOX 33427		
ST. PAUL, MN 55133-3427		

EXAMINER	
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ART UNIT	PAPER NUMBER
1745	

NOTIFICATION DATE	DELIVERY MODE
02/01/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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LegalDocketing@mmm.com



UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

CT

January 31, 2011

In re application of	:	DECISION ON REQUEST TO
Jack Perecman	:	PARTICIPATE IN PATENT
Serial No. 12/678,500	:	PROSECUTION HIGHWAY
Filed: June 24, 2010	:	PROGRAM AND
For: APPLICATOR PORTION OF A	:	PETITION TO MAKE SPECIAL
LINERED TAPE APPLICATOR	:	UNDER 37 CFR 1.102(a)

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed November 12, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, USPTO or KIPO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) Applicant must submit a claims correspondence table in English and all the independent claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;
- (6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial

Application No. 12/678,500

applicability along with an English translation thereof if the latest international work product is not in the English language; and

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

It is noted that applicant has only supplied the International Search Report in support of this PPH petition, however a copy of the Written Opinion of the ISA was obtained via the WIPO's website. Applicant is reminded that in future submissions, applicant may not file a request to participate in the PCT-PPH pilot program on the basis of an International Search Report (ISR) only.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Christine Tierney/

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Christine Tierney  
Quality Assurance Specialist  
Technology Center 1700

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE KOREAN INTELLECTUAL PROPERTY OFFICE (KIPO) AND THE USPTO

Application No:	12/678503	Filing date:	24-JUL-2008
First Named Inventor:	Perecman, Jack L.		
Title of the Invention:	Linered Tape Applicator		

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBS/DFS\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/US2008/070973

**The international date of the corresponding PCT application(s) is/are:** 24 JULY 2008

## I. List of Required Documents:

- a. **A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**

☒

Is attached.

☐

Is not attached because the document is already in the U.S. application.

- b. **A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**

☒

Is attached.

☐

Is not attached because the document is already in the U.S. application.

- c. **English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

## REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM BETWEEN THE KIPO AND THE USPTO

Application No.:	12/678503
First Named Inventor:	Perecman, Jack L.

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Have already been filed in the above-identified U.S. application on 8-3-10 and 10-28-10

[illegible]

Signature <u>/Thomas M. Spielbauer/</u>	Date <u>October 27, 2010</u>
Name (Print/Typed) <u>Thomas M. Spielbauer</u>	Registration Number <u>58,492</u>



# UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,503	06/29/2010	Jack L. Perecman	63195US005	9339
32692 7590 01/11/2011 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER	
			ART UNIT	PAPER NUMBER
			1746	
			NOTIFICATION DATE	DELIVERY MODE
			01/11/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com  
LegalDocketing@mmm.com



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[www.uspto.gov](http://www.uspto.gov)

BC

January 10, 2011

In re application of	:	DECISION ON REQUEST TO
Jack L. Perecman	:	PARTICIPATE IN PATENT
Serial No. 12/678,503	:	PROSECUTION HIGHWAY
Filed: March 17, 2010	:	PROGRAM AND
For: LINERED TAPE APPLICATOR	:	PETITION TO MAKE SPECIAL
	:	UNDER 37 CFR 1.102(a)

This is a decision on the request for reconsideration to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed October 28, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, KIPO or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;
- (6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof if the latest international work

Application No. 12/678,503

product is not in the English language; and

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

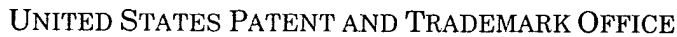
Any inquiry regarding this decision should be directed to Blaine Copenheaver, Quality Assurance Specialist, at (571) 272-1156.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Blaine Copenheaver/

---

Blaine Copenheaver  
Quality Assurance Specialist  
Technology Center 1700



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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

T. Daniel Christenbury  
IP GROUP OF DLA PIPER LLP (US)  
One Liberty Place  
1650 Market St., Suite 4900  
Philadelphia, PA 19103

MAILED

MAR 23 2011

PGT LEGAL ADMINISTRATION

**MAILED**

MAR 23 2011

PCT LEGAL ADMINISTRATION

In re Application of: EISSLER, Dieter  
U.S. Application No.: 12/678,511  
PCT No.: PCT/DE2008/001513  
International Filing Date: 09 September 2008  
Priority Date: 28 September 2007  
Atty's Docket No.: EHF-10-1084  
For: ARRANGEMENT COMPRISING AN  
OPTOELECTRONIC COMPONENT

DECISION

UNDER

37 CFR 1.181

This decision is issued in response to applicant's "REQUEST FOR CORRECTED FILING RECEIPT AND NOTICE OF ACCEPTANCE OF APPLICATION" filed 02 June 2010, which has been treated as a petition under 37 C.F.R. 1.181. No petition fee is required.

## BACKGROUND

On 17 March 2010, applicant filed National Phase application papers requesting entry into the national phase in the United States of America under 35 U.S.C. 371.

On 18 May 2010, the United States Designated/Elected Office (DO/EO/US) mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) and Filing Receipt that identified 17 March 2010 as a 371 (c)(1), (c)(2), and (c)(4) date.

On 02 June 2010, applicant filed the instant “petition” requesting correction of 371(c) date and date of receipt of 371(c) requirement on the Filing Receipt and Notice of Acceptance, respectively, from 03/17/2010 to 04/12/2010.

## DISCUSSION

A review of the application file reveals that the applicant did not file an oath or declaration when requesting entry into the national phase in the United States of America under 35 U.S.C. 371 on 17 March 2010. On 12 April 2010, applicant electronically filed a Combined Declaration, Power of Attorney and Petition via EFS-Web with \$130 surcharge for late

submission of the declaration. Therefore, the correction of the 35 U.S.C. 371 date to 12 April 2010 is proper since applicant completed the requirements set forth in 35 U.S.C. 371(c) on 12 April 2010. (See MPEP section 1893.03(b)).

### **CONCLUSION**

Applicant's petition under 37 CFR 1.181 is **GRANTED**.


The "Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495" and Filing Receipt mailed on 18 May 2010 are hereby **VACATED**.

The application has an international filing date of 09 September 2008 under 35 U.S.C. 363 and a date of 12 April 2010 under 35 U.S.C. 371 (c)(1), (c)(2), and (c)(4).

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision, that is, for mailing of a Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) which identifies a date of 12 April 2010 under 35 U.S.C. 371 (c)(1), (c)(2), and (c)(4) and preparation and mailing of a corrected Filing Receipt in accordance with this decision, that is a filing receipt that identifies a 371 (c)(1), (c)(2), and (c)(4) date of 12 April 2010.



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PCT Legal Examiner  
Office of PCT Legal Administration



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19 AUG 2010

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Leydig, Voit and Mayer  
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Chicago IL 60601

In re Application of :  
BERT et al. :  
U.S. Application No.: 12/678,562 :  
PCT No.: PCT/EP2008/008169 :  
Int. Filing Date: 25 September 2008 :  
Priority Date: 25 September 2007 :  
Attorney Docket No.: 811592 :  
For: METHOD AND APPARATUS FOR :  
IRRADIATION OF A MOVING TARGET :  
VOLUME :

DECISION ON PETITION

This decision is issued in response to applicants' "Response to Notification of Defective Response" filed 22 July 2010, treated herein as a petition under 37 CFR §1.182. Applicants are requesting to change the name of the fourth inventor from Alexander Schmidt to Alexander Gemmel due to marriage. The petition was accompanied by an affidavit signed by Alexander Gemmel using both his former name and present name. The \$400 petition fee under 37 CFR 1.17 has been submitted.

**DISCUSSION**

Section 605.04(b) of the Manual of Patent Examining Procedure states that:

Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 35 U.S.C. 1.182 together with an appropriate petition fee.

Applicants are requesting to change the name of the fourth inventor from Alexander Schmidt to Alexander Gemmel. Accordingly, the present submission has been treated as a petition under 37 CFR 1.182 to correct the name of the fourth inventor. For such a petition to be grantable, MPEP §605.04(c) states that "the petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order."

Here, applicant's submission included the authorization to charge Deposit Account No. 12-1216 for required fees. Based on this authorization, the Deposit Account will be charged the requisite petition fee of \$400. As for the affidavit requirement, applicants have submitted a "Declaration of Alexander Gemmel" regarding the name change. This affidavit states that the inventor's surname was changed, and that her name was legally changed to Alexander Gemmel as a result of marriage.

### CONCLUSION

The petition under 37 CFR 1.182 to change the inventor's name from Alexander Schmidt to Alexander Gemmel is **GRANTED**.

Based on the above, the declaration filed 24 June 2010 is in compliance with 37 CFR 1.497.

This application is being referred to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accordance with this decision. of the letter marked to the attention of the Office of PCT Legal Administration.



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PCT LEGAL ADMINISTRATION

In re Application of	:	
ALEXANDER, Samuel Wayne, et al.	:	DECISION
Application No.: 12/678,570	:	
PCT No.: PCT/US2008/076742	:	ON PETITION UNDER
Int. Filing Date: 17 September 2008	:	
Priority Date: 17 September 2007	:	37 CFR 1.47(a) AND
Docket No.: 0677-032	:	
For: METHODS AND SYSTEMS FOR	:	REQUEST FOR STATUS
MANAGEMENT OF IMAGE-BASED	:	
PASSWORD ACCOUNTS	:	UNDER 37 CFR 1.42

This is a decision on applicants' Petition Under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 15 November 2010. A review of the application papers indicates that inventor Lee is deceased. This petition is also being treated as a request for status under 37 CFR 1.42.

**BACKGROUND**

On 14 May 2010, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors and the surcharge for late filing of the search fee; examination fee or oath or declaration were required.

On 15 November 2010, applicants filed this petition under 37 CFR 1.47(a), accompanied by declarations executed by five joint inventors.

**DISCUSSION**

**REQUEST UNDER 37 CFR 1.42**

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 C.F.R. 1.42.

The declaration does not comply with 37 CFR 1.497(a)-(b) and 37 CFR 1.42. The declaration lists neither the deceased inventor nor his legal representative.

**PETITION UNDER 37 CFR 1.47(a)**

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor,

and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Item (1) has been met. The \$200 petition fee has been paid.

Item (2) has not been satisfied. Applicants allege that the nonsigning inventors could not be located after a diligent effort. Applicants do not indicate that they have even sent a complete copy of the application papers including the declaration to each of the last known addresses. The basis for the allegation that the inventors could not be reached after a *diligent* effort is entirely unclear.

Item (3) has not been satisfied. Applicants state the last known addresses for inventors Sontag, Osborn and Stover. Applicants have not identified inventor Lee's legal representative and the legal representative's last known address. If a legal representative was appointed for inventor Lee and has been discharged, appointment of a new legal representative is required. MPEP 409.01(c).

Item (4) has not been satisfied. The declaration does not comply with 37 CFR 1.497(a). It fails to list inventor Lee and his citizenship. Further, none of the copies of the declaration list the inventor Lee's legal representative and his/her mailing address, residence and citizenship. The declaration must comply 37 CFR 1.42, 1.47(a) and 37 CFR 1.497(a)-(b). Further, any alterations to the text of the declaration must be made prior to execution by the inventors and must be initialed and dated. New oaths or declarations are required.

### CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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PCT LEGAL ADMINISTRATION

In re Application of	:	
ALEXANDER, Samuel Wayne, et al.	:	DECISION
Application No.: 12/678,570	:	
PCT No.: PCT/US2008/076742	:	ON PETITION UNDER
Int. Filing Date: 17 September 2008	:	
Priority Date: 17 September 2007	:	37 CFR 1.47(a) AND
Docket No.: 0677-032	:	
For: METHODS AND SYSTEMS FOR	:	REQUEST FOR STATUS
MANAGEMENT OF IMAGE-BASED	:	
PASSWORD ACCOUNTS	:	UNDER 37 CFR 1.42

This is a decision on applicants' renewed Petition Under 37 CFR 1.47(a) and request for status under 37 CFR 1.42, filed in the United States Patent and Trademark Office (USPTO) on 11 March 2011.

**BACKGROUND**

On 14 January 2011, the Office mailed Decision on Petition Under 37 CFR 1.47(a) and Request for Status under 37 CFR 1.42.

On 11 March 2011, applicants filed this renewed petition under 37 CFR 1.47(a) and request for status under 37 CFR 1.42.

**DISCUSSION**

The petition under 37 CFR 1.47(a) is moot as to inventors Stover and Sontag and as to the legal representative of inventor Lee, who are cooperating with the filing. However, the petition is still appropriate as to inventor Osborn.

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1) and (3) have been satisfied.

Item (2) has not been satisfied. The declaration sent to inventor Osborn was defective. It failed to state the correct inventive entity, as it omitted inventor Lee and his citizenship. The inventor must be presented with a complete copy of accurate application papers, including the declaration.

Item (4) has not been satisfied. The declarations of the inventors must list all the inventors and their citizenships. 37 CFR 1.497. The declarations executed by the signing inventors do not list inventor Lee or his citizenship. New oaths or declarations in compliance with 37 CFR 1.497(a)-(b) and an explanation from each of the signing inventors as to why they executed a declaration that did not list inventor Lee are required. Further, any alterations to the text of the declaration must be made prior to execution by the inventors and must be initialed and dated.

For the legal representative of a deceased inventor, the declaration must list the inventors and the inventors' citizenships and the legal representative and the legal representative's citizenship, residence and postal address. See 37 CFR 1.497. The declaration of the legal representative lists only the deceased inventor and the legal representative and the citizenship for one of them. It is not executed on behalf of the nonsigning inventor as the nonsigning inventor is not listed. Further, it states that the deceased inventor was the sole inventor, which is not the stated inventorship. A new oath or declaration of the legal representative is required.

#### **CONCLUSION**

For the above reasons, applicant's petition under 37 CFR 1.47(a) and request for status under 37 CFR 1.42 are **DISMISSED** without prejudice and **REFUSED**, respectively.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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**PCT LEGAL ADMINISTRATION**

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In re Application of	:	DECISION
ALEXANDER, Samuel Wayne, et al.	:	
Application No.: 12/678,570	:	
PCT No.: PCT/US2008/076742	:	ON PETITION UNDER
Int. Filing Date: 17 September 2008	:	
Priority Date: 17 September 2007	:	37 CFR 1.47(a) AND
Docket No.: 0677-032	:	
For: METHODS AND SYSTEMS FOR	:	REQUEST FOR STATUS
MANAGEMENT OF IMAGE-BASED	:	
PASSWORD ACCOUNTS	:	UNDER 37 CFR 1.42

This is a decision on applicants' renewed Petition Under 37 CFR 1.47(a) and request for status under 37 CFR 1.42, filed in the United States Patent and Trademark Office (USPTO) on 10 October 2011.

**BACKGROUND**

On 10 May 2011, the Office mailed Decision on Petition Under 37 CFR 1.47(a) and Request for Status under 37 CFR 1.42.

On 10 October 2011, applicants filed this renewed petition under 37 CFR 1.47(a) and request for status under 37 CFR 1.42.

**DISCUSSION**

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1) and (3) have been satisfied.

Item (2) has not been satisfied. The declaration sent to inventor Osborn was defective. It failed to state the correct inventive entity, as it listed inventor James Luke Sontag twice. The inventor must be presented with a complete copy of accurate application papers, including the declaration.

Item (4) has not been satisfied. The declarations of the inventors must list all the inventors and their citizenships. 37 CFR 1.497. The declarations list inventor "James Luke Sontag" twice. New oaths or declarations in compliance with 37 CFR 1.497(a)-(b) are required.

For the legal representative of a deceased inventor, the declaration must list the inventors and the inventors' citizenships and the legal representative and the legal representative's citizenship, residence and postal address. See 37 CFR 1.497. The declaration of the legal representative lists only the citizenship of the legal representative, without listing a citizenship for the deceased inventor. As discussed above, the declaration improperly lists inventor Sontag twice, thus failing to comply with 37 CFR 1.497(a).

### **CONCLUSION**

For the above reasons, applicant's petition under 37 CFR 1.47(a) and request for status under 37 CFR 1.42 are **DISMISSED** without prejudice and **REFUSED**, respectively.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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**FEB 07 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of	:	
BOND	:	
U.S. Application No.: 12/678,577	:	DECISION ON PETITION
PCT No.: PCT/US2008/076611	:	
Int. Filing Date: 17 September 2008	:	UNDER 37 CFR 1.47(b)
Priority Date: 17 September 2007	:	
Attorney Docket No.: 3010390-0001-PCT-US	:	
For: METHOD AND APPARATUS FOR SUPPLY	:	
CHAIN MANAGEMENT	:	

This decision is in response to applicant's "PETITION UNDER 37 C.F.R. §1.47(b)" filed 24 November 2010 in the United States Patent and Trademark Office (USPTO) and supplemented on 04 January 2011.

**BACKGROUND**

On 17 September 2008, applicant filed international application PCT/US2008/076611 which claimed priority to an earlier application filed 17 September 2007. Pursuant to 37 CFR 1.495 the period for providing payment of the full, U.S. Basic National Fee was set to expire thirty months from the priority date, or midnight 17 March 2010.

On 17 March 2010, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by among other items, payment of the requisite basic national fee.

On 26 April 2010, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 23 July 2010, applicant responded with a declaration executed by a representative of the assignee in the application.

On 17 August 2010, applicant was mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" advising applicant that the declaration filed 23 July 2010 was not in compliance with 37 CFR 1.497. Applicant was afforded one month or the extendable time from the mail date of the Form PCT/DO/EO/905 to file a response.

On 24 November 2010, applicant filed the present petition under 37 CFR 1.47(b) accompanied by a petition for a four-month extension of time and payment of the four-month extension of time fee.

On 04 January 2011, applicant filed a supplement to the petition discussed herein.

### **DISCUSSION**

Applicant is advised that the Form PCT/DO/EO/905 was mailed on 26 April 2010 setting a two month period for response or 26 June 2010. Applicant's petition for a four-month extension of time would only extend the response period to 26 October 2010. Therefore, the request will be considered a request for a five-month extension of time. The difference in extension of time fees will be charged to deposit account number 13-3405 as authorized. The petition is considered timely filed.

A review of applicant's supplemental response of 04 January 2011 finds that applicant has located the previously non-signing inventor and currently provided a declaration signed by Mr. Bond. As applicant has now provided a signed declaration of the inventor listed on the published international application, the petition under 37 CFR 1.47(b) will be dismissed as moot.

### **CONCLUSION**

For the reasons above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED as moot.**

The application has an international filing date of 17 September 2008 under 35 U.S.C. 363, and will be given a date of **04 January 2011** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the DO/EO/US for processing in accordance with this decision. Specifically, the mailing of a Notification of Acceptance (Form PCT/DO/EO/903).



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**MAR 24 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of :  
BLOOMQUIST *et al* :  
U.S. Application No.: 12/678,585 :  
PCT No.: PCT/US2008/076651 :  
Int. Filing Date: 17 September 2008 :  
Priority Date: 17 September 2007 :  
Attorney Docket No.: 0677-033 :  
For: METHOD AND SYSTEM FOR :  
STORING AND USING A PLURALITY :  
OF PASSWORDS :

**DECISION**

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed in the United States Designated/Elected Office (DO/EO/US) on 08 November 2010.

**BACKGROUND**

On 06 May 2010, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee were required. Applicants were given two months to respond with extensions of time available.

On 08 November 2010, applicants filed a response which was accompanied by, *inter alia*, the subject petition; a \$200.00 petition fee; a \$65.00 surcharge fee; a four-month extension fee of \$865.00; a declaration signed by four of the six named inventors; a statement by Lawrence F. Grable; and documentary evidence in support of the petition (Exhibits A - I).

On 16 November 2010, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 1.495 (Form PCT/DO/EO/903) and filing receipt indicating that the date of receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements and date of completion of all 35 U.S.C. 371 requirements is 08 November 2010.

**DISCUSSION**

Applicants claim that two of the inventors (Jim Zhen LUO and Benjamin STOVER) cannot be found after diligent effort and have filed a petition under 37 CFR 1.47(a) in response to the Form PCT/DO/EO/905 mailed 06 May 2010.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventors cannot be located or refuses to cooperate; (3) a statement of the last known addresses of the nonsigning joint inventors; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

Applicants completed items (1) and (3) with the subject petition.

Regarding item (2), applicants contacted the former employer and coworkers of the nonsigning inventors by email to obtain information on their current locations. Applicants received email addresses for the nonsigning inventors but have not received a response from Mr. LUO and Mr. STOVER. Copies of the emails were provided.

Section 409.03(d)(I) of the MPEP discusses situations where an inventor cannot be reached and states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement.

Applicants have not shown that a diligent effort was made to locate the nonsigning inventors. The 37 CFR 1.47(a) applicants should have attempted to locate the nonsigning inventors by other means (such as internet searches, etc.) after receiving no response from the emails. These efforts are not extraordinary and are required to show that a diligent effort was made to contact each inventor.

For this reason, item (2) of 37 CFR 1.47(a) is not satisfied.

With regards to item (4), the 37 CFR 1.47(a) applicants have provided a declaration executed by four of the six named inventors on behalf of the two nonsigning inventors as required by MPEP § 409.03(a)(A). However, the address of joint inventor, Jason Allyn GRLICKY listed on the declaration contains noninitialed changes in ink.

Any changes made in ink must be initialed and dated by the applicants prior to execution of the declaration. The Office will not consider whether noninitialed and/or

nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration. See MPEP § 605.04(a). Therefore, a new declaration for Mr. GRILICKY is required. For this reason, item (4) of 37 CFR 1.47(a) is also not satisfied.

Accordingly, all the requirements of 37 CFR 1.47(a) are not yet complete.

### **CONCLUSION**

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available.

**Failure to timely respond will result in the abandonment of the application.**

The Form PCT/DO/EO/903 and filing receipt mailed 16 November 2010 were sent in error, and are hereby **VACATED**.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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**AUG 23 2011**

PCT LEGAL ADMINISTRATION

In re Application of :  
BLOOMQUIST *et al* :  
U.S. Application No.: 12/678,585 :  
PCT No.: PCT/US2008/076651 :  
Int. Filing Date: 17 September 2008 :  
Priority Date: 17 September 2007 :  
Attorney Docket No.: 0677-033 :  
For: METHOD AND SYSTEM FOR :  
STORING AND USING A PLURALITY :  
OF PASSWORDS :

**DECISION**

This decision is in response to applicants' renewed petition under 37 CFR 1.47(a) filed 27 June 2011.

**BACKGROUND**

On 24 March 2011, a decision dismissing applicants' 37 CFR 1.47(a) petition was mailed. Applicants were given two months to respond.

On 27 June 2011, applicants filed the subject renewed response which was accompanied by, *inter alia*, a two-month extension fee of \$245.00, a declaration executed by Benjamin STOVER, a new declaration executed by Jason Allyn GRICKY, and documentary evidence in support of the petition.

**DISCUSSION**

In the initial petition, applicants claimed that Jim Zhen LUO and Benjamin STOVER could not be found or reached after diligent effort.

Items (1) and (3) of 37 CFR 1.47(a)<sup>1</sup> were satisfied in the initial petition.

With regards to item (4) of 37 CFR 1.47(a), the prior decision noted that the declaration of Jason Allyn GRICKY was not acceptable as the address listed on the declaration contained noninitialed changes in ink. See MPEP § 605.04(a). The

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<sup>1</sup> 37 CFR 1.47(a) requires: (1) a petition fee; (2) factual proof that the missing joint inventor(s) could not be located or refuse to cooperate; (3) a statement of the last known address(es) of the nonsigning joint inventor(s); (4) and an oath or declaration executed by the signing joint inventor(s) on their behalf and on behalf of the nonsigning joint inventor(s).

decision stated that a new declaration for Mr. GRICKY was required.

In the renewed response, applicants provided a declaration executed by Mr. GRICKY. However, this declaration listed only Mr. GRICKY as the sole inventor in the subject application. This declaration is not acceptable as the proper inventive entity must be recorded on each declaration. See 37 CFR 1.497(a)(3).

Nonetheless, the original declaration containing the noninitialed change in the address of Mr. GRICKY is now accepted.<sup>2</sup>

This declaration is considered sufficient for the purposes of entry into the U.S. national phase despite the noninitialed alterations as all other requirements of 37 CFR 1.497(a) and (b) are satisfied. Applicants should note that acceptance of a declaration containing a noninitialed alteration for purposes of national stage entry does not prohibit the examiner from later requiring a new oath or declaration to cure the defect.

**Item (4) of 37 CFR 1.47(a) is now complete.**

With regards to item (2) of 37 CFR 1.47(a), applicants have provided a declaration executed by one of the two nonsigning inventors, Benjamin STOVER. This declaration lists the proper inventive entity and is accepted.

**Item (2) of 37 CFR 1.47(a) is now satisfied for Mr. STOVER.**

Concerning Mr. LUO, applicants sent a second email to Mr. LUO on 31 May 2011. The email asked if they could send a copy of the patent application and declaration to this email address. No response was received. Applicants then sent documents to the last known address of Mr. LUO by certified mail. These documents were signed for by Mr. LUO on 09 June 2011. A copy of the signed postal receipt was submitted. No response has been received.

It is first noted that there is no evidence that Mr. LUO received the email sent with the initial petition, or the second email sent on 31 May 2011. There is no return receipt and Mr. LUO has not responded using that email address. However, there is sufficient evidence that Mr. LUO received the documents mailed 09 June 2011. As such, the subject petition is treated as a refusal to cooperate by Mr. LUO.

MPEP § 409.03(d)(II) requires that for a refusal to be accepted, the 37 CFR 1.47(a) applicants must show that a complete copy of the application, including specification, claims and drawings, were presented (or attempted to be presented) to the nonsigning inventor. The lack of a response by an inventor could constitute a

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<sup>2</sup> This acceptance is due to a change in Office policy dated 05 May 2011.

refusal to cooperate by conduct.

Counsel states in the petition that the documents received by Mr. LUO contained a copy of the patent application and declaration. This statement is not supported by the evidence. The cover letter provided does not indicate that a copy of the patent application was included. The letter states that only a declaration is attached.

For a refusal to cooperate to be shown, applicants must provided a copy of all documents received by Mr. LUO on 09 June 2011 in any renewed petition.

Further, there was no time period to reply listed on the cover letter. The documents were received by Mr. LUO on 09 June 2011 and the subject petition was signed on 24 June 2011. Thirty days is generally used as a sufficient time period to wait for a response before concluding that no response is forthcoming.

**For these reasons, item (2) of 37 CFR 1.47(a) is not satisfied for Mr. LUO.**

#### **CONCLUSION**

Applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available.

**Failure to timely respond will result in the abandonment of the application.**

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

28840  
TOMLINSON & O'CONNELL, P.C.  
Two Leadership Square  
211 North Robinson, Suite 450  
Oklahoma City, OK 73102

**MAILED**

**DEC 06 2011**

In re Application of :  
BLOOMQUIST *et al* :  
U.S. Application No.: 12/678,585 :  
PCT No.: PCT/US2008/076651 :  
Int. Filing Date: 17 September 2008 :  
Priority Date: 17 September 2007 :  
Attorney Docket No.: 0677-033 :  
For: METHOD AND SYSTEM FOR :  
STORING AND USING A PLURALITY :  
OF PASSWORDS :

**PCT LEGAL ADMINISTRATION**

**DECISION**

This decision is in response to applicants' second renewed petition under 37 CFR 1.47(a) filed 24 October 2011.

**BACKGROUND**

On 23 August 2011, a decision dismissing applicants' 37 CFR 1.47(a) petition was mailed. Applicants were given two months to respond.

On 24 October 2011, applicants filed the subject response which was accompanied by, *inter alia*, documentary evidence in support of the petition.

**DISCUSSION**

The prior decision (mailed 23 August 2011) noted that there was evidence that joint inventor Jim Zhen LUO received a copy of the declaration for the subject application on 09 June 2011 and did not respond.

Therefore, the petition was treated as a refusal to cooperate as contemplated by MPEP § 409.03(d)(II). However, the petition was dismissed as there was no evidence that a copy of the patent application was included with the documents mailed to the nonsigning inventor on 09 June 2011.

In the instant response, applicants state that a complete copy of the subject application and a declaration were forwarded to the last known address of Mr. LUO on 02 September 2011 by certified mail. Applicants requested a response from Mr. LUO before 10 October 2011. Applicants state that these papers were received on 07 September 2011. No response has been received. Applicants conclude that Mr. LUO

refuses to join the application. A copy of a cover letter dated 02 September 2011 and a copy of a certified mail postal receipt was provided.

A review of the evidence shows that a complete copy of the subject application was mailed to the same address that Mr. LUO signed for the documents on 09 June 2011. Although the documents were not received by Mr. LUO, they were signed for by a "D. PLAISTED" as "Agent" of Mr. LUO. Therefore, it is reasonable to conclude that Mr. LUO received these documents. Applicants provided Mr. LUO sufficient time to respond.

The lack of a response by Mr. LUO constitutes a refusal to cooperate as contemplated by MPEP § 409.03(d)(II). Item (2) of 37 CFR 1.47(a) is now satisfied.

All items of 37 CFR 1.47(a) are now complete.

#### **CONCLUSION**

Applicants' renewed petition under 37 CFR 1.47(a) is hereby **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 17 September 2008 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 08 November 2010.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record and will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing

  
James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302



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Commissioner for Patents  
United States Patent and Trademark Office  
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Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Jim Zhen Luo  
5419 Rolling Road  
Springfield, VA 22151

In re Application of  
BLOOMQUIST *et al*  
U.S. Application No.: 12/678,585  
PCT No.: PCT/US2008/076651  
Int. Filing Date: 17 September 2008  
Priority Date: 17 September 2007  
Attorney Docket No.: 0677-033  
For: METHOD AND SYSTEM FOR  
STORING AND USING A PLURALITY  
OF PASSWORDS

**MAILED**

**DEC 06 2011**

**PCT LEGAL ADMINISTRATION**

Dear Mr. Luo:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. The counsel for the applicant is listed below. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302

TOMLINSON & O'CONNELL, P.C.  
Two Leadership Square  
211 North Robinson, Suite 450  
Oklahoma City, OK 73102



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Alexandria, VA 22313-1450  
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MILTONS IP/P.I.  
2255 CARLING AVENUE  
SUITE 203  
OTTAWA, CANADA K2P 1-P9

**MAILED**  
**JUN 24 2011**  
**OFFICE OF PETITIONS**

In re Application of  
Yan Bodain  
Application No. 12/678,603  
Filed: March 17, 2010  
Attorney Docket No. 3504-03-14

DECISION ON PETITION  
TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 30, 2011.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that on June 10, 2011 the power of attorney to Miltons IP/P.I. was revoked by the applicant of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272- 7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

/Joan Olszewski/  
Joan Olszewski  
Petitions Examiner  
Office of Petitions

cc: Yan Bodain  
10777 Auteuil  
Montreal QC H3L 2K7 CA CANADA



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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
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**MAILED**

DEC 29 2010

**PCT LEGAL ADMINISTRATION**

CROWELL & MORING LLP  
INTELLECTUAL PROPERTY GROUP  
P.O. BOX 14300  
WASHINGTON, DC 20044-4300

In re Application of REIDT et al  
U.S. Application No.: 12/678,608  
PCT Application No.: PCT/EP2008/007572  
Int. Filing Date: 12 September 2008  
Priority Date Claimed: 18 September 2007  
Attorney Docket No.: 106223.62354US  
For: DEVICE AND METHOD FOR THE  
REGENERATION OF BIOSENSORS

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DECISION

This is in response to applicant's petition under 37 CFR 1.47(a) filed on 02 December 2010.

### **BACKGROUND**

On 12 September 2008, applicant filed international application PCT/EP2008/007572, which claimed priority of an earlier Germany application filed 18 September 2007. A copy of the international application was communicated to the USPTO from the International Bureau on 26 March 2009. The thirty-month period for paying the basic national fee in the United States expired on 18 March 2010.

On 17 March 2010, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 03 May 2010, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 02 December 2010, applicant filed the present petition under 37 CFR 1.47(a).

**DISCUSSION**

A review of the application file reveals that an acceptable declaration was filed on 17 March 2010. Accordingly, the Notification of Missing Requirements was sent in error.

**CONCLUSION**

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED AS MOOT.

The Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed on 03 May 2010 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 12 September 2008, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 17 March 2010.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

*Bryan Lin*

Bryan Lin  
PCT Legal Examiner  
PCT Legal Office

Telephone: 571-272-3303  
Facsimile: 571-273-0459

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE EUROPEAN PATENT OFFICE (EPO) AND THE USPTO

Application No:	12678641	Filing date:	2010-03-17
First Named Inventor:	Thomas Frese et al.		

Title of the  
Invention: **Self-Adhesive Addition Cross-Linking Silicone Compositions**

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBC/EFSS\\_HELP.HTML](http://www.uspto.gov/EBC/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/EP2008/061955

**The international filing date of the corresponding PCT application(s) is/are:** September 10, 2008

**I. List of Required Documents:**

- a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**

☒

Is attached

☐

Is not attached because the document is already in the U.S. application.

- b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**

☐

Is attached.

☒

Is not attached because the document is already in the U.S. application.

- c. English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM  
BETWEEN THE EPO AND THE USPTO**

(continued)

Application No.:	12678641
First Named Inventor:	Thomas Frese et al.

- d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

☐

Is attached

☒Has already been filed in the above-identified U.S. application on March 17, 2010

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)

☐

Are attached.

☒Have already been filed in the above-identified U.S. application on March 17, 2010**II. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
11	1	Modified to U.S. format
12	2	Modified to U.S. format
13	3	Modified to U.S. format and to eliminate multiple dependencies
14	3	Modified to U.S. format and to eliminate multiple dependencies
15	4	Modified to U.S. format and to eliminate multiple dependencies
16	4	Modified to U.S. format and to eliminate multiple dependencies
17	4	Modified to U.S. format and to eliminate multiple dependencies
18	5	Modified to U.S. format and to eliminate multiple dependencies
19	6	Modified to U.S. format and to eliminate multiple dependencies
20	7	Modified to U.S. format and to eliminate multiple dependencies
21	8	Modified to U.S. format and to eliminate multiple dependencies
22	9	Modified to U.S. format and to eliminate multiple dependencies
23	10	Modified to U.S. format and to eliminate multiple dependencies

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature /William G. Conger/	Date March 9, 2011
Name (Print/Typed) William G. Conger	Registration Number 31209

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant ( i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,641	03/17/2010	Thomas Frese	WAS1060PUSA	1202
22045	7590	04/18/2011		
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			EXAMINER DOLLINGER, MICHAEL M	
			ART UNIT 1766	PAPER NUMBER
			MAIL DATE 04/18/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

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[www.uspto.gov](http://www.uspto.gov)

EL

April 18, 2011

In re application of	:	DECISION ON REQUEST TO
Frese, et al.	:	PARTICIPATE IN PATENT
Serial No. 12/678,641	:	PROSECUTION HIGHWAY
Filed: March 17, 2010	:	PROGRAM AND
For: <b>SELF-ADHESIVE ADDITION</b>	:	PETITION TO MAKE SPECIAL
<b>CROSS-LINKING SILICONE</b>	:	UNDER 37 CFR 1.102(a)
<b>COMPOSITIONS</b>	:	

This is a decision on the request for reconsideration to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed March 09, 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;

(6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof if the latest international work product is not in the English language; and

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Emily M. Le, Supervisory Patent Examiner, at (571) 272-0903.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Emily M. Le/

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Emily M. Le  
Supervisory Patent Examiner  
Technology Center 1700



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**MAILED**

**FEB 22 2011**

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THE FARRELL LAW FIRM, P.C.  
290 Broadhollow Road  
Suite 210E  
Melville NY 11747

PCT LEGAL ADMINISTRATION

In re Application of: RIGAS, Basil, et al.	:	
U.S. Application No.: 12/678,654	:	
PCT No.: PCT/US2008/076631	:	DECISION ON PETITION
International Filing Date: 17 September 2008	:	(37 CFR 1.47(a))
Priority Date: 17 September 2007	:	
Attorney's Docket No.: 788-62 PCT US	:	
For: DETECTION OF H.PYLORI	:	
UTILIZING UNLABELED UREA	:	

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a)" filed 23 December 2010. Petitioner has paid the required \$200 petition fee.

**BACKGROUND**

The procedural background for the present application was set forth in the decision mailed on 13 July 2010. The decision granted applicants' petition under 37 CFR 1.182 to confirm that the present application was the U.S. national stage of international application PCT/US2008/076631.

On 23 July 2010, the United States Designated/Elected Office (DO/EO/US) issued a "Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date.

On 23 December 2003, applicants filed a response to the Notification Of Missing Requirements (with required extension fee). The response included payment of the required surcharge, a partially executed declaration, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signatures of co-inventors Pelagia-Irene GOUMA and Krithika KALYANASUNDARAM, whom applicants assert have refused to execute the application.

**DISCUSSION**

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing

inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have paid the required petition fee, and the petition states the last known addresses of the non-signing inventors (including the address of the attorney for one of the non-signing inventors, Pelagia-Irene GUOMA). Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Applicants have filed declarations executed by two of the four inventors of record, and the declarations contain unsigned signature blocks for the non-signing inventors. These declarations may be accepted as having been executed by the cooperating inventors on their own behalf and on behalf of the non-signing inventors. Item (3) of a grantable petition is therefore satisfied.

Regarding item (4), MPEP section 409.03(d)(II) states that, before it can be concluded that an inventor has refused to execute the application papers, "[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, applicants have provided a statement from Thomas O. Hoover, with accompanying documents, setting forth the efforts made to obtain the signatures of the non-signing inventors. With respect to non-signing inventor Pelagia-Irene GOUMA, the statement provides an acceptable firsthand showing that a request for signature, accompanied by a copy of the complete application, was forwarded to the non-signing inventor and that, through her attorney, this inventor confirmed receipt of the correspondence and expressly refused to execute the declaration. These materials provide an acceptable showing that non-signing inventor Pelagia-Irene GOUMA has refused to execute the application. Item (4) of a grantable petition is therefore satisfied with respect to this inventor.

With respect to non-signing inventor Krithika KALYANASUNDARAM, the statement indicates that a request for signature, accompanied by a copy of the complete application, was forwarded to the inventor's last known residential and email addresses, and that no response was received with respect to these requests. However, the petition does not include evidence that these signature requests were received by the inventor (e.g., a signed delivery receipt). Such evidence of receipt is particularly important where, as here, petitioner is requesting that an

inventor's failure to respond to a signature request be interpreted as a refusal to execute the application. On the present record, absent adequate supplemental materials confirming that a request for signature, accompanied by a copy of the complete application, has been delivered to the non-signing inventor and that the inventor has refused to provide the requested signature in response to such request, it cannot be concluded that non-signing co-inventor Krithika KALYANASUNDARAM has refused to execute the application. Nor have applicants presented an acceptable showing that, in the alternative, this inventor cannot be reached after diligent effort.<sup>1</sup> Item (4) of a grantable petition under 37 CFR 1.47(a) is therefore not satisfied with respect to non-signing co-inventor Krithika KALYANASUNDARAM.

### **CONCLUSION**

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should be entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy item (4) of a grantable petition with respect to non-signing co-inventor Krithika KALYANASUNDARAM, as discussed above and in the MPEP. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application.  
Extensions of time are available under 37 CFR 1.136(a)

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296

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<sup>1</sup> The requirements for such a showing (including, but not limited to, the requirement of an internet search) are set forth in MPEP section 409.03(d)(I).



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**MAILED**

OCT 11 2011

PCT LEGAL ADMINISTRATION

WEINGARTEN, SCHURGIN, GAGNEBIN & LBOVICI LLP  
Ten Post Office Square  
Boston, MA 02109

In re Application of: RIGAS, Basil, et al.	:	
U.S. Application No.: 12/678,654	:	DECISION ON PETITION TO
PCT No.: PCT/US2008/076631	:	WITHDRAW HOLDING OF
International Filing Date: 17 September 2008	:	ABANDONMENT AND
Priority Date: 17 September 2007	:	RENEWED PETITION UNDER
Attorney's Docket No.: SUNYS-006XX	:	37 CFR 1.47(a)
For: DETECTION OF H.PYLORI	:	
UTILIZING UNLABELED UREA	:	

This decision is issued in response to applicants' "Petition To Withdraw Holding Of Abandonment" and "Renewed Petition Under 37 CFR 1.47(a)" and filed 22 August 2011. No additional petition fee is required.

**BACKGROUND**

The procedural background for the present application was set forth in the decisions mailed on 13 July 2010 and 22 February 2011. The decision mailed on 22 February 2011 dismissed without prejudice applicants' petition under 37 CFR 1.47(a), finding that applicants failed to satisfy all the requirements of a grantable petition. Specifically, applicants had not provided an acceptable showing that one of the two non-signing inventors, Krithika KALYANASUNDARAM, had refused to execute the application or cannot be reached after diligent effort.

On 12 May 2011, the United States Designated/Elected Office (DO/EO/US) issued a "Notification Of Abandonment" (Form PCT/DO/EO/909) indicating that the application was abandoned based on applicants' failure to respond to the decision mailed on 22 February 2011.

On 22 August 2011, applicants filed the "Petition To Withdraw Holding Of Abandonment" and "Renewed Petition Under 37 CFR 1.47(a)" considered herein.

**DISCUSSION**

**1. Petition To Withdraw Holding Of Abandonment (37 CFR 1.181)**

Applicants' petition to withdraw the holding of abandonment asserts that the Notification Of Abandonment was issued prior to the expiration of the available response period provided by the decision mailed on 22 February 2011 and that the holding of abandonment is therefore properly withdrawn.

The decision mailed on 22 February 2011 provided applicants with two months to submit the required response, and the decision specifically stated that this response period was extendable under 37 CFR 1.136(a). 37 CFR 1.136(a) permits applicants to obtain a maximum extension of five months which, in the present case, would extend the response deadline to 22 September 2011 (i.e., seven total months from the 22 February 2011 mail-date of the previous decision).

In view of the above, and as argued by applicants in the present petition, the Notification Of Abandonment mailed 12 May 2011 was issued prior to the expiration of the available response period. Applicants' petition to withdraw the holding of abandonment is therefore appropriately granted.

## **2. Renewed Petition Under 37 CFR 1.47(a)**

The renewed petition under 37 CFR 1.47(a) includes a second declaration from Thomas O. Hoover, with supporting documents, describing additional efforts made to obtain the signature of the non-signing inventors. The statement indicates that a signature request mailed to non-signing inventor Krithika KALYANASUNDARAM's last known address was returned with what appears to be a forwarding address, that a copy of the signature request (accompanied by the complete application) was subsequently delivered by "Express Mail" to an authorized representative at the new address, and that no response was received. The renewed petition also indicates that an internet search provided no additional information regarding the current address of the inventor.

The present submission, in combination with the materials previously submitted, provides an acceptable showing that inventor Krithika KALYANASUNDARAM has refused to execute the application. Applicants have therefore satisfied the final requirement for grantable petition under 37 CFR 1.47(a)

## **CONCLUSION**

Applicants' "Petition To Withdraw Holding Of Abandonment" is **GRANTED**.

The "Notification Of Abandonment" (Form PCT/DO/EO/909) mailed on 12 May 2011 is hereby **VACATED**.

Applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

The application is accepted without the signatures of non-signing co-inventors Pelagia-Irene GOUMA and Krithika KALYANASUNDARAM.

A notice of the acceptance of the application will be published in the Official Gazette, and a letter informing the non-signing inventors of the application will be forwarded to the inventors' last-known addresses, as set forth in the petition.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 23 December 2010.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296



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Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
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Krithika KALYANASUNDARAM, Ph.D.  
620 Grandview Meadows Drive  
Unit D203  
Longmont, CO 80503

**MAILED**

**OCT 11 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of: RIGAS, Basil, et al.  
U.S. Application No.: 12/678,654  
PCT No.: PCT/US2008/076631  
International Filing Date: 17 September 2008  
Priority Date: 17 September 2007  
Attorney's Docket No.: 788-62 PCT US  
For: DETECTION OF H.PYLORI UTILIZING UNLABELED UREA

Dear Dr. KALYANASUNDARAM:

You are identified as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296

Counsel Of Record:

Thomas O. Hoover  
WEINGARTEN, SCHURGIN, GAGNEBIN & LEBOVICI LLP  
Ten Post Office Square  
Boston, MA 02109



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Pelagia-Irene GOUMA, Ph.D.  
4 Vantage Court  
Port Jefferson, NY 11777

**MAILED**

**OCT 11 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of: RIGAS, Basil, et al.  
U.S. Application No.: 12/678,654  
PCT No.: PCT/US2008/076631  
International Filing Date: 17 September 2008  
Priority Date: 17 September 2007  
Attorney's Docket No.: 788-62 PCT US  
For: DETECTION OF H.PYLORI UTILIZING UNLABELED UREA

Dear Dr. GOUMA:

You are identified as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/RichardMRoss/

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296

Counsel Of Record:

Thomas O. Hoover  
WEINGARTEN, SCHURGIN, GAGNEBIN & LEBOVICI LLP  
Ten Post Office Square  
Boston, MA 02109

20 SEP 2010



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LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD NJ 07090

In re Application of :  
Rauber et al. :  
Application No. 12/678,656 :  
Filing Date: 17 March 2010 : DECISION  
Atty. Docket No.: REGIM 3.9-099 CIP :  
For: Systems And Methods For Generating :  
Personalized Dynamic Presentations From Non- :  
Personalized Presentation Structures And... :

This is in response to the petition filed on 24 May 2010.

### **BACKGROUND**

International application PCT/EP2008/062376 was filed on 17 September 2008, claimed an earlier priority date of 17 September 2007, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 26 March 2009. The 30 month time period for paying the basic national fee in the United States expired at midnight on 17 March 2010. Said international application became abandoned with respect to the national stage in the United States for failure to timely pay the requisite basic national fee.

On 13 May 2010, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed, indicating that said international application had become abandoned with respect to the national stage in the United States for failure to timely pay the basic national fee.

### **DISCUSSION**

Petitioner requests revival of this application pursuant to 37 CFR 1.137(b). The petition is being treated as a petition to withdraw the holding of abandonment.

Review of the record reveals that the Electronic Acknowledgment Receipt associated with the correspondence filed on 17 March 2010 via EFS-Web indicates the instant application to be a national stage under 35 U.S.C. 371 of "PCT/EP08/62376." However, inspection of the Transmittal Letter filed on 17 March 2010 reveals that it was designated as "only for new nonprovisional applications under 37 CFR 1.53(b)," implying that treatment under 35 U.S.C. 111(a) was desired. Also on 17 March 2010, applicants filed a preliminary amendment to the specification, adding a cross-reference identifying this application as "a Continuation-in-Part of International Application No. PCT/EP2008/062376." This also suggests that treatment under 35 U.S.C. 111(a) was desired.

The USPTO has adopted a bright-line test for determining whether application papers will be processed under 35 U.S.C. 371 or alternatively under 35 U.S.C. 111(a). Under this

standard, any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

- 1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or
- 2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

If there are any conflicting instructions as to which section of the statute (371 or 111(a)) is intended the application will be accepted under 35 U.S.C. 111(a).

Inspection of the correspondence filed on 17 March 2010 reveals that the Electronic Acknowledgment Receipt suggests that processing under 35 U.S.C. 371 was desired, whereas the Transmittal Letter and preliminary amendment to the specification suggest that processing under 35 U.S.C. 111(a) was intended. These indicia constitute conflicting instructions as to whether processing under 35 U.S.C. 371 rather than U.S.C. 111(a) was desired. Under the policy referenced above, this application properly should be processed under 35 U.S.C. 111(a). Since applicants have not shown sufficient cause (e.g., loss of rights) or lack of availability of an alternative remedy, it would be appropriate, and consistent with the policy considerations described above, to process this application under 35 U.S.C. 111(a). Since the instant application properly should be processed under 35 U.S.C. 111(a), the basic national fee was not due; accordingly, the Notification of Abandonment mailed on 13 May 2010 was issued in error, and it is hereby **VACATED**. The holding of abandonment is **WITHDRAWN**.

To the extent that applicants were seeking to revive said international application for purposes of establishing co-pendency with this application, such a petition would be unnecessary because the instant application was co-pending with PCT/EP2008/062376 on 17 March 2010.

### **DECISION**

The petition is **GRANTED**, as described herein.

**Application No.: 12/678,656**

**Page 3**

This application will be returned to the Office of Patent Application Processing for processing as an application filed under 35 U.S.C. 111(a). This processing will include the correction of the electronic records of the USPTO to show the application as in pending status and to show its correct status as an application filed under 35 U.S.C. 111(a).

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,657	03/17/2010	Masumi Suzuki	KF-1032	1296
77319 7590 08/30/2010 Kubotera & Associates, LLC 200 Daingerfield Rd Suite 202 Alexandria, VA 22314			EXAMINER	
			ART UNIT	PAPER NUMBER
			2189	
			MAIL DATE	DELIVERY MODE
			08/30/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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Kubotera & Associates, LLC  
200 Daingerfield Rd, Suite 202  
Alexandria, VA 22314

In re Application of: Suzuki M.  
Application No. 12/678,657.  
Filed: March 17, 2010  
For: Storage device using flash memory.

DECISION ON REQUEST TO  
PARTICIPATE IN PATENT  
PROSECUTION HIGHWAY PILOT  
PROGRAM AND PETITION TO  
MAKE SPECIAL UNDER 37 CFR  
1.102(d)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) ~~pilot~~ program and the petition under 37 CFR 1.102(d), filed ~~May 28~~, 2010 to make the above-identified application special.

*June 21,*

The request and petition are **DENIED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application is
- (a) a Paris Convention application which either
    - (i) validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO, or
    - (ii) validly claims priority to a PCT application that contains no priority claims,
- Or
- (b) a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
    - (i) validly claims priority to an application filed in the JPO, or
    - (ii) validly claims priority to a PCT application that contains no priority claims, or
    - (iii) contains no priority claim,
- Or
- (c) a so-called bypass application filed under 35 U.S.C. 111 (a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
    - (i) validly claims priority to an application filed in the JPO, or

- (ii) validly claims priority to a PCT application that contains no priority claims, or
- (iii) contains no priority claim.

Where the JPO application that contains the allowable/patentable claims is not the same application for which priority is claimed in the U.S. application, applicant must identify the relationship between the JPO application that contains the allowable/patentable claims and the JPO priority application claimed in the U.S. application.

(2) Applicant must submit a copy of:

- a. The allowable/patentable claim(s) from the JPO application(s) or if a copy of the allowable/patentable claims is available via the Dossier Access System (DAS) applicant may request the USPTO obtain a copy from the DAS, however if the USPTO is unable to obtain a copy from the DAS the applicant will be required to submit a copy;
- b. An English translation of the allowable/patentable claim(s) and
- c. A statement that the English translation is accurate;

(3) Applicant must:

- a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s) and
- b. Submit a claims correspondence table in English;

(4) Examination of the U.S. application has not begun;

(5) Applicant must submit:

- a. Documentation of prior office action: i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claim(s) or
- ii. if the allowable/patentable claims(s) are from a "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
- iii. if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form;

Further, if a copy of the documents from a or b above is available via the Dossier Access System (DAS) applicant may request the USPTO obtain a copy from the DAS, however if the USPTO is unable to obtain a copy from the DAS the applicant will be required to submit a copy; b. An English language translation of the JPO Office action from (5)(a)(i)-(ii) above c. A statement that the English translation is accurate;

(6) Applicant must submit:

- a. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
- b. Copies of the documents except U.S. patents or U.S. patent application publications (unless already submitted in this application);

(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH pilot program and petition fail to include:

A. Item 6. above. Specifically,

Document **JP-2007-517335** that has been cited by the JPO in the Reasons for refusal dated June 2, 2008, is not listed or provided in any IDS with the request.

The Petition is **DENIED**.

The application will await action in its regular turn.

Telephone inquiries concerning this decision should be directed to Mano Padmanabhan at 571-272-4210.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system.

/Mano Padmanabhan/

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Mano Padmanabhan  
Quality Assurance Specialist, Technology Center 2100, Workgroup 2180  
571-272-4210



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,657	03/17/2010	Masumi Suzuki	KF-1032	1296
77319 7590 10/26/2010 Kubotera & Associates, LLC 200 Daingerfield Rd Suite 202 Alexandria, VA 22314				
EXAMINER				
ART UNIT		PAPER NUMBER		
2189				
MAIL DATE		DELIVERY MODE		
10/26/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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Kubotera & Associates, LLC  
200 Daingerfield Rd, Suite 202  
Alexandria, VA 22314

In re Application of: Suzuki M.  
Application No. 12/678,657.  
Filed: March 17, 2010  
For: Storage device using flash memory.

DECISION ON REQUEST TO  
PARTICIPATE IN PATENT  
PROSECUTION HIGHWAY PILOT  
PROGRAM AND PETITION TO  
MAKE SPECIAL UNDER 37 CFR  
1.102(d)

This is a decision on the renewed request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed June 21, 2010 to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application is
  - (a) a Paris Convention application which either
    - (i) validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO, or
    - (ii) validly claims priority to a PCT application that contains no priority claims,
  - Or
  - (b) a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
    - (i) validly claims priority to an application filed in the JPO, or
    - (ii) validly claims priority to a PCT application that contains no priority claims, or
    - (iii) contains no priority claim,
  - Or
  - (c) a so-called bypass application filed under 35 U.S.C. 111 (a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
    - (i) validly claims priority to an application filed in the JPO, or

- (ii) validly claims priority to a PCT application that contains no priority claims; or
- (iii) contains no priority claim.

Where the JPO application that contains the allowable/patentable claims is not the same application for which priority is claimed in the U.S. application, applicant must identify the relationship between the JPO application that contains the allowable/patentable claims and the JPO priority application claimed in the U.S. application.

(2) Applicant must submit a copy of:

- a. The allowable/patentable claim(s) from the JPO application(s) or if a copy of the allowable/patentable claims is available via the Dossier Access System (DAS) applicant may request the USPTO obtain a copy from the DAS, however if the USPTO is unable to obtain a copy from the DAS the applicant will be required to submit a copy;
- b. An English translation of the allowable/patentable claim(s) and
- c. A statement that the English translation is accurate;

(3) Applicant must:

- a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s) and
- b. Submit a claims correspondence table in English;

(4) Examination of the U.S. application has not begun;

(5) Applicant must submit:

- a. Documentation of prior office action: i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claim(s) or
- ii. if the allowable/patentable claims(s) are from a "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
- iii. if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form;

Further, if a copy of the documents from a or b above is available via the Dossier Access System (DAS) applicant may request the USPTO obtain a copy from the DAS, however if the USPTO is unable to obtain a copy from the DAS the applicant will be required to submit a copy; b. An English language translation of the JPO Office action from (5)(a)(i)-(ii) above c. A statement that the English translation is accurate;

(6) Applicant must submit:

- a. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
- b. Copies of the documents except U.S. patents or U.S. patent application publications (unless already submitted in this application);

(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH pilot program and petition was denied in the petition decision mailed on August 30, 2010, for failing to include a reference cited in the office action of the OFF, in the IDS of the instant U.S. application. However, applicant pointed out in a telephone conversation that followed the decision that the equivalent reference (US Patent 7139864) was cited in the IDS that was filed on March 17, 2010.

The petition is **GRANTED**.

The request to participate in the PPH pilot program and petition are found to comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Mano Padmanabhan at 571-272-4210.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

/Mano Padmanabhan/

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Mano Padmanabhan  
Quality Assurance Specialist, Technology Center 2100, Workgroup 2180  
571-272-4210

## REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE JAPAN PATENT OFFICE (JPO) AND THE USPTO

Application No.:	12/678,659	Filing Date:	March 17, 2010
First Named Inventor:	Keiji KAITA et al.		
Attorney Docket No.:	144849		

Title of the Invention: CONTROL SYSTEM FOR SECONDARY BATTERY, ELECTRICALLY POWERED VEHICLE HAVING SAME, AND METHOD FOR CONTROLLING SECONDARY BATTERY

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBS/EF\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html).**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

The corresponding PCT application number(s) is/are: PCT/JP2008/067235

The international date of the corresponding PCT application(s) is/are: September 25, 2008

**I. List of Required Documents:**

- a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)
  - ☒ Is attached.
  - ☐ Is not attached because the document is already in the U.S. application.
- b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).
  - ☒ Is attached.
  - ☐ Is not attached because the document is already in the U.S. application.
- c. English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.

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This collection of information is required by 35 U.S.C. 119, 37 CFR 1.55, and 37 CFR 1.102(d). The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.

## REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM BETWEEN THE JPO AND THE USPTO

(continued)

Application No.:	12/678,659
First Named Inventor:	Keiji KAITA et al.

- d. (1) **An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.**

☐ Is attached.

☒ Has already been filed in the above-identified U.S. application on March 17, 2010

- (2) **Copies of all documents (except) for U.S. patents or U.S. patent application publications)**

☐ Are attached.

☒ Have already been filed in the above-identified U.S. application on March 17, 2010

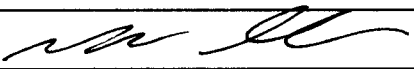
### II. Claims Correspondence Table:

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
1	1	US claim 1 substantially corresponding to PCT claim 1.
2	2	Canceled
3	3	US claim 3 substantially corresponding to PCT claim 3.
4	4	US claim 4 substantially corresponding to PCT claim 4.
5	5	US claim 5 substantially corresponding to PCT claim 5.
6	6	US claim 6 substantially corresponding to PCT claim 6.
7	7	US claim 7 substantially corresponding to PCT claim 7.
8	8	US claim 8 substantially corresponding to PCT claim 8.
9	9	US claim 9 substantially corresponding to PCT claim 9.
10	10	US claim 10 substantially corresponding to PCT claim 10.
11	11	US claim 11 substantially corresponding to PCT claim 11.
12	12	US claim 12 substantially corresponding to PCT claim 12.
13	13	US claim 13 substantially corresponding to PCT claim 13.
14	14	US claim 14 differs from PCT claim 14 in that U.S. claim 14 does not include the multiple dependency.
15	15	US claim 15 differs from PCT claim 15 in that U.S. claim 15 does not include the multiple dependency.
16	16	US claim 16 substantially corresponding to PCT claim 16.
17	17	Canceled
18	18	US claim 18 substantially corresponding to PCT claim 18.
19	19	US claim 19 substantially corresponding to PCT claim 19.
20	20	US claim 20 substantially corresponding to PCT claim 20.
21	21	US claim 22 substantially corresponding to PCT claim 21.
22	22	US claim 22 substantially corresponding to PCT claim 22.
23	23	US claim 23 substantially corresponding to PCT claim 23.
24	24	US claim 24 substantially corresponding to PCT claim 24.
25	25	US claim 25 substantially corresponding to PCT claim 25.
26	26	US claim 26 substantially corresponding to PCT claim 26.
27	27	US claim 27 substantially corresponding to PCT claim 27.
28	28	US claim 28 substantially corresponding to PCT claim 28.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

29	29	US claim 29 differs from PCT claim 29 in that U.S. claim 29 does not include the multiple dependency.
30	30	US claim 30 differs from PCT claim 30 in that U.S. claim 30 does not include the multiple dependency.

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature 	Date August 17, 2011
Name (Print/Typed) James A. Oliff	Registration Number 27,075
Name (Print/Typed) Vitaliy Orekhov	Registration Number 66,731

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Your Ref.: 144849

Our Ref.: 908388US01 (YM/ayk)

## English Translation of Annexes to IPRP

## CLAIMS

1. (Amended) A control system for a secondary battery (220) configured to exchange electric power with a load,
- 5        said secondary battery including
- first and second electrodes (12, 15) each configured to include an active material (18) containing a predetermined material, and
- an ionic conductor (14) for conducting said predetermined material which is ionized between said first and second electrodes,
- 10        the control system comprising:
- a concentration estimating unit (202) configured to estimate an electrolyte ion concentration in an electrolytic solution of said ionic conductor based on a use state of said secondary battery; and
- a charging/discharging control unit (204) for controlling charging/discharging of
- 15        said secondary battery based on an estimated value (B#) of said electrolyte ion concentration provided by said concentration estimating unit, so as to maintain said electrolyte ion concentration within a normal range,
- said concentration estimating unit (202) including
- a first change ratio estimating unit (210) configured to calculate an
- 20        estimated value ( $\Delta B$ ) of a ratio of change in said electrolyte ion concentration in
- accordance with a previously found characteristic regarding a change in said electrolyte ion concentration relative to a charging/discharging current (Ib) and a
- charging/discharging time (tbat) in charging/discharging said secondary battery (220)
- with a fixed current, based on said charging/discharging current and said
- 25        charging/discharging time of said secondary battery with said charging/discharging current, and
- a concentration estimated value calculating unit (230) configured to
- sequentially obtain said estimated value (B#) of said electrolyte ion concentration by

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## English Translation of Annexes to IPRP

accumulating a change in said electrolyte ion concentration caused by use of said secondary battery, according to said estimated value of said ratio of change calculated by said first change ratio estimating unit.

5                   2. (Canceled)

10                   3. (Amended) The control system for a secondary battery according to claim 1, wherein said first change ratio estimating unit (210) is configured to make reference to a map (221) storing a previously determined relation among said charging/discharging current ( $I_b$ ), said charging/discharging time ( $t_{bat}$ ), and said ratio of change, so as to obtain said estimated value ( $\Delta B$ ) of said ratio of change for each charging/discharging of said secondary battery (220) based on said charging/discharging current and said charging/discharging time.

15                   4. (Amended) The control system for a secondary battery according to claim 1, wherein said first change ratio estimating unit (210) is configured to make reference to a map (221) storing a previously determined relation among said charging/discharging current ( $I_b$ ), said charging/discharging time ( $t_{bat}$ ), and said ratio of change for each electrolyte ion concentration, so as to obtain said estimated value ( $\Delta B$ ) of said ratio of change for each charging/discharging of said secondary battery (220), based on said electrolyte ion concentration ( $B\#$ ), said charging/discharging current, and said charging/discharging time at the time of charging/discharging.

20                   5. (Amended) The control system for a secondary battery according to claim 1, wherein:

25                   said concentration estimating unit (202) further includes  
                    a second change ratio estimating unit (215) configured to calculate said estimated value ( $\Delta B$ ) of said ratio of change in said electrolyte ion concentration caused

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by relaxation of said secondary battery during a non-use period in which the charging/discharging of said secondary battery (220) is stopped, at least based on a temperature ( $T_{bst}$ ) of said secondary battery and a length ( $t_{st}$ ) of said non-use period,

5 said concentration estimated value calculating unit (230) is configured to calculate said estimated value ( $B\#$ ) of said electrolyte ion concentration at a start of use of said secondary battery based on said estimated value of said ratio of change calculated by said second change ratio estimating unit.

10 6. The control system for a secondary battery according to claim 1, wherein said charging/discharging control unit (204) includes  
a determining unit (250) configured to determine that said electrolyte ion concentration is outside the normal range when a difference between said estimated value ( $B\#$ ) of said electrolyte ion concentration provided by said concentration estimating unit (202) and an initial value ( $B_0$ ) of said electrolyte ion concentration is  
15 greater than a first predetermined value ( $\alpha_1$ ), and  
a charging/discharging condition modifying unit (260) configured to modify a charging/discharging condition ( $W_{in}$ ,  $W_{out}$ ,  $t(W_{in})$ ,  $t(W_{out})$ ) of said secondary battery (220) to bring said electrolyte ion concentration back to said normal range when said determining unit determines that said electrolyte ion concentration is  
20 outside the normal range.

7. The control system for a secondary battery according to claim 6, wherein:  
said determining unit (250) is configured to determine that said electrolyte ion concentration is brought back to said normal range, when said difference between said  
25 estimated value ( $B\#$ ) of said electrolyte ion concentration and said initial value ( $B_0$ ) of said electrolyte ion concentration is brought to be smaller than a second predetermined value ( $\alpha_2$ ) smaller than said first predetermined value ( $\alpha_1$ ) after said determining unit (250) has determined that said electrolyte ion concentration is outside said normal range,

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and

said charging/discharging condition modifying unit (260) is configured to stop modifying said charging/discharging condition ( $W_{in}$ ,  $W_{out}$ ,  $t(W_{in})$ ,  $t(W_{out})$ ) when said determining unit determines that said electrolyte ion concentration is brought back to said normal range.

5

8. The control system for a secondary battery according to claim 1, wherein:  
said charging/discharging control unit (204) includes

a concentration change detecting unit (252) configured to obtain, for each predetermined period, an amount of change ( $\Delta B\#(n)$ ) in said estimated value ( $B\#$ ) of said electrolyte ion concentration during the predetermined period,

10

a tendency sensing unit (254) configured to calculate, based on said amount of change found by said concentration change detecting unit, a first frequency ( $N1$ ) indicating how frequent said electrolyte ion concentration reaches/goes above a predetermined value, and a second frequency ( $N2$ ) indicating how frequent said electrolyte ion concentration reaches/goes below a predetermined value,

15

a determining unit (255) configured to determine that said electrolyte ion concentration is outside the normal range when said first frequency and said second frequency calculated by said tendency sensing unit satisfy a first predetermined condition, and

20

a charging/discharging condition modifying unit (260) configured to modify a charging/discharging condition ( $W_{in}$ ,  $W_{out}$ ,  $t(W_{in})$ ,  $t(W_{out})$ ) of said secondary battery (220) to bring back said electrolyte ion concentration to said normal range when said determining unit determines that said electrolyte ion concentration is outside the normal range.

25

9. The control system for a secondary battery according to claim 8, wherein said predetermined period is a period of time with a fixed length.

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10. The control system for a secondary battery according to claim 8, wherein said predetermined period corresponds to a period of time from start of driving of said load to end of the driving.

5

11. The control system for a secondary battery according to claim 8, wherein: said determining unit (255) is configured to determine that said electrolyte ion concentration is brought back to said normal range when said first frequency (N1) and said second frequency (N2) calculated by said tendency sensing unit (245) satisfy a second predetermined condition after said determining unit (255) has determined that said electrolyte ion concentration is outside said normal range, and

10

said charging/discharging condition modifying unit (260) is configured to stop modifying said charging/discharging condition (Win, Wout, t(Win), t(Wout)) when said determining unit determines that said electrolyte ion concentration is brought back to said normal range.

15

12. The control system for a secondary battery according to claim 1, wherein: said charging/discharging control unit (204) includes

20

a determining unit (250, 250#) configured to determine whether or not said electrolyte ion concentration is within said normal range, in accordance with said estimated value (B#) of said electrolyte ion concentration provided by said concentration estimating unit (202), and

25

a charging/discharging condition modifying unit (260) configured to make a predetermined time (t(Win), t(Wout)) relatively shorter than that when said electrolyte ion concentration is within the normal range, in limiting the charging/discharging by setting a first electric power (Win) and a second electric power (Wout) able to be continuously input and output to and from said secondary battery (220) over said predetermined time, when said determining unit determines that said

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electrolyte ion concentration is outside the normal range.

13. The control system for a secondary battery according to claim 1, wherein:  
said charging/discharging control unit (204) includes

5 a determining unit (250, 250#) configured to determine whether or not  
said electrolyte ion concentration is within said normal range, in accordance with said  
estimated value of said electrolyte ion concentration provided by said concentration  
estimating unit, and

10 a charging/discharging condition modifying unit (260) configured to  
decrease an absolute value of at least one of a first electric power (Win) and a second  
electric power (Wout) able to be continuously input and output to and from said  
secondary battery over a predetermined time ( $t(Win)$ ,  $t(Wout)$ ), as compared with that  
when said electrolyte ion concentration is within the normal range, in limiting the  
charging/discharging by setting said first and said second electric powers, when said  
15 determining unit determines that said electrolyte ion concentration is outside the normal  
range.

14. (Amended) The control system for a secondary battery according to any  
one of claims 1, 3-13, wherein said predetermined material is lithium.

20 15. (Amended) An electrically powered vehicle (100), comprising:  
the control system for a secondary battery (220) according to any one of claims  
1, 3-13; and

25 a motor (140A, 140B) provided as said load of said control system for a  
secondary battery,

the electrically powered vehicle being configured such that said motor generates  
a vehicle driving force.

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## English Translation of Annexes to IPRP

16. (Amended) A method for controlling a secondary battery (220) configured to exchange electric power with a load,  
said secondary battery including  
first and second electrodes (12, 15) each configured to include an active  
5 material (18) containing a predetermined material, and  
an ionic conductor (14) for conducting said predetermined material  
which is ionized between said first and second electrodes,  
the method comprising the steps of:  
estimating (S102) an electrolyte ion concentration in an electrolytic solution of  
10 said ionic conductor based on a use state of said secondary battery; and  
controlling (S104) charging/discharging of said secondary battery based on an  
estimated value (B#) of said electrolyte ion concentration provided by said step of  
estimating, so as to maintain said electrolyte ion concentration within a normal range,  
said step (S102) of estimating including the steps of  
15 calculating (S110) an estimated value ( $\Delta B$ ) of a ratio of change in said  
electrolyte ion concentration in accordance with a previously found characteristic  
regarding a change in said electrolyte ion concentration relative to a  
charging/discharging current ( $I_b$ ) and a charging/discharging time ( $t_{bat}$ ) in  
charging/discharging said secondary battery (220) with a fixed current, based on said  
20 charging/discharging current and said charging/discharging time of said secondary  
battery with said charging/discharging current, and  
sequentially obtaining (S120) said estimated value (B#) of said  
electrolyte ion concentration by accumulating a change in said electrolyte ion  
concentration caused by use of said secondary battery, according to said estimated value  
25 of said ratio of change thus calculated.

17. (Canceled)

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## English Translation of Annexes to IPRP

18. (Amended) The method for controlling a secondary battery according to claim 16, wherein:

in said step (S110) of calculating, said estimated value ( $\Delta B$ ) of said ratio of change is obtained for each charging/discharging of said secondary battery (220) based on said charging/discharging current and said charging/discharging time, with reference to a map (221) storing a previously determined relation among said charging/discharging current ( $I_b$ ), said charging/discharging time ( $t_{bat}$ ), and said ratio of change.

19. (Amended) The method for controlling a secondary battery according to claim 16, wherein:

in said step (S110) of calculating, said estimated value ( $\Delta B$ ) of said ratio of change for each charging/discharging of said secondary battery (220) is obtained based on said electrolyte ion concentration ( $B\#$ ), said charging/discharging current, and said charging/discharging at the time of charging/discharging, with reference to a map (221) storing a previously determined relation among said charging/discharging current ( $I_b$ ), said charging/discharging time ( $t_{bat}$ ), and said ratio of change for each electrolyte ion concentration.

20. (Amended) The method for controlling a secondary battery according to claim 16, wherein:

said step (S110) of calculating includes a step (S119a-c) of calculating said estimated value ( $\Delta B$ ) of said ratio of change in said electrolyte ion concentration caused by relaxation of said secondary battery during a non-use period in which the charging/discharging of said secondary battery (220) is stopped, at least based on a temperature ( $T_{bst}$ ) of said secondary battery and a length ( $t_{st}$ ) of said non-use period, and

in said step (S120) of sequentially obtaining said estimated value of said

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## English Translation of Annexes to IPRP

electrolyte ion concentration at a start of use of said secondary battery is obtained based on said estimated value of said ratio of change calculated during said non-use period.

21. The method for controlling a secondary battery according to claim 16,  
5 wherein:

said step (S104) of controlling charging/discharging includes the steps of  
determining (S130) that said electrolyte ion concentration is outside the  
normal range when a difference between said estimated value (B#) of said electrolyte  
ion concentration provided by said step (S102) of estimating and an initial value (B0) of  
10 said electrolyte ion concentration is greater than a first predetermined value ( $\alpha 1$ ), and  
modifying (S140) a charging/discharging condition (Win, Wout, t(Win),  
t(Wout)) of said secondary battery to bring said electrolyte ion concentration back to  
said normal range when it is determined that said electrolyte ion concentration is  
outside the normal range.

15

22. The method for controlling a secondary battery according to claim 21,  
wherein:

said step (S130) of determining includes a sub step (S133, S133#, S134) of  
determining that said electrolyte ion concentration is brought back to said normal range,  
20 when said difference between said estimated value of said electrolyte ion concentration  
and said initial value of said electrolyte ion concentration is brought to be smaller than  
a second predetermined value ( $\alpha 2$ ) smaller than said first predetermined value ( $\alpha 1$ ) after  
it has been determined that said electrolyte ion concentration is outside said normal  
range, and

25 said step (S104) of controlling charging/discharging includes a step (S143) of  
stopping modifying said charging/discharging condition (Win, Wout, t(Win), t(Wout))  
when said sub step of determining determines that said electrolyte ion concentration is  
brought back to said normal range.

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23. The method for controlling a secondary battery according to claim 16,  
wherein:

5           said step (S104) of controlling charging/discharging includes the steps of  
          obtaining (S137), for each predetermined period, an amount of change  
( $\Delta B\#(n)$ ) in said estimated value ( $B\#$ ) of said electrolyte ion concentration during the  
predetermined period,  
          calculating (S138), based on said amount of change thus found, a first  
frequency ( $N1$ ) indicating how frequent said electrolyte ion concentration reaches/goes  
10       above a predetermined value, and a second frequency ( $N2$ ) indicating how frequent said  
electrolyte ion concentration reaches/goes below a predetermined value,  
          determining (S132#, S134) that said electrolyte ion concentration is  
outside the normal range when said first frequency and said second frequency satisfy a  
first predetermined condition, and  
15       modifying (S142) a charging/discharging condition ( $Win$ ,  $Wout$ ,  $t(Win)$ ,  
 $t(Wout)$ ) of said secondary battery to bring back said electrolyte ion concentration to  
said normal range when it is determined that said electrolyte ion concentration is  
outside the normal range.

20           24. The method for controlling a secondary battery according to claim 23,  
wherein said predetermined period is a period of time with a fixed length.

          25. The method for controlling a secondary battery according to claim 23,  
wherein said predetermined period corresponds to a period of time from start of driving  
25       of said load to end of the driving.

          26. The method for controlling a secondary battery according to claim 23,  
wherein:

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said step of determining includes a sub step (S133#, S135) of determining that said electrolyte ion concentration is brought back to said normal range when said first frequency (N1) and said second frequency thus calculated satisfy a second predetermined condition after it has been determined that said electrolyte ion concentration is outside said normal range, and

said step (S104) of controlling charging/discharging further includes a step (S143) of stopping modifying said charging/discharging condition (Win, Wout, t(Win), t(Wout)) when said sub step of determining determines that said electrolyte ion concentration is brought back to said normal range.

27. The method for controlling a secondary battery according to claim 16, wherein:

said step (S104) of controlling charging/discharging includes the steps of determining (S130) whether or not said electrolyte ion concentration is within said normal range, in accordance with said estimated value (B#) of said electrolyte ion concentration provided by said step (S102) of estimating, and making (S142) a predetermined time (t(Win), t(Wout)) relatively shorter than that when said electrolyte ion concentration is within the normal range, in limiting the charging/discharging by setting a first electric power (Win) and a second electric power (Wout) able to be continuously input and output to and from said secondary battery (220) over said predetermined time, when it is determined that said electrolyte ion concentration is outside the normal range.

28. The method for controlling a secondary battery according to claim 16, wherein:

said step (S104) of controlling charging/discharging includes the steps of determining (S130) whether or not said electrolyte ion concentration is within said normal range, in accordance with said estimated value (B#) of said

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electrolyte ion concentration provided by said step (S102) of estimating, and  
decreasing (S142) an absolute value of at least one of a first electric  
power ( $W_{in}$ ) and a second electric power ( $W_{out}$ ) able to be continuously input and  
output to and from said secondary battery over a predetermined time ( $t(W_{in})$ ,  $t(W_{out})$ ),  
5 as compared with that when said electrolyte ion concentration is within the normal  
range, in limiting the charging/discharging by setting said first and said second electric  
powers, when it is determined that said electrolyte ion concentration is outside the  
normal range.

10 29. (Amended) The method for controlling a secondary battery according to  
any one of claims 16, 18-28, wherein said predetermined material is lithium.

30. (Amended) The method for controlling a secondary battery according to  
any one of claims 16, 18-28, wherein:

15 said secondary battery (220) is mounted on an electrically powered vehicle  
(100), and

said load includes a motor (140A, 140B) for generating driving force for a  
wheel of said electrically powered vehicle.

PCT/JP2008/067235

日本国特許庁 09.4.2009

35

## 請求の範囲

- [1] (補正後) 負荷との間で電力を授受可能に構成された二次電池(220)の制御システムであって、
- 前記二次電池は、
- 所定物質を含む活物質(18)を含んで構成される第1および第2の電極(12, 15)と、
- 前記第1および第2の電極間でイオン化した前記所定物質を伝導するためのイオン伝導体(14)とを含み、
- 前記制御システムは、
- 前記二次電池の使用状態に基づいて、前記イオン伝導体における電解液中の電解質イオン濃度を推定するように構成された濃度推定部(202)と、
- 前記濃度推定部による前記電解質イオン濃度の推定値(B#)に基づいて、前記電解質イオン濃度を正常範囲に維持するように前記二次電池の充放電を制御するための充放電制御部(204)とを備え、
- 前記濃度推定部(202)は、
- 前記二次電池(220)の一定電流での充放電における充放電電流(Ib)および充放電時間(tbat)に対する前記電解質イオン濃度の変化についての予め求められた特性に従って、前記二次電池の前記充放電電流および当該充放電電流での前記充放電時間に基づいて、前記電解質イオン濃度の変化率の推定値( $\Delta B$ )を算出するように構成された第1の変化率推定部(210)と、
- 前記第1の変化率推定部によって算出された変化率推定値に従って、前記二次電池の使用に伴う前記電解質イオン濃度の変化を積算することによって、前記電解質イオン濃度の推定値(B#)を逐次求めるように構成された濃度推定値算出部(230)とを含む、二次電池の制御システム。
- [2] (削除)
- [3] (補正後) 前記第1の変化率推定部(210)は、予め求められた、前記充放電電流(Ib)および前記充放電時間(tbat)と前記変化率との関係を格納したマップ(221)の参照によって、前記二次電池(220)の充放電毎に前記充放電電流および前記充放

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電時間に基づいて前記変化率推定値( $\Delta B$ )を求めるように構成される、請求の範囲  
第1項記載の二次電池の制御システム。

- [4] (補正後) 前記第1の変化率推定部(210)は、予め求められた、前記電解質イオン  
濃度毎に

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おける、前記充放電電流( $I_b$ )および前記充放電時間( $t_{bat}$ )と前記変化率との関係を格納したマップ(221)の参照によって、前記二次電池(220)の充放電毎に、そのときの前記電解質イオン濃度( $B\#$ )、前記充放電電流および前記充放電時間に基づいて前記変化率推定値( $\Delta B$ )を求めるように構成される、請求の範囲第1項記載の二次電池の制御システム。

[5] (補正後) 前記濃度推定部(202)は、

前記二次電池(220)からの充放電が停止されている非使用期間において、前記二次電池が緩和されることによる前記電解質イオン濃度の変化率の推定値( $\Delta B$ )を、少なくとも前記二次電池の温度( $T_{bst}$ )および前記非使用期間( $t_{st}$ )の長さに基づいて算出するように構成された第2の変化率推定部(215)をさらに含み、

前記濃度推定値算出部(230)は、前記第2の変化率推定部により算出された変化率推定値に基づいて、前記二次電池の使用開始時点における前記電解質イオン濃度の推定値( $B\#$ )を算出するように構成される、請求の範囲第1項記載の二次電池の制御システム。

[6] 前記充放電制御部(204)は、

前記濃度推定部(202)による前記電解質イオン濃度の推定値( $B\#$ )と、前記電解質イオン濃度の初期値( $B_0$ )との差が第1の所定値以上( $\alpha 1$ )となったときに、前記電解質イオン濃度が正常範囲外であると判定するように構成された判定部(250)と、

前記判定部によって前記電解質イオン濃度が正常範囲外であると判定されたときに、前記電解質イオン濃度を前記正常範囲に復帰させるために、前記二次電池(220)の充放電条件( $W_{in}$ ,  $W_{out}$ ,  $t(W_{in})$ ,  $t(W_{out})$ )の修正を行なうように構成された充放電条件修正部(260)とを含む、請求の範囲第1項記載の二次電池の制御システム。

[7] 前記判定部(250)は、前記電解質イオン濃度が前記正常範囲外であると判定した後に、前記電解質イオン濃度の推定値( $B\#$ )と、前記電解質イオン濃度の初期値( $B_0$ )との差が、前記第1の所定値( $\alpha 1$ )よりも低い第2の所定値( $\alpha 2$ )以下に復帰したときには、前記電解質イオン濃度が前記正常範囲に復帰したと判定するように構成され、

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前記充放電条件修正部(260)は、前記判定部によって前記電解質イオン濃度が前記正常範囲に復帰したと判定されたときには、前記充放電条件( $W_{in}$ ,  $W_{out}$ ,  $t(W_{in})$ ,  $t(W_{out})$ )の修正を停止するように構成される、請求の範囲第6項記載の二次電池の制御システム。

[8] 前記充放電制御部(204)は、

所定期間毎に当該期間内における前記電解質イオン濃度の推定値( $B\#$ )の変化量( $\Delta B\#(n)$ )を求めるように構成された濃度変化検出部(252)と、

前記濃度変化検出部によって求められた変化量に基づいて、前記電解質イオン濃度が所定以上上昇する頻度を示す第1の頻度( $N1$ )および前記電解質イオン濃度が所定以上低下する頻度を示す第2の頻度( $N2$ )を算出するように構成された傾向検知部(254)と、

前記傾向検知部によって算出された前記第1の頻度および前記第2の頻度が第1の所定条件を満たしたときに、前記電解質イオン濃度が正常範囲外であると判定するように構成された判定部(255)と、

前記判定部によって前記電解質イオン濃度が正常範囲外であると判定されたときに、前記電解質イオン濃度を前記正常範囲に復帰させるために、前記二次電池(220)の充放電条件( $W_{in}$ ,  $W_{out}$ ,  $t(W_{in})$ ,  $t(W_{out})$ )の修正を行なうように構成された充放電条件修正部(260)とを含む、請求の範囲第1項記載の二次電池の制御システム。

[9] 前記所定期間は、一定長さの時間である、請求の範囲第8項記載の二次電池の制御システム。

[10] 前記所定期間は、前記負荷の運転開始から運転終了までの期間に対応する、請求の範囲第8項記載の二次電池の制御システム。

[11] 前記判定部(255)は、前記電解質イオン濃度が前記正常範囲外であると判定した後に、前記傾向検知部(245)によって算出された前記第1の頻度( $N1$ )および前記第2の頻度( $N2$ )が第2の所定条件を満たしたときには、前記電解質イオン濃度が前記正常範囲に復帰したと判定するように構成され、

前記充放電条件修正部(260)は、前記判定部によって前記電解質イオン濃度が

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前記正常範囲に復帰したと判定されたときには、前記充放電条件(Win, Wout, t(Win), t(Wout))の修正を停止するように構成される、請求の範囲第8項記載の二次電池の制御システム。

- [12] 前記充放電制御部(204)は、  
前記濃度推定部(202)による前記電解質イオン濃度の推定値(B#)に従って、前記電解質イオン濃度が前記正常範囲であるか否かを判定するように構成された判定部(250, 250#)と、

前記判定部によって前記電解質イオン濃度が正常範囲外であると判定されたときには、前記二次電池(220)が所定時間(t(Win), t(Wout))に渡って継続的に入力可能な第1の電力(Win)および出力可能な第2の電力(Wout)を設定することによって実行される充放電制限において、前記所定時間を、前記電解質イオン濃度が正常範囲であるときと比較して相対的に短縮するように構成された充放電条件修正部(260)とを含む、請求の範囲第1項記載の二次電池の制御システム。

- [13] 前記充放電制御部(204)は、  
前記濃度推定部による前記電解質イオン濃度の推定値に従って、前記電解質イオン濃度が前記正常範囲であるか否かを判定するように構成された判定部(250, 250#)と、

前記判定部によって前記電解質イオン濃度が正常範囲外であると判定されたときには、前記二次電池が所定時間(t(Win), t(Wout))に渡って継続的に入力可能な第1の電力(Win)および出力可能な第2の電力(Wout)を設定することによって実行される充放電制限において、前記第1および前記第2の電力のうちの少なくとも一方の絶対値を、前記電解質イオン濃度が正常範囲であるときと比較して相対的に低下させるように構成された充放電条件修正部(260)とを含む、請求の範囲第1項記載の二次電池の制御システム。

- [14] (補正後) 前記所定物質はリチウムである、請求の範囲第1, 3～13項のいずれか1項に記載の二次電池の制御システム。

- [15] (補正後) 電動車両(100)であって、  
請求の範囲第1, 3～13項のいずれか1項に記載の二次電池(220)の制御システムと

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、  
前記二次電池の制御システムの前記負荷として設けられた電動機(140A, 140B)  
とを備え、

前記電動車両は、前記電動機によって車両駆動力を発生するように構成される、  
電動車両。

[16] (補正後) 負荷との間で電力を授受可能に構成された二次電池(220)の制御方法  
であって、

前記二次電池は、  
所定物質を含む活物質(18)を含んで構成される第1および第2の電極(12, 15)と

、  
前記第1および第2の電極間でイオン化した前記所定物質を伝導するためのイオン  
伝導体(14)とを含み、

前記制御方法は、

前記二次電池の使用状態に基づいて、前記イオン伝導体における電解液中の電  
解質イオン濃度を推定するステップ(S102)と、

前記推定するステップによる前記電解質イオン濃度の推定値(B#)に基づいて、  
前記電解質イオン濃度を正常範囲に維持するように前記二次電池の充放電を制御  
するステップ(S104)とを備え、

前記推定するステップ(S102)は、

前記二次電池(220)の一定電流での充放電における充放電電流(Ib)および充放  
電時間(tbat)に対する前記電解質イオン濃度の変化についての予め求められた特  
性に従って、前記二次電池の前記充放電電流および当該充放電電流での前記充放  
電時間に基づいて、前記電解質イオン濃度の変化率の推定値( $\Delta B$ )を算出するステ  
ップ(S110)と、

算出された変化率推定値に従って、前記二次電池の使用に伴う前記電解質イオン  
濃度の変化を積算することによって、前記電解質イオン濃度の推定値(B#)を逐次  
求めるステップ(S120)とを含む、二次電池の制御方法。

[17] (削除)

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- [18] (補正後) 前記算出するステップ(S110)は、予め求められた、前記充放電電流( $I_b$ )および前記充放電時間( $t_{bat}$ )と前記変化率との関係を格納したマップ(221)の参照によって、前記二次電池(220)の充放電毎に前記充放電電流および前記充放電時間に基づいて前記変化率推定値( $\Delta B$ )を求める、請求の範囲第16項記載の二次電池の制御方法。

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- [19] (補正後) 前記算出するステップ(S110)は、予め求められた、前記電解質イオン濃度毎における、前記充放電電流(Ib)および前記充放電時間(tbat)と前記変化率との関係を格納したマップ(221)の参照によって、前記二次電池(220)の充放電毎に、そのときの前記電解質イオン濃度(B#)、前記充放電電流および前記充放電時間に基づいて前記変化率推定値( $\Delta B$ )を求める、請求の範囲第16項記載の二次電池の制御方法。
- [20] (補正後) 前記算出するステップ(S110)は、  
前記二次電池(220)からの充放電が停止されている非使用期間において、前記二次電池が緩和されることによる前記電解質イオン濃度の変化率の推定値( $\Delta B$ )を、少なくとも前記二次電池の温度(Tbst)および前記非使用期間の長さ(tst)に基づいて算出するステップ(S119a-c)を含み、  
前記逐次求めるステップ(S120)は、前記非使用期間に算出された変化率推定値に基づいて、前記二次電池の使用開始時点における前記電解質イオン濃度の推定値を求める、請求の範囲第16項記載の二次電池の制御方法。
- [21] 前記充放電を制御するステップ(S104)は、  
前記推定するステップ(S102)による前記電解質イオン濃度の推定値(B#)と、前記電解質イオン濃度の初期値(B0)との差が第1の所定値( $\alpha 1$ )以上となったときに、前記電解質イオン濃度が正常範囲外であると判定するステップ(S130)と、  
前記電解質イオン濃度が正常範囲外であると判定されたときに、前記電解質イオン濃度を前記正常範囲に復帰させるために、前記二次電池の充放電条件(Win, Wout, t(Win), t(Wout))の修正を行なうステップ(S140)とを含む、請求の範囲第16項記載の二次電池の制御方法。
- [22] 前記判定するステップ(S130)は、前記電解質イオン濃度が前記正常範囲外であると判定した後に、前記電解質イオン濃度の推定値と、前記電解質イオン濃度の初期値との差が、前記第1の所定値( $\alpha 1$ )よりも低い第2の所定値( $\alpha 2$ )以下に復帰したときには、前記電解質イオン濃度が前記正常範囲に復帰したと判定するサブステップ(S133, S133#, S134)を含み、  
前記充放電を制御するステップ(S104)は、前記判定するサブステップにより前記

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電解質イオン濃度が前記正常範囲に復帰したと判定されたときには、前記充放電条件(Win, Wout, t(Win), t(Wout))の修正を停止するステップ(S143)を含む、請求の範囲第21項記載の二次電池の制御方法。

- [23] 前記充放電を制御するステップ(S104)は、  
所定期間毎に当該期間内における前記電解質イオン濃度の推定値(B#)の変化量( $\Delta B\#(n)$ )を求めるステップ(S137)と、  
求められた変化量に基づいて、前記電解質イオン濃度が所定以上上昇する頻度を示す第1の頻度(N1)および前記電解質イオン濃度が所定以上低下する頻度を示す第2の頻度(N2)を算出するステップ(S138)と、  
前記第1の頻度および前記第2の頻度が第1の所定条件を満たしたときに、前記電解質イオン濃度が正常範囲外であると判定するステップ(S132#, S134)と、  
前記電解質イオン濃度が正常範囲外であると判定されたときに、前記電解質イオン濃度を前記正常範囲に復帰させるために、前記二次電池の充放電条件(Win, Wout, t(Win), t(Wout))の修正を行なうステップ(S142)とを含む、請求の範囲第16項記載の二次電池の制御方法。
- [24] 前記所定期間は、一定長さの時間である、請求の範囲第23項記載の二次電池の制御方法。
- [25] 前記所定期間は、前記負荷の運転開始から運転終了までの期間に対応する、請求の範囲第23項記載の二次電池の制御方法。
- [26] 前記判定するステップは、  
前記電解質イオン濃度が前記正常範囲外であると判定した後に、算出された前記第1の頻度(N1)および前記第2の頻度が第2の所定条件を満たしたときには、前記電解質イオン濃度が前記正常範囲に復帰したと判定するサブステップ(S133#, S135)を含み、  
前記充放電を制御するステップ(S104)は、前記判定するサブステップにより前記電解質イオン濃度が前記正常範囲に復帰したと判定されたときには、前記充放電条件(Win, Wout, t(Win), t(Wout))の修正を停止するステップ(S143)をさらに含む、請求の範囲第23項記載の二次電池の制御方法。

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- [27] 前記充放電を制御するステップ(S104)は、  
前記推定するステップ(S102)による前記電解質イオン濃度の推定値(B#)に従って、前記電解質イオン濃度が前記正常範囲であるか否かを判定するステップ(S130)と、  
前記電解質イオン濃度が正常範囲外であると判定されたときには、前記二次電池(220)が所定時間(t(Win), t(Wout))に渡って継続的に入力可能な第1の電力(Win)および出力可能な第2の電力(Wout)を設定することによって実行される充放電制限において、前記所定時間を、前記電解質イオン濃度が正常範囲であるときと比較して相対的に短縮するステップ(S142)とを含む、請求の範囲第16項記載の二次電池の制御方法。
- [28] 前記充放電を制御するステップ(S104)は、  
前記推定するステップ(S102)による前記電解質イオン濃度の推定値(B#)に従って、前記電解質イオン濃度が前記正常範囲であるか否かを判定するステップ(S130)と、  
前記電解質イオン濃度が正常範囲外であると判定されたときには、前記二次電池(220)が所定時間(t(Win), t(Wout))に渡って継続的に入力可能な第1の電力(Win)および出力可能な第2の電力(Wout)を設定することによって実行される充放電制限において、前記第1および前記第2の電力のうちの少なくとも一方の絶対値を、前記電解質イオン濃度が正常範囲であるときと比較して相対的に低下させるステップ(S142)とを含む、請求の範囲第16項記載の二次電池の制御方法。
- [29] (補正後) 前記所定物質はリチウムである、請求の範囲第16, 18~28項のいずれか1項に記載の二次電池の制御方法。
- [30] (補正後) 前記二次電池(220)は、電動車両(100)に搭載され、  
前記負荷は、前記電動車両の車輪の駆動力を発生する電動機(140A, 140B)を含む、請求の範囲第16, 18~28項のいずれか1項に記載の二次電池の制御方法。

## PATENT COOPERATION TREATY

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ON PATENTABILITY  
(CHAPTER I OR CHAPTER II  
OF THE PATENT COOPERATION TREATY)  
(PCT Rules 44bis.3(c) and 72.2)



To:

FUKAMI, Hisao  
Fukami Patent Office,  
Nakanoshima Central Tower, 22nd Floor  
2-7, Nakanoshima 2-chome, Kita-ku, Osaka-shi, Osaka  
5300005  
JAPON

Date of mailing (day/month/year)  
17 June 2010 (17.06.2010)

Applicant's or agent's file reference  
908388WO01

**IMPORTANT NOTIFICATION**

International application No.  
PCT/JP2008/067235

International filing date (day/month/year)  
25 September 2008 (25.09.2008)

Applicant

TOYOTA JIDOSHA KABUSHIKI KAISHA et al

**1. Transmittal of the translation to the applicant.**

The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

**2. Transmittal of the copy of the translation to the designated or elected Offices.**

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

EP, KR, MY

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AO, AP, AT, AU, AZ, BA, BB, BG, BH, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DO, DZ, EA, EC, EE, EG, ES, FI, GB, GD, GE, GH, GM, GT, HN, HR, HU, ID, IL, IN, IS, KE, KG, KM, KN, KP, KZ, LA, LC, LK, LR, LS, LT, LU, LY, MA, MD, ME, MG, MK, MN, MW, MX, MZ, NA, NG, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RS, RU, SC, SD, SE, SG, SK, SL, SM, ST, SV, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, ZA, ZM, ZW

**3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).**

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

Authorized officer

Yoshiko Kuwahara

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**TRANSLATION****PATENT COOPERATION TREATY****PCT****INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**  
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference <b>908388WO01</b>	FOR FURTHER ACTION See Form PCT/IPEA/416	
International application No. <b>PCT/JP2008/067235</b>	International filing date (day/month/year) <b>25.09.2008</b>	Priority date (day/month/year) <b>15.10.2007</b>
International Patent Classification (IPC) or national classification and IPC <b>H01M10/44 (2006.01) i, B60L3/00 (2006.01) i, G01R31/36 (2006.01) i, H01M10/48 (2006.01) i, H02J7/00 (2006.01) i, B60L11/14 (2006.01) n</b>		
Applicant <b>TOYOTA JIDOSHA KABUSHIKI KAISHA</b>		

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of \_\_\_\_\_ sheets, including this cover sheet.

3. This report is also accompanied by ANNEXES, comprising:

a. ☒ (sent to the applicant and to the International Bureau) a total of **8** sheets, as follows:

☒ sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).

☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.

b. ☐ (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) \_\_\_\_\_, containing a sequence listing and/or tables related thereto, in electronic form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:

☒ Box No. I Basis of the report

☐ Box No. II Priority

☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

☐ Box No. IV Lack of unity of invention

☒ Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

☐ Box No. VI Certain documents cited

☐ Box No. VII Certain defects in the international application

☐ Box No. VIII Certain observations on the international application

Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/JP	Authorized officer
Facsimile No.	Telephone No.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY		International application No. <b>PCT/JP2008/067235</b>
<b>Box No. I</b>	<b>Basis of the report</b>	
<p>1. With regard to the language, this report is based on:</p> <p><input checked="" type="checkbox"/> the international application in the language in which it was filed</p> <p><input type="checkbox"/> a translation of the international application _____, which is the language of a translation furnished for the purposes of:</p> <p style="margin-left: 20px;"><input type="checkbox"/> international search (Rules 12.3(a) and 23.1(b))</p> <p style="margin-left: 20px;"><input type="checkbox"/> publication of the international application (Rule 12.4(a))</p> <p style="margin-left: 20px;"><input type="checkbox"/> international preliminary examination (Rule 55.2(a) and/or 55.3(a))</p> <p>2. With regard to the elements of the international application, this report is based on (replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):</p> <p><input type="checkbox"/> the international application as originally filed/furnished</p> <p><input checked="" type="checkbox"/> the description:</p> <p style="margin-left: 20px;">pages <u>1-34</u> _____ as originally filed/furnished</p> <p style="margin-left: 20px;">pages* _____ received by this Authority on _____</p> <p style="margin-left: 20px;">pages* _____ received by this Authority on _____</p> <p><input checked="" type="checkbox"/> the claims:</p> <p style="margin-left: 20px;">nos. <u>6-13, 21-28</u> _____ as originally filed/furnished</p> <p style="margin-left: 20px;">nos.* _____ as amended (together with any statement) under Article 19</p> <p style="margin-left: 20px;">nos.* <u>1, 3-5, 14-16, 18-20, 29, 30</u> received by this Authority on <u>09.04.2009</u></p> <p style="margin-left: 20px;">nos.* _____ received by this Authority on _____</p> <p><input checked="" type="checkbox"/> the drawings:</p> <p style="margin-left: 20px;">sheets <u>figures 1-19</u> _____ as originally filed/furnished</p> <p style="margin-left: 20px;">sheets* _____ received by this Authority on _____</p> <p style="margin-left: 20px;">sheets* _____ received by this Authority on _____</p> <p><input type="checkbox"/> a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.</p> <p>3. <input checked="" type="checkbox"/> The amendments have resulted in the cancellation of:</p> <p style="margin-left: 20px;"><input type="checkbox"/> the description, pages _____</p> <p style="margin-left: 20px;"><input checked="" type="checkbox"/> the claims, nos. <u>2, 17</u> _____</p> <p style="margin-left: 20px;"><input type="checkbox"/> the drawings, sheets/figs _____</p> <p style="margin-left: 20px;"><input type="checkbox"/> the sequence listing (specify): _____</p> <p style="margin-left: 20px;"><input type="checkbox"/> any table(s) related to sequence listing (specify): _____</p> <p>4. <input type="checkbox"/> This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).</p> <p style="margin-left: 20px;"><input type="checkbox"/> the description, pages _____</p> <p style="margin-left: 20px;"><input type="checkbox"/> the claims, nos. _____</p> <p style="margin-left: 20px;"><input type="checkbox"/> the drawings, sheets/figs _____</p> <p style="margin-left: 20px;"><input type="checkbox"/> the sequence listing (specify): _____</p> <p style="margin-left: 20px;"><input type="checkbox"/> any table(s) related to sequence listing (specify): _____</p> <p>5. <input type="checkbox"/> This report has been established taking into account the rectification of an obvious mistake authorized by or notified to this Authority under Rule 91 (Rule 70.2(e)).</p> <p>6. <input type="checkbox"/> Supplementary international search report(s) from Authority(ies) _____ have been received and taken into account in drawing up this report (Rule 45bis.8(b) and (c)).</p> <p>* If item 4 applies, some or all of those sheets may be marked "superseded."</p>		

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY		International application No. PCT/JP2008/067235
Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	
1. Statement		
Novelty (N)	Claims <u>1, 3-16, 18-30</u>	YES
	Claims _____	NO
Inventive step (IS)	Claims <u>1, 3-16, 18-30</u>	YES
	Claims _____	NO
Industrial applicability (IA)	Claims <u>1, 3-16, 18-30</u>	YES
	Claims _____	NO
2. Citations and explanations (Rule 70.7)		
<p>Document 1: JP 2007-141558 A (Toyota Motor Corp.), 07 June 2007, claims 1, 2; paragraphs [0061] to [0078], [0094] to [0100]; fig. 2, 3, 5, 6, 10 to 12, 19</p> <p>Document 2: JP 2006-42497 A (Toyota Motor Corp.), 09 February 2006, entire text</p> <p>Document 3: JP 2003-346919 A (Nissan Motor Co., Ltd.), 05 December 2003, entire text</p> <p>Document 4: JP 7-263031 A (Sony Corp.), 13 October 1995, entire text</p> <p>The invention as in claims 1, 3-16, and 18-30 is not disclosed in any of the documents cited in the ISR, and would not be obvious to a person skilled in the art.</p>		

**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Kenji KAITA, Teruo ISHISHITA, Shinobu OKAYAMA, Yuji NISHII and Daisuke  
KURODA

Application No.: 12/678,659

Filed: March 17, 2010

Docket No.: 144849


For: Control System for Secondary Battery, Electrically Powered Vehicle Having  
Same, and Method for Cotrolling Secondary Battery

**STATEMENT THAT THE ENGLISH LANGUAGE TRANSLATION OF  
PATENTABLE CLAIMS OF THE PCT APPLICATION IS ACCURATE**

I Yutaka Horii, hereby declare and state that I am knowledgeable of each of the  
Japanese and English languages. I hereby certify that the attached English language  
translation is a complete and accurate translation of the patentable claims of the PCT  
application.

August 12, 2011

Date

  
Signature

Yutaka Horii

Name

## 特許協力条約

PCT

特許性に関する国際予備報告（特許協力条約第二章）

（法第12条、法施行規則第56条）

〔PCT36条及びPCT規則70〕

出願人又は代理人 の書類記号 908388W001	今後の手続きについては、様式PCT/IPEA/416を参照すること。	
国際出願番号 PCT/JP2008/067235	国際出願日 (日.月.年) 25.09.2008	優先日 (日.月.年) 15.10.2007
国際特許分類 (IPC) Int.Cl. H01M10/44(2006.01)i, B60L3/00(2006.01)i, G01R31/36(2006.01)i, H01M10/48(2006.01)i, H02J7/00(2006.01)i, B60L11/14(2006.01)n		
出願人 (氏名又は名称) トヨタ自動車株式会社		

1. この報告書は、PCT35条に基づきこの国際予備審査機関で作成された国際予備審査報告である。 法施行規則第57条（PCT36条）の規定に従い送付する。
2. この国際予備審査報告は、この表紙を含めて全部で 3 ページからなる。
3. この報告には次の附属物件も添付されている。 a. <input checked="" type="checkbox"/> 附属書類は全部で 8 ページである。 <input checked="" type="checkbox"/> 補正されて、この報告の基礎とされた及び／又はこの国際予備審査機関が認めた訂正を含む明細書、請求の範囲及び／又は図面の用紙（PCT規則70.16及び実施細則第607号参照） <input type="checkbox"/> 第I欄4.及び補充欄に示したように、出願時における国際出願の開示の範囲を超えた補正を含むものとこの国際予備審査機関が認定した差替え用紙 b. <input type="checkbox"/> 配列表に関する補充欄に示され、電子形式のみで提出された、配列表又は配列表に関連するテーブルを含む電子媒体は全部で (電子媒体の種類、数を示す)。 (実施細則第802号参照)
4. この国際予備審査報告は、次の内容を含む。 <input checked="" type="checkbox"/> 第I欄 国際予備審査報告の基礎 <input type="checkbox"/> 第II欄 優先権 <input type="checkbox"/> 第III欄 新規性、進歩性又は産業上の利用可能性についての国際予備審査報告の不作成 <input type="checkbox"/> 第IV欄 発明の単一性の欠如 <input checked="" type="checkbox"/> 第V欄 PCT35条(2)に規定する新規性、進歩性又は産業上の利用可能性についての見解、それを裏付けるための文献及び説明 <input type="checkbox"/> 第VI欄 ある種の引用文献 <input type="checkbox"/> 第VII欄 国際出願の不備 <input type="checkbox"/> 第VIII欄 国際出願に対する意見

国際予備審査の請求書を受理した日 09.04.2009	国際予備審査報告を作成した日 01.07.2009	
名称及びあて先 日本国特許庁 (IPEA/JP) 郵便番号100-8915 東京都千代田区霞が関三丁目4番3号	特許庁審査官 (権限のある職員) 須田 裕一 電話番号 03-3581-1101 内線 3477	4X 3558

様式PCT/IPEA/409 (表紙) (2009年1月)

## 特許性に関する国際予備報告

国際出願番号 PCT/J P 2008/067235

## 第 I 欄 報告の基礎

1. 言語に関し、この予備審査報告は以下のものを基礎とした。

- ☒ 出願時の言語による国際出願
- ☐ 出願時の言語から次の目的のための言語である \_\_\_\_\_ 語に翻訳された、この国際出願の翻訳文
- ☐ 国際調査 (PCT規則12.3(a)及び23.1(b))
- ☐ 国際公開 (PCT規則12.4(a))
- ☐ 国際予備審査 (PCT規則55.2(a)又は55.3(a))

2. この報告は下記の出願書類を基礎とした。(法第6条(PCT14条)の規定に基づく命令に応答するために提出された差替え用紙は、この報告において「出願時」とし、この報告に添付していない。)

- ☐ 出願時の国際出願書類
- ☒ 明細書
- 第 1-34 \_\_\_\_\_ ページ、出願時に提出されたもの
- 第 \_\_\_\_\_ ページ\*、 \_\_\_\_\_ 付けで国際予備審査機関が受理したもの
- 第 \_\_\_\_\_ ページ\*、 \_\_\_\_\_ 付けで国際予備審査機関が受理したもの
- ☒ 請求の範囲
- 第 6-13, 21-28 \_\_\_\_\_ 項、出願時に提出されたもの
- 第 \_\_\_\_\_ 項\*、PCT19条の規定に基づき補正されたもの
- 第 1, 3-5, 14-16, 18-20, 29, 30 \_\_\_\_\_ 項\*、09.04.2009 付けで国際予備審査機関が受理したもの
- 第 \_\_\_\_\_ 項\*、 \_\_\_\_\_ 付けで国際予備審査機関が受理したもの
- ☒ 図面
- 第 1-19 \_\_\_\_\_ ページ/図、出願時に提出されたもの
- 第 \_\_\_\_\_ ページ/図\*、 \_\_\_\_\_ 付けで国際予備審査機関が受理したもの
- 第 \_\_\_\_\_ ページ/図\*、 \_\_\_\_\_ 付けで国際予備審査機関が受理したもの
- ☐ 配列表又は関連するテーブル
- 配列表に関する補充欄を参照すること。

3. ☒ 補正により、下記の書類が削除された。

- ☐ 明細書 第 \_\_\_\_\_ ページ
- ☒ 請求の範囲 第 2, 17 \_\_\_\_\_ 項
- ☐ 図面 第 \_\_\_\_\_ ページ/図
- ☐ 配列表 (具体的に記載すること) \_\_\_\_\_
- ☐ 配列表に関連するテーブル (具体的に記載すること) \_\_\_\_\_

4. ☐ この報告は、補充欄に示したように、この報告に添付されかつ以下に示した補正が出願時における開示の範囲を超えてされたものと認められるので、その補正がされなかったものとして作成した。(PCT規則70.2(c))

- ☐ 明細書 第 \_\_\_\_\_ ページ
- ☐ 請求の範囲 第 \_\_\_\_\_ 項
- ☐ 図面 第 \_\_\_\_\_ ページ/図
- ☐ 配列表 (具体的に記載すること) \_\_\_\_\_
- ☐ 配列表に関連するテーブル (具体的に記載すること) \_\_\_\_\_

5. ☐ この報告は、PCT規則91の規定により国際予備審査機関が認めた又は国際予備審査機関に通知された明らかな誤りの訂正を考慮して作成した(PCT規則70.2(e))。6. ☐ この報告を作成するにあたり、補充国際調査機関である \_\_\_\_\_ から受領した補充国際調査報告を考慮した。(PCT規則45の2.8(b)及び(c))

\* 4. に該当する場合、その用紙に“superseded”と記入されることがある。

## 特許性に関する国際予備報告

国際出願番号 PCT/JP2008/067235

第V欄 新規性、進歩性又は産業上の利用可能性についての法第12条(PCT35条(2))に定める見解、  
それを裏付ける文献及び説明

## 1. 見解

新規性(N)	請求項 1, 3-16, 18-30	有
	請求項	無
進歩性(IS)	請求項 1, 3-16, 18-30	有
	請求項	無
産業上の利用可能性(IA)	請求項 1, 3-16, 18-30	有
	請求項	無

## 2. 文献及び説明(PCT規則70.7)

文献1: JP 2007-141558 A (トヨタ自動車株式会社) 2007.06.07, 請求項1、2、【0061】-【0078】、【0094】-【0100】、図2、3、5、6、10-12、19

文献2: JP 2006-42497 A (トヨタ自動車株式会社) 2006.02.09, 全文

文献3: JP 2003-346919 A (日産自動車株式会社) 2003.12.05, 全文

文献4: JP 7-263031 A (ソニー株式会社) 1995.10.13, 全文

請求項1、3-16、18-30に係る発明は、国際調査報告で引用されたいずれの文献にも記載されておらず、当業者にとって自明でもない。



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,659	03/17/2010	Keiji Kaita	144849	1306
25944	7590	11/17/2011		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER KING, RODNEY P	
			ART UNIT 3665	PAPER NUMBER
			NOTIFICATION DATE 11/17/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com  
jarmstrong@oliff.com



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

OLIFF & BERRIDGE, PLC  
P.O. BOX 320850  
ALEXANDRIA VA 22320-4850

In re application of : **DECISION ON REQUEST TO**  
Kaita et al. : **PARTICIPATE IN PATENT**  
Application No. 12/678,659 : **PROSECUTION HIGHWAY**  
Filed: March 17, 2010 : **PROGRAM AND PETITION**  
For: CONTROL SYSTEM FOR SECONDARY : **TO MAKE SPECIAL UNDER**  
BATTERY, ELECTRICALLY POWERED : **37 CFR 1.102(a)**  
VEHICLE HAVING SAME, AND METHOD  
FOR CONTROLLING SECONDARY  
BATTERY

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed August 17, 2011 to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications filed in the JPO or USPTO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the PCT application(s) latest international work product (the written opinion or the IPER) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the PCT application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of the latest international work product from the PCT application containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
- (6) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH pilot program complies with the above requirements. Therefore, the above-identified application has been accorded "special" status.

All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Mikado Buiz, Quality Assurance Specialist, at (571) 272-6578.

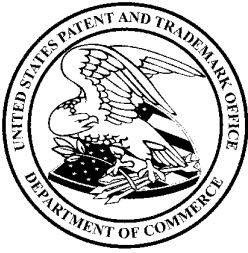
/ Mikado Buiz /  
Mikado Buiz,  
Quality Assurance Specialist  
Technology Center 3600

MB/MB: 11/16/11

<b>Doc Code: PET.AUTO</b> <b>Document Description: Petition automatically granted by EFS-Web</b>		PTO/SB/83 U.S. Patent and Trademark Office Department of Commerce
Electronic Petition Request	<b>REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS</b>	
Application Number	12678670	
Filing Date	26-Aug-2010	
First Named Inventor	Norman Lafrance	
Art Unit	3735	
Examiner Name	CHARLES MARMOR II	
Attorney Docket Number	346715-0728 (MIP-022/PCT/	
Title	THERAPEUTIC INFUSION AND TRANSFER SYSTEM FOR USE WITH RADIOACTIVE AGENTS	
<input checked="" type="radio"/> Please withdraw me as attorney or agent for the above identified patent application and the practitioners of record associated with Customer Number: <span style="float: right;">48329</span>		
The reason(s) for this request are those described in 37 CFR: 10.40(b)(4)		
Certifications		
<input checked="" type="checkbox"/> I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment		
<input checked="" type="checkbox"/> I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled		
<input checked="" type="checkbox"/> I/We have notified the client of any responses that may be due and the time frame within which the client must respond		
Change the correspondence address and direct all future correspondence to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71:		
Name	MR. JOHN GARVEY K&L GATES	
Address	ONE LINCOLN STREET	
City	BOSTON	
State	MA	
Postal Code	02111	
Country	US	

I am authorized to sign on behalf of myself and all withdrawing practitioners.

Signature	/MICHEL MORENCY/
Name	MICHEL MORENCY
Registration Number	50183



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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Decision Date : April 17, 2012

In re Application of :

Norman Lafrance

Application No : 12678670

Filed : 26-Aug-2010

Attorney Docket No : 346715-0728 (MIP-022/PCT/

DECISION ON REQUEST TO WITHDRAW AS  
ATTORNEY/AGENT OF RECORD

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed April 17, 2012

The request is **APPROVED**.

The request was signed by MICHEL MORENCY (registration no. 50183 ) on behalf of all attorneys/agents associated with Customer Number 48329 . All attorneys/agents associated with Customer Number 48329 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with correspondence address:

Name MR. JOHN GARVEY  
Name2 K&L GATES  
Address 1 ONE LINCOLN STREET  
Address 2  
City BOSTON  
State MA  
Postal Code 02111  
Country US

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Office of Petitions



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**PCT LEGAL ADMINISTRATION**

FISH & RICHARDSON, PC  
P.O. BOX 1022  
MINNEAPOLIS MN 55440-1022

In re Application of	:	
CROSBIE et al.	:	
Application No.: 12/678,709	:	DECISION
PCT No.: PCT/AU2008/001378	:	
Int. Filing Date: 17 September 2008	:	
Priority Date: 17 September 2007	:	
Attorney Docket No.: 27530-0002US1/509190	:	
For: LAYOUT MANAGER	:	

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 01 October 2010 in the United States Patent and Trademark Office (USPTO). The petition is **GRANTED**.

**BACKGROUND**

On 17 September 2008, applicants filed international application PCT/AU2008/001378, which designated the United States and claimed a priority date of 17 September 2007. A copy of the international application was communicated from the International Bureau to the USPTO on 26 March 2009. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 March 2010.

On 17 March 2010, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 13 April 2010, the United States Designated/Elected Office (DO/EO/US) issued a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a two-month extendable period for response.

On 11 June 2010, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors and a statement of refusal to sign by non-signing inventor Vittorio Cordioli.

On 20 July 2010, a decision was issued dismissing without prejudice applicants' petition under 37 CFR 1.47(a) because factual proof that the missing joint inventor refuses to execute the

application or cannot be reached after diligent effort had not been provided. Specifically, it was noted that it was not clear that the non-signing inventor Vittorio Cordioli had been presented with the application papers including the specification, claims, and drawings.

On 01 October 2010, applicants filed the instant renewed petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a one-month extension of time and a second statement of refusal to sign by non-signing inventor Vittorio Cordioli.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As noted in the decision issued 20 July 2010, items (1), (3), and (4) have been satisfied.

Item (2) has now been satisfied as well. The second statement of refusal to sign by non-signing inventor Vittorio Cordioli indicates that he was presented with a copy of the application papers including the specification, claims, and drawings.

### **CONCLUSION**

For the reasons set forth above, applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to each of the non-signing inventors at their respective last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of **11 June 2010**.

/Daniel Stemmer/  
Daniel Stemmer  
Legal Examiner

Application No.: 12/678,709

-3-

PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301



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**PCT LEGAL ADMINISTRATION**

Mr. Vittorio Cordioli  
Unit 6, 30 Riviera Street  
Mentone, Victoria 3194  
AUSTRALIA

In re Application of  
CROSBIE et al.  
Application No.: 12/678,709  
PCT No.: PCT/AU2008/001378  
Int. Filing Date: 17 September 2008  
Priority Date: 17 September 2007  
Attorney Docket No.: 27530-0002US1/509190  
For: LAYOUT MANAGER

Dear Mr. Cordioli:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/Daniel Stemmer/  
Daniel Stemmer  
PCT Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301

FISH & RICHARDSON, PC  
P.O. BOX 1022  
MINNEAPOLIS MN 55440-1022



UNITED STATES PATENT AND TRADEMARK OFFICE

24 AUG 2010

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WORKMAN NYDEGGER/Leica  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City UT 84111

In re Application of :  
BUEHLMANN, et al. :  
U.S. Application No.: 12/678,727 : DECISION ON PETITION  
PCT No.: PCT/EP2008/006944 :  
Int. Filing Date: 23 August 2008 : UNDER 37 CFR 1.47(a)  
Priority Date: 24 September 2007 :  
Attorney Docket No.: 16455.78 :  
For: POSITION DETERMINATION METHOD :

This decision is in response to applicant's petition under 37 C.F.R. 1.47(a) filed 15 July 2010 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 23 August 2008, applicant filed international application PCT/EP2008/006944 which claimed priority to an earlier application filed 24 September 2007. A copy of the international application was transmitted to the United States on 02 April 2009. Pursuant to 37 CFR 1.495 the period for providing payment of the full, U.S. Basic National Fee was set to expire thirty months from the priority date, or midnight 24 March 2010.

On 17 March 2010, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by among other items, payment of the requisite basic national fee.

On 27 April 2010, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 15 July 2010, applicant filed the present petition under 37 CFR 1.47(a) accompanied by a petition for a one-month extension of time and payment of the appropriate extension of time fee. The response is timely filed.

**DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or

cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied all four items and it is therefore proper to grant applicant's petition at this time.

**CONCLUSION**

For the reasons above, applicant's petition under 37 CFR 1.47(a) is **GRANTED**.

The application has an international filing date of 23 August 2008 under 35 U.S.C. 363, and will be given a date of **15 July 2010** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(c), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record. A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the DO/EO/US for processing in accordance with this decision. Specifically, the mailing of a Notification of Acceptance (Form PCT/DO/EO/903).



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294



UNITED STATES PATENT AND TRADEMARK OFFICE

24 AUG 2010

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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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Mr. Andreas Buehlmann  
Seestrasse 250  
CH-3658 Merligen am Thunersee  
SWITZERLAND

In re Application of  
BUEHLMANN, et al.  
U.S. Application No.: 12/678,727  
PCT No.: PCT/EP2008/006944  
Int. Filing Date: 23 August 2008  
Priority Date: 24 September 2007  
Attorney Docket No.: 16455.78  
For: POSITION DETERMINATION METHOD

Dear Mr. Buehlmann:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor. As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternately, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, the law firm of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294

Counsel of Record:

WORKMAN NYDEGGER/Leica  
1000 Eagle Gate Tower  
60 East South Temple  
Salt Lake City UT 84111  
United States of America

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**DATE** : 07/13/11

**TO SPE OF** : ART UNIT: **2873 Attn: MACK RICKY L (SPE)**

**SUBJECT** : Request for Certificate of Correction for Appl. No.: **12/678730** Patent No.: **7940477**

CofC mailroom date: **06/23/11**

Please respond to this request for a certificate of correction within 7 days.

**FOR IFW FILES:**

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

**FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

**Certificates of Correction Branch (CofC)**  
**Randolph Square – 9D10-A**  
**Palm Location 7580**

**Note:** **Please check Claims 15 to 23**

**Tasneem Siddiqui**

**Certificates of Correction Branch**

**703-756-1814 & 703-756-1593**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

☐ **Approved**

All changes apply.

☐ **Approved in Part**

Specify below which changes do not apply.

☐ **Denied**

State the reasons for denial below.

**Comments:** **Please do no enter any changes to claims 15-23. (The changes to claims 10-13 are approved for entry).**

**SPE**

**2873**  
**Art Unit**

**Siddiqui, Tasneem**

---

**From:** Mack, Ricky  
**Sent:** Tuesday, September 27, 2011 3:26 PM  
**To:** Siddiqui, Tasneem  
**Subject:** FW: SPE's Responses 3 01-13-2006 for IFW docs (2) (2).doc  
**Attachments:** SPE's Reponse 3 01-13-2006 for IFW docs.pdf  
**Importance:** High

Good afternoon,

My electronic signature is on the document. Please let me know if you have trouble seeing it (call for quicker response).

**Comments:** Please do no enter any changes to claims 15-23. (The changes to claims 10-13 are approved for entry).

---

/Ricky Mack/

**SPE**

**2873**  
**Art Unit**

OL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark

Thanks,  
Ricky

Ricky L. Mack  
Supervisory Patent Examiner  
Art Unit 2873  
United States Patent and Trademark Office  
(571)272-2333



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Patent No. : 7940477 B2  
Application No.: 12/678730  
Inventor(s) : BRUN et al.  
Issued : May 10, 2011  
Attorney Docket Number: P1992WOUS

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322.

The request for certificate of correction is approved in part.

According to the Examiner please do not enter changes to claims 15-23. The changes to claims 10-13 are approved for entry.

In view of the foregoing, your request, in this matter, is hereby denied.

A certificate of correction will be issued for the remaining errors noted on your request.

Tasneem Siddiqui  
For Mary Diggs (Supervisor)  
Decisions & Certificates of Correction Branch  
(703) 756-1593 or (703) 756-1814  
Date: 10/07/2011

Address: John E. Nielsen  
LARIVIERE, GRUBMAN & PAYNE, LLP  
P.O. Box 3140  
Monterey, CA 93942

ts

14 SEP 2010



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LAW OFFICE OF STEPHEN D. BURBACH/RAMBUS  
2155 VERDUGO BLVD., BOX 28  
MONTROSE CA 91020

In re Application of	:	
SHAEFFER et al.	:	DECISION
Application No.: 12/678,739	:	
PCT No.: PCT/US2008/074247	:	
Int. Filing Date: 25 August 2008	:	
Priority Date: 27 September 2007	:	
Attorney's Docket No.: R1-1071US	:	
For: RECONFIGURABLE MEMORY SYSTEM	:	
DATA STROBES	:	

This decision is in response to applicants' submission filed in the United States Patent and Trademark Office (USPTO) on 01 August 2010. The submission has properly been treated as a petition under 37 CFR 1.181. No petition fee is due.

**BACKGROUND**

On 25 August 2008, applicants filed international application PCT/US2008/074247 which claimed a priority date of 27 September 2007 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 02 April 2009. The thirty-month period for paying the basic national fee in the United States expired at midnight on 29 March 2010 (27 March 2010 being a Saturday).

On 17 March 2010, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee.

On 29 June 2010, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) for late submission of the oath or declaration were required.

On 30 June 2010, applicants submitted, *inter alia*, a declaration of inventors as well as a communication indicating that the declaration had been timely submitted in compliance with PCT Rule 4.17(iv) in the international phase and thus the surcharge under 37 CFR 1.492(h) was not required..

On 14 July 2010, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating, *inter alia*, that the surcharge under 37 CFR 1.492(h) was not received.

On 01 August 2010, applicants filed the instant submission, which has properly been treated as a petition under 37 CFR 1.181.

### **DISCUSSION**

Applicants urge that a declaration in compliance with PCT Rule 4.17(iv) was provided within the time limits set forth in PCT Rule 26ter.1 in the international phase and thus both the NOTICE OF MISSING REQUIREMENTS mailed 29 June 2010 and the NOTIFICATION OF DEFECTIVE RESPONSE mailed 14 July 2010 were in error.

Although a declaration under PCT Rule 4.17(iv) does not appear with the published international application on the WIPO website, such a declaration does appear in the RO/US file for the international application; the declaration was filed with the Request on 25 August 2008 and thus was submitted within the appropriate time limit. (A copy of the declaration has been copied from the RO/US file for the international application to the electronic file for the instant application.) This declaration is sufficient. Accordingly, the NOTICE OF MISSING REQUIREMENTS mailed 29 June 2010 and the NOTIFICATION OF DEFECTIVE RESPONSE mailed 14 July 2010 are hereby VACATED. The surcharge under 37 CFR 1.492(h) is not required.

### **CONCLUSION**

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

The NOTIFICATION OF MISSING REQUIREMENTS mailed 29 June 2010 is **VACATED**.

The NOTIFICATION OF DEFECTIVE RESPONSE mailed 14 July 2010 is **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application.

/Daniel Stemmer/  
Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration; Telephone: (571) 272-3301



UNITED STATES PATENT AND TRADEMARK OFFICE

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22850.

OBLON, SPIVAK, MCCLELLAND AND MAIER & NEUSTADT, L.L.P.  
1940 Duke Street  
Alexandria, VA 22314

In re Application of :  
SAWADA *et al* :  
Application No.: 12/678,765 :  
PCT No.: PCT/JP2008/064420 :  
Int. Filing Date: 11 August 2008 :  
Priority Date: 18 September 2007 :  
Attorney Docket No.: 356510US26PCT :  
For: VAPORIZING UNIT, FILM FORMING :  
APPARATUS, FILM FORMING :  
METHOD, COMPUTER PROGRAM :  
AND STORAGE MEDIUM :

**DECISION**

This decision is in response to the petition under 37 CFR 1.182 filed 20 May 2010.

**BACKGROUND**

On 20 May 2010, applicants filed the subject petition which was accompanied by, *inter alia*, a statement (declaration) of the inventor whose name has changed, an executed declaration, a Supplemental Application Data Sheet, and the petition fee.

**DISCUSSION**

Applicants petition to change the name of the second listed inventor from Sumie SEGAWA to Sumie NAGASEKI.

Section 605.04(c), *Inventor Changes Name*, of the MPEP lists the procedures required to change the name of an inventor and states, in part:

The petition must include an appropriate petition fee and an affidavit signed by the inventor setting forth both names and the procedure whereby the change of name was effected, or a certified copy of the court order.

Applicants have provided a statement by the inventor whose name has changed which lists both names and indicating that the change was as a result of a marriage. The \$400.00 petition fee was also provided.

This is sufficient for a grantable petition.

**CONCLUSION**

Applicants' petition under 37 CFR 1.182 is **GRANTED**.

The second listed inventor's name has changed to Sumie NAGASEKI.

The declaration submitted on 20 May 2010 is in compliance with 37 CFR 1.497(a) and (b).

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing



James Thomson

Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302

<b>Doc Code: PET.AUTO</b> <b>Document Description: Petition automatically granted by EFS-Web</b>		PTO/SB/83 U.S. Patent and Trademark Office Department of Commerce
Electronic Petition Request	<b>REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS</b>	
Application Number	12678776	
Filing Date	20-Apr-2010	
First Named Inventor	Yerramilli Murthy	
Art Unit	1635	
Examiner Name	RICHARD SCHNIZER	
Attorney Docket Number	027585-002401US	
Title	Pharmaceutical Compositions for Administering Oligonucleotides	
<input checked="" type="radio"/> Please withdraw me as attorney or agent for the above identified patent application and the practitioners of record associated with Customer Number: <span style="float: right;">20350</span>		
The reason(s) for this request are those described in 37 CFR: 10.40(b)(4)		
Certifications		
<input checked="" type="checkbox"/> I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment		
<input checked="" type="checkbox"/> I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled		
<input checked="" type="checkbox"/> I/We have notified the client of any responses that may be due and the time frame within which the client must respond		
Change the correspondence address and direct all future correspondence to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71:		
Name	IDEXX Laboratories, Inc.	
Address	One IDEXX Drive	
City	Westbrook	
State	ME	
Postal Code	04092	
Country	US	

I am authorized to sign on behalf of myself and all withdrawing practitioners.

Signature	/John McGroarty/
Name	John McGroarty
Registration Number	41186



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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Decision Date : May 24,2011

In re Application of :

Yerramilli Murthy

Application No : 12678776

Filed : 20-Apr-2010

Attorney Docket No : 027585-002401US

DECISION ON REQUEST TO WITHDRAW AS  
ATTORNEY/AGENT OF RECORD

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed May 24,2011

The request is **APPROVED**.

The request was signed by John McGroarty (registration no. 41186 ) on behalf of all attorneys/agents associated with Customer Number 20350 . All attorneys/agents associated with Customer Number 20350 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with correspondence address:

Name IDEXX Laboratories, Inc.

Name2

Address 1 One IDEXX Drive

Address 2

City Westbrook

State ME

Postal Code 04092

Country US

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Office of Petitions



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UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,794	06/08/2010	Mikio Iwamura	17470/058001	1392
22511	7590	07/13/2011		
OSHA LIANG L.L.P. TWO HOUSTON CENTER 909 FANNIN, SUITE 3500 HOUSTON, TX 77010			EXAMINER BOST, DWAYNE D	
			ART UNIT	PAPER NUMBER
			2617	
			NOTIFICATION DATE	DELIVERY MODE
			07/13/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com  
hathaway@oshaliang.com  
kennedy@oshaliang.com



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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

**OSHA LIANG L.L.P.  
TWO HOUSTON CENTER  
909 FANNIN, SUITE 3500  
HOUSTON TX 77010**

**In re Application of  
IWAMURA et al.  
Application No.: 12/678,794  
Filed: 08 June 2010  
Attorney Docket No.: 17470/058001  
For: BROADCAST INFORMATION  
TRANSMISSION METHOD, RADIO  
BASE STATION AND MOBILE  
STATION**

**: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)**

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed on 16 June 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PPH pilot program and petition to make special require:

1. The U.S. application is
  - a. a Paris Convention application which either
    - i. validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
  - b. a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
    - i. validly claims priority to an application filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
    - iii. contains no priority claim, or
  - c. a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
    - i. validly claims priority to an application filed in the JPO, or

- ii. validly claims priority to a PCT application that contains no priority claims, or
  - iii. contains no priority claim;
- 2. Applicant must submit a copy of:
  - a. The allowable/patentable claim(s) from the JPO application(s);
  - b. An English translation of the allowable/patentable claim(s) and
  - c. A statement that the English translation is accurate;
- 3. Applicant must:
  - a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s) and
  - b. Submit a claims correspondence table in English;
- 4. Examination of the U.S. application has not begun;
- 5. Applicant must submit:
  - a. Documentation of prior office action:
    - i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claim(s) or
    - ii. if the allowable/patentable claims(s) are from a "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
    - iii. if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form;
  - b. An English language translation of the JPO Office action from (5)(a)(i)-(ii) above
  - c. A statement that the English translation is accurate;
- 6. Applicant must submit:
  - a. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
  - b. Copies of the documents except U.S. patents or U.S. patent application publications (unless already submitted in this application);

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Inquiries concerning this decision should be directed to Lee W. Young at 571-272-4549.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

This application will be forwarded to the examiner for action on the merits commensurate with this decision once this application's formality reviews have been completed.



Lee W. Young  
TQAS, Technology Center 2600



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ARLINGTON VA 22203

**MAILED**

DEC 16 2010

PCT LEGAL ADMINISTRATION

In re Application of : DECISION ON  
HELLER et al :  
Application No.: 12/678,811 :  
PCT No.: PCT/EP2008/062441 :  
Int. Filing Date: 18 September 2008 : PAPERS FILED  
Priority Date: 18 September 2007 :  
Attorney's Docket No.: BHD-5256-36 :  
For: AMPHIPHILIC COPOLYMERS ... POLYMERS : UNDER 37 CFR 1.42

This is a decision on the declaration filed 27 August 2010, which has been treated as a request for status under 37 CFR 1.42.

**BACKGROUND**

On 18 March 2010, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration was submitted at such time.

On 13 May 2010, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date." It also stated that items set forth above must be submitted within two months from date of mailing or by 32 months from the priority date, whichever is later. Failure to properly respond will result in abandonment."

On 27 August 2010, applicants submitted a responded to the Notice by filing an executed declaration which is signed, *inter alia*, by Gloria Galen Heller as legal representative (administratrix) of the deceased first joint inventor Jorge Heller.

**DISCUSSION**

A review of the application file reveals that the declaration does not comply with 37 C.F.R. §1.497(b)(2).

Because joint inventor Jorge HELLER is deceased and Gloria Galen HELLER has been appointed as the legal representative for the deceased inventor, 37 C.F.R. §1.497(b)(2) indicates that "[i]f the person making the oath or the declaration or any supplemental or oath or declaration is not the inventor (§§1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state (the inventor's citizenship and so on). If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative." (see MPEP § 409.01)

The executed declaration submitted is signed by Jorge Heller as legal representative of the deceased joint inventor Jorge Heller and it indicates her citizenship but her residence and mailing address have not been included as required under 37 C.F.R. §1.497(b)(2) and 37 CFR 1.64. The citizenship, residence and mailing address of the of the deceased inventor has been provided in the declaration.

### CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **not accepted**.

Applicant is required to provide an oath or declaration in compliance with 37 CFR 1.497(a)-(b) within TWO (2) MONTHS from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Tel: (571) 272-3276  
Fax: (571) 273-0459



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**MAILED**

**APR 12 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of : DECISION ON  
HELLER et al :  
Application No.: 12/678,811 :  
PCT No.: PCT/EP2008/062441 :  
Int. Filing Date: 18 September 2008 : PAPERS FILED  
Priority Date: 18 September 2007 :  
Attorney's Docket No.: BHD-5256-36 :  
For: AMPHIPHILIC COPOLYMERS ... POLYMERS : UNDER 37 CFR 1.42

This is a decision on the "RESPONSE TO DECISION... TO THIS APPLICATION,"  
filed on 16 February 2011.

**BACKGROUND**

In a decision from this Office on 16 December 2010, the request filed on 27 August 2010  
was not accepted under 37 CFR 1.42.

On 16 February 2011, applicant filed the present renewed petition, which also included a  
renewed submission under 37 CFR § 1.42 accompanied with an executed declaration.

**DISCUSSION**

Applicants have provided a new executed declaration, which sets forth that Ms. Gloria  
Galen Heller is the legal representative (Administratrix) of the deceased co-inventor, Mr. Jorge  
Heller and it also sets forth her citizenships and residences. The executed declaration now has the  
citizenship, residence and mailing address information for both the legal representative and the  
deceased co-inventor.

Accordingly, the requirements under 37 CFR 1.42 are satisfied and the declaration is  
acceptable at this time.

**DECISION**

The renewed submission filed under 37 CFR 1.42 is **ACCEPTED**.

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision.

A handwritten signature in black ink, appearing to read 'R. Bacares', is positioned above the printed name.

Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Tel: (571) 272-3276  
Fax: (571) 273-0459



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,857		Philip Tan	910180.420USPC	1757
85377	7590	08/20/2010	EXAMINER	
Seed Intellectual Property Law Group PLLC 701 Fifth Avenue, Suite 5400 Seattle, WA 98104			ART UNIT	PAPER NUMBER
			1645	
			MAIL DATE	DELIVERY MODE
			08/20/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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Seed Intellectual Property Law Group PLLC  
701 Fifth Avenue, Suite 5400  
Seattle WA 98104

AUG 20 2010

In re Application of	:	
TAN, PHILIP	:	DECISION ON REQUEST TO
Application No. 12/678,857	:	PARTICIPATE IN PCT-PATENT
Filed: March 18, 2010	:	PROSECUTION HIGHWAY PILOT
Attorney Docket No. 910180.420USPC	:	PROGRAM AND PETITION
	:	TO MAKE SPECIAL UNDER
	:	37 CFR 1.102(d)

This is a decision on the request to participate in the PCT-Patent Prosecution Highway (PPH) Pilot program and the petition under 37 CFR 1.102(d), filed April 21, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT- PPH Pilot program and petition to make special require:

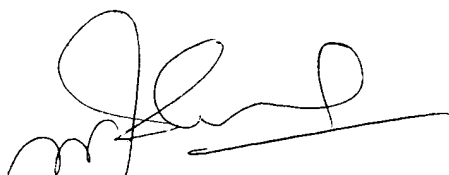
- (1) The U.S. application is a national stage entry of the corresponding EPO PCT application;
- (2) The latest work product in the international phase of the PCT application corresponding to the US application, namely the WO/ISA, or the WO/IPEA, or the IPER, indicates at least one claim in the PCT claim has novelty, inventive step and industrial applicability.
- (3) Applicant must submit a copy of the allowable/patentable claim(s) from the corresponding PCT application(s);
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the PCT application;
- (5) Examination of the U.S. application has not begun;
- (6) Unless already filed in the U.S. application for which participation in the PCT-PPH pilot program is requested, applicant must submit a copy of the latest international work product, WO/ISA, or WO/IPEA or IPER, which indicated that the claim(s) has/have novelty, inventive step and industrial applicability along with an English translation thereof;
- (7) Applicant must submit an IDS listing the documents cited international work product, WO/ISA, or WO/IPEA or IPER along with copies of documents except U.S. patents or U.S. patent application publications; and
- (8) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PCT-PPH Pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Ram R. Shukla at 571-272-0735.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system at the <http://www.uspto.gov/ebc/index.html>.

The application is undergoing pre-examination processing. Once it is released for examination, the application will be forwarded to the examiner for action on the merits commensurate with this decision.

A handwritten signature in black ink, appearing to read 'R. Shukla', with a long horizontal stroke extending to the right.

Ram R. Shukla, Ph.D.

Supervisory Patent Examiner

TC 1600

**RAM R. SHUKLA, PH.D.**

**SUPERVISORY PATENT EXAMINER**

MAILED

OCT 14 2010



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In re Application of	:	DECISION ON
Andrea CHIECCHI	:	
Application No.: 12/678,871	:	
PCT No.: PCT/EP2007/0063437	:	
Int. Filing Date: 06 December 2007	:	PETITION UNDER
Priority Date: 05 October 2006	:	
Attorney's Docket No.:	:	
For: METHOD FOR CONTROLLING...	:	37 CFR 1.47(b)
FOR A WATERCRAFT	:	

This decision is in response to petitioner's "Petition By Person... Cannot be Found (37 CFR 1.47(b))" filed on 22 July 2010, requesting the acceptance of the application without the signature of the sole inventor, Andrea CHIECCHI. Petitioner has provided the \$200 petition fee by check.

### **BACKGROUND**

On 06 December 2007, applicant filed international application PCT/EP2007/0063437, which claimed priority of an earlier application filed 05 October 2006.

On 18 March 2010, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration or oath was submitted at such time.

On 19 May 2010, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 in The United States Designated/Elected Office (DO/EO/US) indicating, *inter alia*, that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The notification set two months from the date of this notice or 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

On 19 May 2010, petitioner filed a petition under 37 CFR 1.47(b), *inter alia*, statements from Michael J. Bujold and Andreas Paul.

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has satisfied items (1), (3)-(4), and (6) but not items (2) and (5) thus not completing the requirements under 37 CFR 1.47(b).

Petitioner has satisfied item (1) because the petition fee has been provided.

Regarding requirement (2), although a complete set of the application papers were mailed to Andrea Chiecchi on June 25, 2010 for his signature, the documentary evidence to support the assertion that he received it is on June 28, 2010 (Proof of Delivery UPS) and the cover letter has been provided.

However, it is not clear from the petition that it was Michael Bujold who performed the items listed in paragraph 4 of his declaration (as it does not state he was the one who mailed the application papers but states that my office mailed a packet of documents), and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Mr. Bujold was not the person who performed the actions listed in paragraph 2, petitioner will need to submit statements, with specific facts on the actions referred to by paragraph 2 by persons who have first-hand knowledge of such facts.

Regarding item (3), applicant has stated the last known address of the inventor:

Andrea Chiecchi  
Via Fincato  
27/3  
37129 Verona  
Italy

Regarding item (4) a declaration has been provided executed by an authorized person of company on behalf of the non-signing sole inventor, Andrea Chiecchi.

Regarding item (6) applicant has presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage.

Application No.: 12/678,871

Regarding item (5) applicant has not submitted proof that applicant has sufficient proprietary interest in the application. Mr. Andreas Paul's statement (Statement of facts ... on behalf of nonsigning inventor) is not sufficient without additional corroborating evidence (i.e., an assignment), and no copy of an executed assignment (signed assignment by inventor Andrea Ciechhi) has been provided with this petition.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office.

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment.

When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record. Note MPEP 409.03(f)

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

### **CONCLUSION**

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

Application No.: 12/678,871

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Telephone: (571) 272-3276  
Facsimile: (571) 273-0459



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CONCORD NH 03301

**MAILED**

**MAR 01 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of	:	DECISION ON RENEWED
Andrea CHIECCHI	:	
Application No.: 12/678,871	:	
PCT No.: PCT/EP2007/0063437	:	
Int. Filing Date: 06 December 2007	:	PETITION UNDER
Priority Date: 05 October 2006	:	
Attorney's Docket No.:	:	
For: METHOD FOR CONTROLLING...	:	37 CFR 1.47(b)
FOR A WATERCRAFT	:	

This decision is in response to applicant's "RENEWED PETITION UNDER 37 CFR 1.47(b)" filed on 07 December 2010 that seeks the acceptance of the application without the signature of sole inventor Michael J. Bujold.

**BACKGROUND**

In a decision from this Office on 14 October 2010, the petition filed on 22 July 2010 was dismissed because 37 CFR 1.47(b) applicant did not satisfy items (2) and (5) under 37 CFR 1.47(b).

On 07 December 2010, applicant filed a renewed petition which includes, inter alia, documentary evidence to support applicant's assertion that the application papers were sent to the non-signing inventor from Michael J. Bujold (who has first hand knowledge of the actions taken) and a legal memorandum submitted by Andreas Paul.

**DISCUSSION**

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner has now satisfied requirements (2) and (5) of 37 CFR 1.47(b), thus completing the requirements under 37 CFR 1.47(b).

Regarding requirement (2), petitioner has provided a declaration of Michael J. Bujold who has first hand knowledge of sending the application papers to Andrea Chiechhi on June 25, 2010 via UPS and received by him, and he has not return the documents signed.

Regarding item (5) 1.47(b) applicant has submitted proof that applicant has sufficient proprietary interest in the application because the legal memorandum prepared by Andreas Paul in which it states that Andrea Chiechhi was subject to an employment policy in which he signed on April 3, 2007 of the company's policy of ZF Friedrichshafen AG regarding incentives for employees innovation. In addition, national laws of Italy and Germany regarding the ownership of inventions developed by an employee during his employment would award the ownership and title of the invention to the 37 CFR 1.47(b) applicant. The relevant parts of these laws have been submitted and translated into English.

Accordingly, it is appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

### **CONCLUSION**

The renewed petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) to continue national stage processing of the application.



Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Telephone: (571) 272-3276  
Facsimile: (571) 272-0459



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Andrea Chiecchi  
Via Fincato  
27/3  
37129 Verona  
Italy

**MAILED**

**MAR 01 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of  
Andrea CHIECCHI  
Application No.: 12/678,871  
PCT No.: PCT/EP2007/0063437  
Int. Filing Date: 06 December 2007  
Priority Date: 05 October 2006  
Attorney's Docket No.:  
For: METHOD FOR CONTROLLING... A WATERCRAFT

Dear Chiecchi:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 118. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Rafael Bacares  
PCT Legal Examiner  
PCT Legal Office  
Telephone: (703) 308-6312  
Facsimile: (703) 308-6459

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**MAIL**

**APR 05 2011**

**DIRECTOR'S OFFICE  
TECHNOLOGY CENTER 2600**

APEX JURIS, PLLC  
12733 LAKE CITY WAY NORTHEAST  
SEATTLE WA 98125

In re Application of	:	
SASAKAWA, TADASHI	:	DECISION ON REQUEST TO
Application No. 12/678,873	:	PARTICIPATE IN PATENT
Filed: March 18, 2010	:	PROSECUTION HIGHWAY
Attorney Docket No. 10.01.03.PCT	:	PROGRAM AND PETITION
	:	TO MAKE SPECIAL UNDER
	:	37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed July 21, 2010 to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Kenneth Wieder at 571-272-2986.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

/Kenneth A. Wieder/

---

Kenneth Wieder  
Quality Assurance Specialist  
Technology Center 2600  
Communications



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Alexandria, VA 22313-1450  
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**MAILED**

**FEB 02 2012**

**OFFICE OF PETITIONS**

**OLIFF & BERRIDGE, PLC  
P.O. BOX 320850  
ALEXANDRIA VA 22320-4850**

**In re Application of  
KOGO, et al  
Application No.: 12/678,876  
Filed: March 18, 2010  
Attorney Docket No.: 144854  
For: CONTROL APPARATUS FOR  
INTERNAL COMBUSTION ENGINE**

**: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)**

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed November 22, 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PPH pilot program and petition to make special require:

1. The U.S. application is
  - a. a Paris Convention application which either
    - i. validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
  - b. a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
    - i. validly claims priority to an application filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
    - iii. contains no priority claim, or
  - c. a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
    - i. validly claims priority to an application filed in the JPO, or

- ii. validly claims priority to a PCT application that contains no priority claims, or
  - iii. contains no priority claim;
- 2. Applicant must submit a copy of:
  - a. The allowable/patentable claim(s) from the JPO application(s);
  - b. An English translation of the allowable/patentable claim(s) and
  - c. A statement that the English translation is accurate;
- 3. Applicant must:
  - a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s) and
  - b. Submit a claims correspondence table in English;
- 4. Examination of the U.S. application has not begun;
- 5. Applicant must submit:
  - a. Documentation of prior office action:
    - i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claim(s) or
    - ii. if the allowable/patentable claims(s) are from a "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
    - iii. if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form;
  - b. An English language translation of the JPO Office action from (5)(a)(i)-(ii) above
  - c. A statement that the English translation is accurate;
- 6. Applicant must submit:
  - a. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
  - b. Copies of the documents except U.S. patents or U.S. patent application publications (unless already submitted in this application);

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

This application is being forwarded to Technology Center AU 3748 for action on the merits commensurate with this decision.

/Diane Goodwyn/  
Diane Goodwyn  
Petitions Examiner  
Office of Petitions



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**OCT 08 2010**  
**PCT LEGAL ADMINISTRATION**

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DAVIS & BUJOLD, P.L.L.C.  
112 PLEASANT STREET  
CONCORD NH 03301

In re Application of	:	DECISION ON
CHIECCHI, Andrea	:	
Application No.: 12/678,879	:	PETITION UNDER
PCT No.: PCT/EP2007/063439	:	
Int. Filing Date: 06 December 2007	:	37 CFR § 1.47(b)
Priority Date: 05 October 2007	:	
Attorney Docket No.: ZF P413US	:	
For: METHOD FOR CONTROLLING A	:	
WATERCRAFT HAVING A SURFACE DRIVE	:	

This is a decision on applicant's petition under 37 CFR 1.47(b) filed in the United States Patent and Trademark Office (USPTO) on 26 July 2010. The petition is **DISMISSED** without prejudice.

#### **BACKGROUND**

On 06 December 2007, applicant filed international application PCT/EP2007/063439 which designated the US and claimed a priority date of 05 October 2007. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 16 April 2009. The thirty-month period for paying the basic national fee in the United States expired at midnight on 05 April 2010.

On 18 March 2010, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 23 April 2010, the United States Designated/Elected Office (DO/EO/US) issued a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 26 July 2010, applicant submitted the instant petition under 37 CFR 1.47(b). The petition was accompanied by, *inter alia*, a declaration of the inventor, a statement of facts by Mr. Michael Bujold with documents in support thereof, and a statement of facts by Andreas Paul with documents in support thereof.

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(g), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1), (3), (4), and (6) have been satisfied.

Item (2) has not been met. A copy of the application papers (specification, including claims, drawings, and oath or declaration) was sent to non-signing inventor Andrea Chiecchi on 25 June 2010 and delivered to his last known address on 28 June 2010. The instant petition was filed on 22 July 2010. Thus, Mr. Chiecchi had less than one month to review the materials, sign, and return the documents. In the instant situation, this is not an adequate amount of time. (Although an e-mail was sent to Mr. Chiecchi on 16 March 2010 and Mr. Chiecchi responded by e-mail on 19 March 2010, the e-mail did not include a copy of the specification including claims and drawings.)

Item (5) has not been met. A copy of an Invention Disclosure document executed by Mr. Chiecchi has been provided. However, an Invention Disclosure statement is not an assignment. The statement of facts by Andreas Paul indicates that Andrea Chiecchi was in the employ of ZF Friedrichshafen AG when he prepared and signed the invention disclosure statement (paragraph III). However, the record does not include an agreement to assign inventions to Mr. Chiecchi's employer. Mr. Paul's statement of facts also indicates that international application number PCT/EP2007/063439 was filed "covering the subject matter of Andrea Chiecchi's invention" (paragraph III). However, it is not clear that the invention of the Invention Disclosure document and the invention of the present application are the same invention. *Cf. In Re Gray*, 115 USPQ 80 (Comm'r Pat. 1956) (An assignment of an application and any "reissue, division, or continuation of said application" does not itself establish an assignment of a continuation-in-part application.) See MPEP 409.03(f). Attention is directed to MPEP § 409.03 which states in part:

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

### CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301



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JUL 05 2011

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112 PLEASANT STREET  
CONCORD NH 03301

PCT LEGAL ADMINISTRATION

In re Application of	:	DECISION ON
CHIECCHI, Andrea	:	
Application No.: 12/678,879	:	PETITION UNDER
PCT No.: PCT/EP2007/063439	:	
Int. Filing Date: 06 December 2007	:	37 CFR § 1.47(b)
Priority Date: 05 October 2007	:	
Attorney Docket No.: ZF P413US	:	
For: METHOD FOR CONTROLLING A	:	
WATERCRAFT HAVING A SURFACE DRIVE	:	

This is a decision on applicant's petition under 37 CFR 1.47(b) filed in the United States Patent and Trademark Office (USPTO) on 07 December 2010. The petition is **GRANTED**.

**BACKGROUND**

On 06 December 2007, applicant filed international application PCT/EP2007/063439 which designated the US and claimed a priority date of 05 October 2007. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 16 April 2009. The thirty-month period for paying the basic national fee in the United States expired at midnight on 05 April 2010.

On 18 March 2010, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 23 April 2010, the United States Designated/Elected Office (DO/EO/US) issued a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 26 July 2010, applicant submitted a petition under 37 CFR 1.47(b). The petition was accompanied by, *inter alia*, a declaration of the inventor, a statement of facts by Mr. Michael Bujold with documents in support thereof, and a statement of facts by Andreas Paul with documents in support thereof.

On 08 October 2010, a decision was mailed dismissing without prejudice applicant's petition under 37 CFR 1.47(b).

On 07 December 2010, applicant filed the instant petition under 37 CFR 1.47(b), which was accompanied by, *inter alia*, a supplemental declaration of facts by Michael J. Bujold and a supplemental declaration of facts by Andreas Paul with documentation in support thereof.

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(g), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

As noted in the decision mailed 08 October 2010, items (1), (3), (4), and (6) have been satisfied.

Item (2) has now been met. It has been established that a copy of the application papers has been presented to non-signing inventor Andrea Chiecchi. Mr. Chiecchi's conduct constitutes a refusal to sign.

Item (5) has now been met as well. The supplemental declaration of Andreas Paul and accompanying documentation establish that ZF Friedrichshafen AG has sufficient proprietary interest in the instant application.

### CONCLUSION

For the above reasons, applicants' renewed petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

Application No.: 12/678,879

-3-

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of **26 July 2010**.

/Daniel Stemmer/

Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301



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**JUL 05 2011**

**PCT LEGAL ADMINISTRATION**

Mr. Andrea Chiecchi  
Via Fincato, 27/3  
37129 Verona  
ITALY

In re Application of  
CHIECCHI, Andrea  
Application No.: 12/678,879  
PCT No.: PCT/EP2007/063439  
Int. Filing Date: 06 December 2007  
Priority Date: 05 October 2007  
Attorney Docket No.: ZF P413US  
For: METHOD FOR CONTROLLING A WATERCRAFT HAVING A SURFACE DRIVE

Dear Mr. Chiecchi:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/Daniel Stemmer/

Daniel Stemmer  
PCT Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301

DAVIS & BUJOLD, P.L.L.C.  
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Davis & Bujold, P.L.L.C.  
112 Pleasant Street  
Concord, NH 03301

**MAILED**

OCT 21 2010

PCT LEGAL ADMINISTRATION

In re Application of :  
CHIECCHI, Andrea :  
U.S. Application No.: 12/678,882 :  
PCT No.: PCT/EP2007/063438 :  
Int. Filing Date: 06 December 2007 :  
Priority Date: 05 October 2007 :  
Attorney Docket No.: ZF P414US :  
For: METHOD FOR CONTROLLING A :  
SURFACE DRIVE FOR A :  
WATERCRAFT IN THE UPPER SPEED :  
RANGE :

DECISION ON PETITION

This decision is issued in response to applicant's "Petition by Person Having Proprietary Interest to File Application . . . under 37 CFR 1.47(b)" filed 26 July 2010, to accept the application without the signature of sole inventor, Andrea CHIECCHI.

**BACKGROUND**

On 06 December 2007, applicant filed international application PCT/EP2007/063438. Pursuant to 37 CFR 1.495, the period for paying the basic national fee in the United States expired 30 months from the priority date, 05 April 2010.

On 18 March 2010, applicant filed a request for entry into the national stage accompanied by, *inter alia*: the requisite basic national fee; a copy of the international application; and a preliminary amendment.

On 30 April 2010, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.63 must be filed. The notification set a one-month time limit in which to respond.

On 26 July 2010, applicant filed the present petition under 37 CFR 1.47(b).

**DISCUSSION**

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or

cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of item (1), (3), (4) and (6). However, items (2) and (5) have not been satisfied.

Petitioner states that Andrea CHIECCHI has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Here, the attempts to contact the nonsigning inventor are set forth in the "37 CFR 1.132 Declaration" by Michael J. Bujold. However, it is not clear whether the person (Michael J. Bujold) who executed the statement is the person who conducted the actions set forth therein. It appears that the statements made with regards to the efforts to reach Andrea CHIECCHI constitutes secondhand knowledge, in that, the actions to which petitioner is averring to were conducted by Mr. Bujold's office. Secondhand evidence does not satisfy the requirements set forth above. Applicants must provide evidence of the efforts made to reach the nonsigning inventor in the form required by the MPEP, that is, in an

affidavit or declaration from a person with firsthand knowledge of the facts set forth, accompanied by copies of any supportive documentary evidence. Therefore, item (2) has not been satisfied.

Concerning Item (5), section 409.03(f) of the M.P.E.P., **Proof of Proprietary Interest**, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324) . . .

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and

signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Regarding item (5), petitioner has not demonstrated that applicant has a proprietary interest in the invention. Further, the statement provided by Andreas Paul is not acceptable without additional corroborating evidence. As stated above, when an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. Therefore, item (5) has not been satisfied.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Andrea CHIECCHI under 37 CFR 1.47(b) at this time.

#### CONCLUSION

The petition filed under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO MONTHS** from the mailing date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)."

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Anthony Smith  
Attorney-Advisor  
Office PCT Legal Administration  
Tel.: 571-272-3298



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Davis & Bujold, P.L.L.C.  
112 Pleasant Street  
Concord, NH 03301

**MAILED**

**MAR 04 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of :  
CHIECCHI, Andrea :  
U.S. Application No.: 12/678,882 :  
PCT No.: PCT/EP2007/063438 :  
Int. Filing Date: 06 December 2007 :  
Priority Date: 05 October 2007 :  
Attorney Docket No.: ZF P414US :  
For: METHOD FOR CONTROLLING A :  
SURFACE DRIVE FOR A :  
WATERCRAFT IN THE UPPER SPEED :  
RANGE :

**DECISION ON PETITION**

This decision is issued in response to applicant's "Renewed Petition under 37 CFR 1.47(b)" filed 07 December 2010, to accept the application without the signature of sole inventor, Andrea CHIECCHI.

**BACKGROUND**

On 06 December 2007, applicant filed international application PCT/EP2007/063438. Pursuant to 37 CFR 1.495, the period for paying the basic national fee in the United States expired 30 months from the priority date, 05 April 2010.

On 18 March 2010, applicant filed a request for entry into the national stage accompanied by, *inter alia*: the requisite basic national fee; a copy of the international application; and a preliminary amendment.

On 30 April 2010, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.63 must be filed. The notification set a one-month time limit in which to respond.

On 26 July 2010, applicant filed the present petition under 37 CFR 1.47(b). In a decision dated 21 October 2010, applicant's petition was dismissed without prejudice.

On 07 December 2010, applicant filed a renewed petition under 37 CFR 1.47(b).

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages.

A complete review of the papers filed reveals that petitioner has paid the requisite petition fee, provided sufficient proof that the non-signing inventor has refused to execute the application, stated the last known address of the non-signing inventor, provided an acceptable declaration, provided sufficient proof of proprietary interest, and provided a sufficient showing of preservation of right or irreparable damage. Accordingly, all of the requirements of items (1) through (6) above have been satisfied.

### CONCLUSION

The renewed petition under 37 CFR 1.47(b) is GRANTED.

The application will be given an international filing date of 06 December 2007 under 35 U.S.C. 363, and a date of **26 July 2010** under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.



Anthony Smith  
Attorney-Advisor  
Office PCT Legal Administration  
Tel.: 571-272-3298



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Andrea Chiecchi  
Via Fincato, 27/3  
37129 Verona Italy

**MAILED**

**MAR 04 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of  
CHIECCHI, Andrea  
U.S. Application No.: 12/678,882  
PCT No.: PCT/EP2007/063438  
Int. Filing Date: 06 December 2007  
Priority Date: 05 October 2007  
Attorney Docket No.: ZF P414US  
For: METHOD FOR CONTROLLING A SURFACE DRIVE FOR A WATERCRAFT IN  
THE UPPER SPEED RANGE

Dear Andrea Chiecchi:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3298

Counsel of Record:  
Davis & Bujold, P.L.L.C.  
112 Pleasant Street  
Concord, NH 03301



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United States Patent and Trademark Office  
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Alexandria, VA 22313-1450  
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**MAILED**

**MAR 09 2012**

**OFFICE OF PETITIONS**

**GIFFORD, KRASS, SPRINKLE,  
ANDERSON & CITKOWSKI, P.C.  
PO BOX 7021  
TROY MI 48007-7021**

**In re Application of  
Jun Tahara et al  
Application No.: 12/678,915  
Filed: March 18, 2010  
Attorney Docket No.: TMCB-10002/08  
For: DEVICE FOR LIMITING  
OUTPUT OF INTERNAL  
COMBUSTION ENGINE WHEN THE  
ENGINE HAS ABNORMALITY**

**: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)**

**:  
:  
:  
:**

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed January 31, 2012, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PPH pilot program and petition to make special require:

1. The U.S. application is
  - a. a Paris Convention application which either
    - i. validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
  - b. a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
    - i. validly claims priority to an application filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
    - iii. contains no priority claim, or

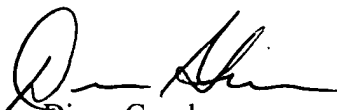
- c. a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
  - i. validly claims priority to an application filed in the JPO, or
  - ii. validly claims priority to a PCT application that contains no priority claims, or
  - iii. contains no priority claim;
- 2. Applicant must:
  - a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s) and
  - b. Submit a claims correspondence table in English;
- 3. Examination of the U.S. application has not begun;
- 4. Applicant must submit:
  - a. Documentation of prior office action:
    - i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claim(s) or
    - ii. if the allowable/patentable claims(s) are from a "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
    - iii. if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form;
  - b. An English language translation of the JPO Office action from (4)(a)(i)-(ii) above
- 5. Applicant must submit:
  - a. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
  - b. Copies of the documents except U.S. patents or U.S. patent application publications (unless already submitted in this application);

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Inquiries concerning this decision should be directed to Karen Creasy at 571-272-3208.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

This application will be forwarded to the examiner for action on the merits commensurate with this decision.



Diane Goodwyn  
Petitions Examiner  
Office of Petitions



UNITED STATES PATENT AND TRADEMARK OFFICE

30 SEP 2010

Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

Pabst Patent Group LLP  
1545 PEACHTREE STREET NE  
SUITE 320  
ATLANTA GA 30309

In re Application of	:	
KEMP, et al.	:	DECISION ON PETITION
Serial No.: 12/678,957	:	
PCT No.: PCT/GB2008/003186	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 18 September 2008	:	
Priority Date: 21 September 2007	:	
Atty Docket No.: ARI 9047	:	
For: EPIDERMAL STIMULATION TO	:	
ENHANCE HAIR FOLLICLE	:	
FORMATION	:	

This decision is in response to applicant's petition under 37 CFR 1.47(a) filed 12 August 2010 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 18 September 2008, applicant filed international application PCT/GB2008/003186 which claimed priority to a previous application filed 21 September 2007. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 21 March 2010.

On 18 March 2010, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, among other items, the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a preliminary amendment.

On 15 June 2010, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 12 August 2010, applicant filed the present petition under 37 CFR 1.47(a).

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1, 3 and 4.

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature."

In the present case, applicant has stated that a complete set of application papers and declaration was mailed to the non-signing inventor at his last known address and to date the inventor has not responded. However, it appears from the exhibits which accompany the petition that the parcel was not delivered to the correct address. The mailing label matches the last known address provided in the petition and published international application: 10502 Park Road, Suite 100, Charlotte, NC 28210. Yet, the delivery location on the FedEx tracking sheet shows that the parcel was delivered to the "receptionist/front desk" at 10650 Park Road, Suite 310, Pineville, NC 28134. As such, further more information it is not possible to consider the silence of the inventor as a refusal as there is significant evidence that Dr. Cooley never received the papers.

In light of the above, it is not possible to grant applicant's petition at this time.

### **CONCLUSION**

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Application No.: 12/678,957

3

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration or electronically filed utilizing the USPTO's EFS-Web electronic filing system.

A handwritten signature in black ink, appearing to read 'Derek A. Putonen', with a stylized, cursive script.

Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: 571-272-3294



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
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PABST PATENT GROUP LLP  
1545 PEACHTREE STREET NE  
SUITE 320  
ATLANTA GA 30309

**MAILED**

**NOV 22 2010**

**PCT LEGAL ADMINISTRATION**

In re Application of	:	
KEMP, et al.	:	DECISION ON PETITION
Serial No.: 12/678,957	:	
PCT No.: PCT/GB2008/003186	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 18 September 2008	:	
Priority Date: 21 September 2007	:	
Atty Docket No.: ARI 9047	:	
For: EPIDERMAL STIMULATION TO ENHANCE	:	
HAIR FOLLICLE FORMATION	:	

This decision is in response to applicant's renewed petition under 37 CFR 1.47(a) filed 22 October 2010 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 30 September 2010, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(a). Applicant was afforded two months to file any request for reconsideration.

On 22 October 2010, applicant filed the present renewed petition under 37 CFR 1.47(a).

**DISCUSSION**

As detailed in the decision mailed 20 May 2010, a petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant previously satisfied items 1, 3 and 4.

With the filing of the renewed petition and supporting exhibits, applicant has satisfied the remaining item and it is proper to grant applicant's renewed petition at this time.

**CONCLUSION**

For the reasons discussed above, applicant's renewed petition under 37 CFR 1.47(a) is **GRANTED**.

The application has an international filing date of 18 September 2008 under 35 U.S.C. 363, and will be given a date of **12 August 2010** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(c), a notice of the filing of this application will be forwarded to the non-signing inventors at their last known addresses of record. A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the DO/EO/US for processing in accordance with this decision.

A handwritten signature in black ink, appearing to read 'D. A. Putonen', is positioned above the typed name.

Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: 571-272-3294



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Dr. Jerry Cooley  
10650 Park Road, Suite 310  
Charlotte, NC 28210

**MAILED**

**NOV 22 2010**

**PCT LEGAL ADMINISTRATION**

In re Application of  
KEMP, et al.  
Serial No.: 12/678,957  
PCT No.: PCT/GB2008/003186  
Int. Filing Date: 18 September 2008  
Priority Date: 21 September 2007  
Atty Docket No.: ARI 9047  
For: EPIDERMAL STIMULATION TO ENHANCE  
HAIR FOLLICLE FORMATION

Dear Dr. Cooley:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor. As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternately, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, the law firm of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294

Counsel of record:  
PABST PATENT GROUP LLP  
1545 PEACHTREE STREET NE  
SUITE 320  
ATLANTA GA 30309



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/678,968	03/18/2010	Byoung-II Kang	29137.592.00	2404
30827 7590 06/07/2011 MCKENNA LONG & ALDRIDGE LLP 1900 K STREET, NW WASHINGTON, DC 20006			EXAMINER KRYLOVA, IRINA	
			ART UNIT 1764	PAPER NUMBER
			MAIL DATE 06/07/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
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Alexandria, VA 22313-1450  
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WG

June 7, 2011

In re application of	:	DECISION ON REQUEST TO
Byoung-Il Kang et al.	:	PARTICIPATE IN PATENT
Serial No. 12/678,968	:	PROSECUTION HIGHWAY
Filed: March 18, 2010	:	PROGRAM AND
For: OPTICAL FILM AND METHOD OF	:	PETITION TO MAKE SPECIAL
MANUFACTURING THE SAME	:	UNDER 37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a) to make the above-identified application special filed April 12, 2011.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the KIPO, note where the KIPO application with similar claims is not the same application from which the U.S. application claims priority that the applicant must identify the relationship between the KIPO application with similar claims and the KIPO priority application;
- (2) Applicant must submit a copy of:
  - a. The allowable/patentable claim(s) from the KIPO application(s);
  - b. An English translation of the allowable/ patentable claim(s); and
  - c. A statement that the English translation is accurate;
- (3) Applicant must:
  - a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the KIPO application(s); and
  - b. Submit a claims correspondence table in English;
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of:

Application No. 12/678,968

- a. All of the Office actions from each of the KIPO application(s) containing the allowable/patentable claim(s) that are the basis for the request;
- b. An English language translation of the KIPO Office actions from (5)(a) above; and
- c. A statement that the English translation is accurate;

(6) Applicant must submit:

- a. An IDS listing the documents cited by the KIPO examiner in the KIPO office action (unless already submitted in this application)
- b. Copies of documents except U.S. patents or U.S. patent application publications (unless already submitted in this application); and

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Walter D. Griffin, Supervisory Patent Examiner, at (571) 272-1447.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Walter D. Griffin/

---

Walter D. Griffin  
Supervisory Patent Examiner  
Technology Center 1700



UNITED STATES PATENT AND TRADEMARK OFFICE

24 SEP 2010

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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HERSHKOVITZ & ASSOCIATES, LLC  
2845 DUKE STREET  
ALEXANDRIA VA 22314

In re Application of: HAN, Soung-Joo  
Application No.: 12/679011  
PCT Application No.: PCT/KR2008/007228  
International Filing Date: 5 December 2008  
Priority Date: 24 December 2007  
Attorney Docket No.: PW1391153  
For: METHOD AND SYSTEM FOR SEARCHING  
INFORMATION OF COLLECTIVE EMOTION BASED  
ON COMMENTS ABOUT CONTENTS ON THE  
INTERNET

DECISION ON PETITION  
UNDER  
37 CFR 1.181

This decision is responsive to the communication filed 13 August 2010, which has been treated as a petition under 37 CFR 1.181. No petition fee is required.

**BACKGROUND**

On 5 December 2008, applicant filed the above referenced international application with the receiving Office (RO/KR), which claimed an earliest priority to application KR 10-2007-0136565 filed 24 December 2007.

On 18 March 2010, prior to the expiration of 30 months from the earliest priority date, applicant filed a first submission under 35 U.S.C. 371 to commence national stage in the United States. Applicant filed a transmittal letter, which indicated an express request to begin national examination procedures (35 U.S.C. 371(f)), together with the basic national fee (35 U.S.C. 371(c)(1)), a courtesy copy of the international application (WO 2009/082100 A2) published in the English language (35 U.S.C. 371(c)(2), and an executed oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)). Further, applicant provided courtesy copies of the published international search report (WO 2009/082100 A3) and published Article 19 claims and statement (WO 2009/082100 A4). Applicant indicated that the WO 2009/082100 A4 publication was incomplete and in lieu of the Article 19 amendment requested entry of (1) the Article 19 amendment filed during the international phase and (2) a preliminary amendment.

On 25 March 2010, the International Bureau published a Corrected Version of the international application (WO 2009/082100 A9) which included the description, claims, Article 19 amendment and statement, drawings, and international search report.

On 08 July 2010, the United States Designated/Elected Office (DO/EO/US) mailed a Notice of Acceptance of Application under 35 U.S.C. 371 (Form PCT/EO/EO/903) (hereinafter Notice of Acceptance) which indicated *inter alia* the following:

06/11/2010 DATE OF COMPLETION OF ALL 35 U.S.C. 371 REQUIREMENTS

The following items have been received:

Request for Immediate Examination filed on 06/11/2010

Priority Documents filed on 03/18/2010

The following defects have been observed:

Article 19 amendments have not been entered because (not a page for page substitution).

Preliminary Amendments have not been entered because (Identifies with art. 19 claims).

On 13 August 2010, applicant filed the present petition under 37 CFR 1.181. The petition pointed out alleged errors in the Notice of Acceptance.

**DISCUSSION**

Petitioner requests a corrected Notice of Acceptance which indicates that there is no defect to be observed with regard to the Article 19 amendment and the preliminary amendments.

Indications related to Date of completion of all 35 U.S.C. 371 requirements and Request for immediate examination.

On 18 March 2010 applicant submitted an express request for immediate examination (35 U.S.C. 371(f)), the basic national fee (35 U.S.C. 371(c)(1)) and an executed oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)). The requirements under 35 U.S.C. 371

The International Bureau provided copies of the international application with amendments to the claims, the international search report (35 U.S.C. 371 (a)), and the international preliminary report on patentability, Chapter I (35 U.S.C. 371(a)).

Therefore, the date of completion of all 35 U.S.C. 371 requirements is 18 March 2010.

Indications related to The following defects have been observed.

It appears from the record that at the time of the first submission applicant wished reversal of the Article 19 amendment to the claims published by the International Bureau (WO 2009/082100 A4) because the publication was incomplete. In lieu thereof, applicant provided a copy of the complete Article 19 amendment to the claims which was filed during the international phase and requested entry of the copy. The copy of the complete Article 19 amendment filed during the international phase is not entered because is not in compliance with 37 CFR 1.121. Specifically, claims 2, 3 and 5 do not include the requisite markings that identify

text that has been added to and deleted from the claims. Further, applicant filed a preliminary amendment believed to be in compliance with 37 CFR 1.121 and requested entry of the preliminary amendment. The preliminary amendment failed to comply with 37 CFR 1.121 due to the non-entry of the non-compliant copy of the complete Article 19 amendment.

At the time the Notice of Acceptance was prepared, the indications were correct regarding defects that have been observed.

The International Bureau, subsequent to applicant's first submission under 35 U.S.C. 371, published a Corrected Version of the international application (WO 2009/082100 A9) on 25 March 2010. The Corrected Version of the international application has been entered into the record of the above application with effect from 18 March 2010, the date of first submission under 35 U.S.C. 371.

The Corrected Version of the international application includes a complete Article 19 amendment to the claims, which obviates the defects that have been observed on the Notice of Acceptance.

The Article 19 amendment contained in the Corrected Version of the international application has been entered. Therefore, the preliminary amendment is now in compliance with 37 CFR 1.121 and has been entered.

Indications related to Priority documents.

Applicant has filed a letter indicating a foreign priority claim and that the certified copy has already been filed with the International Bureau. However, the International Bureau has not provided the priority document to the DO/EO/US and priority document is not yet available to the DO/EO/US via the WIPO PATENTSCOPE® Web site.

**CONCLUSION**

The petition under 37 CFR 1.181 is GRANTED.

This application is being forwarded to the National Phase Division of PCT Operations for preparing a corrected Notice of Acceptance as follows:

[[06/10/2010]] 03/18/2010 DATE OF COMPLETION OF ALL 35 U.S.C. 371 REQUIREMENTS

Request for Immediate Examination filed on [[06/10/2010]] 03/18/2010

There should be no indication that priority documents have been received.

There should be no indication that any defects have been observed.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Tamara Graysay  
PCT Special Program Examiner  
Office of PCT Legal Administration  
(571) 272-6728



Richard Cole  
PCT Legal Examiner  
Office of PCT Legal Administration



UNITED STATES PATENT AND TRADEMARK OFFICE

13 SEP 2010

Commissioner for Patents  
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P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

PANITCH SCHWARZE BELISARIO & NADEL LLP  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA PA 19103

In re Application of:	:	
VADSTRUP, Pierre, et al.	:	
U.S. Application No.: 12/679,054	:	DECISION REGARDING
PCT No.: PCT/EP2008/007041	:	SUBMISSION UNDER
International Filing Date: 28 August 2008	:	37 CFR 1.42
Priority Date: 20 September 2007	:	
Atty Docket No.: 7911-110US (GP 1596 US)	:	
For: METHOD FOR MONITORING AN	:	
ENERGY CONVERSION DEVICE	:	

This decision is issued in response to applicants' submission on 18 May 2010 of a declaration executed on behalf of deceased inventor Pierre VADSTRUP by the deceased inventor's legal representative Jette Egebaek Vadstrup, considered herein as a submission under 37 CFR 1.42.

### **BACKGROUND**

On 28 August 2008, applicants filed international application PCT/EP2008/007041. The international application claimed a priority date of 20 September 2007, and it designated the United States. On 02 April 2009, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 20 March 2010.

On 19 March 2010, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee, an English translation of the international application, an application data sheet (ADS), and an executed declaration.

On 18 May 2010, applicants filed a "Substitute Declaration And Power Of Attorney" executed on behalf of deceased inventor Pierre VADSTRUP by the deceased inventor's legal representative Jette Egebaek Vadstrup, a "Declaration Of Jette Egebaek Vadstrup As Legal Representative Of Deceased Joint Inventor Pierre Vadstrup" providing additional information, and a supplemental ADS indicating that the first inventor was deceased and adding information regarding the legal representative.

On 26 August 2010, the United States Designated/Elected Office (DO/EO/US) issued a "Notification Of Acceptance" (Form PCT/DO/EO/903) identifying the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements" as 19 March 2010 and the "Date Of Completion Of All 35 U.S.C. 371 Requirements" as 20 March 2010. Also on 26 August 2010, a filing receipt was issued that identified the 35 U.S.C. 371(c) date as 19 March 2010.

### **DISCUSSION**

37 CFR 1.42 states in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the MPEP states that the application can also be executed by all of the heirs of the deceased inventor, where no legal representative has been appointed or is required to be appointed by law.

37 CFR 1.497(b)(2) states the following:

If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), the declaration must include the citizenship for both the deceased inventor and the legal representative, the mailing address and residence information of the legal representative, a statement of the relationship between the person signing on behalf of the deceased inventor and the deceased inventor, and all other information required under 37 CFR 1.497.

Applicants' 18 May 2010 submission expressly states that the declaration included with the original application materials filed on 19 March 2010 was executed on behalf of deceased inventor Pierre VADSTRUP by his legal representative. However, the declaration filed on 19 March 2010 did not expressly indicate that the first inventor was deceased or that the declaration was being executed on the inventor's behalf by his legal representative, nor did it include all the information required under 37 CFR 1.497(b)(2). The declaration filed 19 March 2010 was therefore not acceptable under 37 CFR 1.497 and 1.42 with respect to deceased inventor Pierre VADSTRUP.

The "Substitute Declaration And Power Of Attorney" and "Declaration Of Jette Egebaek Vadstrup As Legal Representative Of Deceased Joint Inventor Pierre Vadstrup" filed on 18 May 2010, in combination, make clear that the first inventor is deceased, and they set forth the required citizenship, residence, and mailing address information for the person signing the declaration on behalf of the deceased inventor, as well as the citizenship of the deceased

inventor. The declarations also state the relationship of the person signing to the deceased inventor (i.e., "legal representative"). The declarations filed on 18 May 2010 therefore include all information required under 37 CFR 1.497(b)(2) and may be accepted under 37 CFR 1.497 and 1.42.<sup>1</sup>

Based on the above, the Notification Of Acceptance and filing receipt mailed 26 August 2010, both of which incorrectly set forth a 35 U.S.C. 371(c) date of 19 March 2010 that is based on the purported acceptability of the declaration filed 19 March 2010, are appropriately vacated. A corrected Notification Of Acceptance and filing receipt will be issued identifying the 35 U.S.C. 371(c) date as 18 May 2010, the date on which the declaration acceptable under 37 CFR 1.42 and 1.497 with respect to the deceased inventor was first filed herein.

### CONCLUSION

Applicants' 18 May 2010 request for status under 37 CFR 1.42 with respect to deceased inventor Pierre VADSTRUP is **GRANTED**.

The "Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt mailed 26 August 2010 are hereby **VACATED**.

Deposit Account No. 50-1017 will be charged the \$130 surcharge for filing the acceptable declaration later than thirty months after the priority date.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including the issuance of: (1) a corrected "Notification Of Acceptance" identifying the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements," the "Date Of Completion Of All 35 U.S.C. 371 Requirements," and the date of receipt of the declaration as **18 May 2010**; and (2) a corrected filing receipt identifying the 35 U.S.C. 371(c) date as **18 May 2010**.



Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296  
Facsimile: (571) 273-0459

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<sup>1</sup> Deposit Account No. 50-1017 will be charged the \$130 surcharge required for filing the acceptable declaration later than thirty months after the priority date.



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**MAILED**

**DEC 16 2010**

**PCT LEGAL ADMINISTRATION**

NIXON & VANDERHYE, PC  
901 NORTH GLEBE ROAD, 11TH FLOOR  
ARLINGTON VA 22203

In re Application of	:	
SENEVIRANTE	:	DECISION ON PETITION
Serial No.: 12/679,077	:	
PCT No.: PCT/AU2007/001375	:	UNDER 37 CFR 1.47(b)
Int. Filing Date: 19 September 2007	:	
Priority Date: None	:	
Atty Docket No.: 4633-68	:	
For: NON-WOVEN BIODEGRADABLE	:	
HYGIENE PRODUCT	:	

This decision is in response to the "PETITION TO FILE APPLICATION UNDER 37 C.F.R. §1.47(a)" filed 19 November 2010 in the United States Patent and Trademark Office (USPTO). In situations where the sole inventor refuses to sign an oath or declaration or cannot be located despite diligent effort the proper course is a petition under 37 CFR 1.47(b). As such, applicant's present petition is being treated as a petition under 37 CFR 1.47(b). Applicant has provided payment of the requisite \$200.00 petition fee.

**BACKGROUND**

On 19 September 2007, applicant filed international application PCT/AU2007/001375. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 26 March 2009. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 19 March 2010.

On 19 March 2010, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee.

On 30 August 2010, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 19 November 2010, applicant responded with the present petition accompanied by a petition for a one-month extension of time. With the payment of the one-month extension of time fee, applicant's present filing is considered timely filed.

### **DISCUSSION**

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant has satisfied items (1)-(4).

Regarding item (5), applicant has included a copy an assignment signed by Ms. Senevirante. However, as explained in the Manual of Patent Examining Procedure (MPEP) section 409.03(f):

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324).

In the present case, the power of attorney filed 04 August 2010 does contain a statement under 37 CFR 3.73(b) but the statement does not identify the frame and reel information for a recorded assignment nor include the referenced copy of the assignment. As such, a proper statement under 37 CFR 3.73(b) has not been provided in the application and therefore this item cannot be considered satisfied.

As to item (6), applicant has not included a statement that such action is necessary to preserve the rights of the parties or to prevent irreparable damages.

In light of the above, it is not possible to grant applicant's petition at this time.

### **CONCLUSION**

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED**, **without prejudice**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Application No.: 12/679,077

3

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration or electronically filed utilizing the USPTO's EFS-Web electronic filing system.

A handwritten signature in black ink, appearing to read 'Derek A. Putonen', written in a cursive style.

Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294



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**MAR 07 2011**

**PCT LEGAL ADMINISTRATION**

NIXON & VANDERHYE, PC  
901 NORTH GLEBE ROAD, 11TH FLOOR  
ARLINGTON VA 22203

In re Application of	:	
SENEVIRANTE	:	DECISION ON PETITION
Serial No.: 12/679,077	:	
PCT No.: PCT/AU2007/001375	:	UNDER 37 CFR 1.47(b)
Int. Filing Date: 19 September 2007	:	
Priority Date: None	:	
Atty Docket No.: 4633-68	:	
For: NON-WOVEN BIODEGRADABLE	:	
HYGIENE PRODUCT	:	

This decision is in response to the "RENEWED PETITION TO FILE APPLICATION UNDER 37 C.F.R. §1.47(a)" filed 10 February 2011 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 16 December 2010, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(b). Applicant was afforded two months to file any request for reconsideration.

On 10 February 2011, applicant responded with the present petition.

**DISCUSSION**

As detailed in the decision mailed 16 December 2010, a petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant previously satisfied items (1)-(4).

With the filing of the present renewed petition and accompanying exhibits applicant has satisfied the remaining two items and it is therefore proper to grant applicant's renewed petition at this time.

**CONCLUSION**

For the reasons stated above, applicant's renewed petition under 37 CFR 1.47(b) is **GRANTED**.

The application has an international filing date of 19 September 2007 under 35 U.S.C. 363, and will be given a date of **19 November 2010** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(c), a notice of the filing of this application will be forwarded to the non-signing inventors at their last known addresses of record. A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

This application is being returned to the DO/EO/US for processing in accordance with this decision.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294



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Ms. Charishma Mohini Wickremesinghe Senevirantne  
P.O. Box 74  
Como  
Western Australia 6952

**MAILED**

**MAR 07 2011**

**PCT LEGAL ADMINISTRATION**

In re Application of  
SENEVIRANTE  
Serial No.: 12/679,077  
PCT No.: PCT/AU2007/001375  
Int. Filing Date: 19 September 2007  
Priority Date: None  
Atty Docket No.: 4633-68  
For: NON-WOVEN BIODEGRADABLE  
HYGIENE PRODUCT

Dear Ms. Senevirantne:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor. As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternately, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, the law firm of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294

Counsel of Record:

NIXON & VANDERHYE, PC  
901 NORTH GLEBE ROAD, 11TH FLOOR  
ARLINGTON VA 22203  
UNITED STATES OF AMERICA



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CORPORATE INTELLECTUAL PROPERTY  
ONE HEALTH PLAZA 101/2  
EAST HANOVER, NJ 07936-1080

**MAILED**

**OCT 08 2010**

**PCT LEGAL ADMINISTRATION**

In re Application of BIANCHI et al :  
U.S. Application No.: 12/679,088 :  
PCT Application No.: PCT/EP2008/062769 :  
Int. Filing Date: 24 September 2008 :  
Priority Date Claimed: 28 September 2007 :  
Attorney Docket No.: PAT052266-US-PCT :  
For: GALENICAL FORMULATIONS OF :  
ORGANIC COMPOUNDS :

DECISION

This is in response to applicant's petition under 37 CFR 1.182 filed on 12 August 2010. The requisite \$400.00 petition fee will be charged to Deposit Account No. 19-0134 as authorized in the transmittal letter filed on 19 March 2010.

**BACKGROUND**

On 24 September 2008, applicant filed international application PCT/EP2008/062769, which claimed priority of an earlier United States application filed 28 September 2007. A copy of the international application was communicated to the USPTO from the International Bureau on 02 April 2009. The thirty-month period for paying the basic national fee in the United States expired on 29 March 2010.

On 19 March 2010, applicant filed national stage papers via the EFS-Web electronic filing system of the USPTO. As evidenced by the EFS-Web electronic acknowledgement receipt, applicant identified the international application number as "PCT/US08/62769".

On 30 July 2010, this Office mailed a communication which identified the discrepancy with regard to the international application number.

On 12 August 2010, applicant filed the present petition under 37 CFR 1.182.

**DISCUSSION**

The petition states that the incorrect international application number was mistakenly entered into the EFS-Web interface at the time of filing. A review of the application papers

reveals that the correct international application number was present on at least one document. Applicant's explanation for the error is accepted.

**CONCLUSION**

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 24 September 2008, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 19 March 2010.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.



Bryan Lin  
PCT Legal Examiner  
PCT Legal Office

Telephone: 571-272-3303  
Facsimile: 571-273-0459



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/679,093	03/19/2010	Kenji Umayahara	02013/39	3286
23838 7590 11/08/2011 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			EXAMINER LEE, BENJAMIN C	
			ART UNIT 2612	PAPER NUMBER
			MAIL DATE 11/08/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**KENYON & KENYON LLP  
1500 K STREET N.W.  
SUITE 700  
WASHINGTON DC 20005**

**In re Application of  
Kenji Umayahara**

**Application No.: 12/679,093**

**Filed: 19 March 2010**

**Attorney Docket No.: 02013/39**

**For: GAS LEVEL DISPLAY  
CONTROLLER, GAS LEVEL DISPLAY  
DEVICE, AND GAS LEVEL DISPLAY  
CONTROL METHOD**

**: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PATENT  
: PROSECUTION HIGHWAY  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(a)**

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed 18 October 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PPH pilot program and petition to make special require:

1. The U.S. application is
  - a. a Paris Convention application which either
    - i. validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
  - b. a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
    - i. validly claims priority to an application filed in the JPO, or
    - ii. validly claims priority to a PCT application that contains no priority claims, or
    - iii. contains no priority claim, or
  - c. a so-called bypass application filed under 35 U.S.C. 111(a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
    - i. validly claims priority to an application filed in the JPO, or


- ii. validly claims priority to a PCT application that contains no priority claims, or
  - iii. contains no priority claim;
- 2. Applicant must submit a copy of:
  - a. The allowable/patentable claim(s) from the JPO application(s);
  - b. An English translation of the allowable/patentable claim(s) and
  - c. A statement that the English translation is accurate;
- 3. Applicant must:
  - a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s) and
  - b. Submit a claims correspondence table in English;
- 4. Examination of the U.S. application has not begun;
- 5. Applicant must submit:
  - a. Documentation of prior office action:
    - i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claim(s) or
    - ii. if the allowable/patentable claims(s) are from a "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
    - iii. if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form;
  - b. An English language translation of the JPO Office action from (5)(a)(i)-(ii) above
  - c. A statement that the English translation is accurate;
- 6. Applicant must submit:
  - a. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
  - b. Copies of the documents except U.S. patents or U.S. patent application publications (unless already submitted in this application);

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Inquiries concerning this decision should be directed to Lee W. Young at 571-272-4549.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

This application will be forwarded to the examiner for action on the merits commensurate with this decision once this application's formality reviews have been completed.

  
Lee W. Young  
Quality Assurance Specialist  
Technology Center 2600



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P.O. Box 1450  
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[www.uspto.gov](http://www.uspto.gov)

Decision Date : February 7, 2012

In re Application of :

Donald Bunning

Application No : 12679112

Filed : 19-Mar-2010

Attorney Docket No : GEIN-111

DECISION ON REQUEST TO WITHDRAW AS  
ATTORNEY/AGENT OF RECORD

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed February 7, 2012

The request is **APPROVED**.

The request was signed by Nick C. Kottis (registration no. 31974 ) on behalf of all attorneys/agents associated with Customer Number 42419 . All attorneys/agents associated with Customer Number 42419 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with correspondence address:

Name Donald Leroy Bunning  
Name2  
Address 1 925 Woodland Avenue  
Address 2  
City South Charleston  
State WV  
Postal Code 25303  
Country US

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Office of Petitions

<b>Doc Code: PET.AUTO</b> <b>Document Description: Petition automatically granted by EFS-Web</b>		PTO/SB/83 U.S. Patent and Trademark Office Department of Commerce
Electronic Petition Request	<b>REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS</b>	
Application Number	12679112	
Filing Date	19-Mar-2010	
First Named Inventor	Donald Bunning	
Art Unit	1771	
Examiner Name	PAMELA WEISS	
Attorney Docket Number	GEIN-111	
Title	PROCESSES FOR THE ESTERIFICATION OF FREE FATTY ACIDS AND THE PRODUCTION OF BIODIESEL	
<input checked="" type="radio"/> Please withdraw me as attorney or agent for the above identified patent application and the practitioners of record associated with Customer Number:		42419 <hr/>
The reason(s) for this request are those described in 37 CFR: 10.40(c)(1)(iv) 10.40(c)(1)(vi)		
Certifications		
<input checked="" type="checkbox"/> I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment		
<input checked="" type="checkbox"/> I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled		
<input checked="" type="checkbox"/> I/We have notified the client of any responses that may be due and the time frame within which the client must respond		
Change the correspondence address and direct all future correspondence to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71:		
Name	Donald Leroy Bunning	
Address	925 Woodland Avenue	
City	South Charleston	
State	WV	
Postal Code	25303	

Country	US
I am authorized to sign on behalf of myself and all withdrawing practitioners.	
Signature	/Nick C. Kottis/
Name	Nick C. Kottis
Registration Number	31974



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/679,189	04/07/2010	Osamu Fukawatase	144918	3963
25944	7590	10/19/2011		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER TO, TOAN C	
			ART UNIT 3616	PAPER NUMBER
			NOTIFICATION DATE 10/19/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com  
jarmstrong@oliff.com



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OLIFF & BERRIDGE, PLC  
P.O. BOX 320850  
ALEXANDRIA VA 22320-4850

In re application of	:	<b>DECISION ON REQUEST TO</b>
Fukawatase et al.	:	<b>PARTICIPATE IN PATENT</b>
Application No. 12/679,189	:	<b>PROSECUTION HIGHWAY</b>
Filed: April 7, 2010	:	<b>PROGRAM AND PETITION</b>
For: MOUNTING STRUCTURE OF	:	<b>TO MAKE SPECIAL UNDER</b>
KNEE AIRBAG DEVICE AND	:	<b>37 CFR 1.102(a)</b>
ELECTRIC POWER STEERING		
DRIVE MOTOR		

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed August 2, 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of the latest Office action from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
- (6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO Office action along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH pilot program complies with the above requirements. Therefore, the above-identified application has been accorded "special" status.

All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Mikado Buiz, Quality Assurance Specialist, at (571) 272-6578.

          / Mikado Buiz /  
Mikado Buiz,  
Quality Assurance Specialist  
Technology Center 3600

MB/MB: 10/18/11



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/679,210	01/03/2011	Ho Suk Shin	5097-0163PUS1	4110

2292	7590	07/26/2011
BIRCH STEWART KOLASCH & BIRCH		
PO BOX 747		
FALLS CHURCH, VA 22040-0747		

EXAMINER	
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ART UNIT	PAPER NUMBER
1761	

NOTIFICATION DATE	DELIVERY MODE
07/26/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com



UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 26 2011

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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BC

In re application of	:	DECISION ON REQUEST TO
Ho Suk Shin et al.	:	PARTICIPATE IN PATENT
Serial No. 12/679,210	:	PROSECUTION HIGHWAY
Filed: March 19, 2010	:	PROGRAM AND
Attorney Docket No: 5097-0163PUS1	:	PETITION TO MAKE SPECIAL
	:	UNDER 37 CFR 1.102(a)

This is a decision on the request for reconsideration to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a) to make the above-identified application special filed January 03, 2011.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the KIPO, note where the KIPO application with similar claims is not the same application from which the U.S. application claims priority that the applicant must identify the relationship between the KIPO application with similar claims and the KIPO priority application;
- (2) Applicant must submit a copy of:
  - a. The allowable/patentable claim(s) from the KIPO application(s);
  - b. An English translation of the allowable/ patentable claim(s); and
  - c. A statement that the English translation is accurate;
- (3) Applicant must:
  - a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the KIPO application(s); and
  - b. Submit a claims correspondence table in English;
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of:
  - a. All of the Office actions from each of the KIPO application(s) containing the allowable/patentable claim(s) that are the basis for the request;

Application No. 12/379,210

- b. An English language translation of the KIPO Office actions from (5)(a) above;  
and
- c. A statement that the English translation is accurate; and

(6) Applicant must submit:

- a. An IDS listing the documents cited by the KIPO examiner in the KIPO office action (unless already submitted in this application)
- b. Copies of documents except U.S. patents or U.S. patent application publications (unless already submitted in this application).

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Blaine Copenheaver, Quality Assurance Specialist, at (571) 272-1156.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Blaine Copenheaver/

---

Blaine Copenheaver  
Quality Assurance Specialist  
Technology Center 1700

Doc Code: PPH.PCT.652

Document Description: Petition to make special under PCT-Patent Pros Hwy

PTO/SB/20PCT-EP (05-10)

Approved for use through 01/31/2012. OMB 0651-0058

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

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**REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION  
HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE EUROPEAN PATENT OFFICE (EPO) AND  
THE USPTO**

Application No:	12/679,237	Filing date:	July 19, 2010
First Named Inventor:	Ayse Tulay Massey		
Title of the Invention:	Coffee Composition		

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE  
SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT  
[HTTP://WWW.USPTO.GOV/EBC/EF5\\_HELP.HTML](http://www.uspto.gov/ebc/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE  
ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT  
application number(s) is/are:** PCT/GB2008/003220

**The international filing date of the corresponding  
PCT application(s) is/are:** September 22, 2008

**I. List of Required Documents:**

**a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified  
corresponding PCT application(s)**

☐

Is attached

☒

Is not attached because the document is already in the U.S. application.

**b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the  
above-identified corresponding PCT application(s).**

☐

Is attached.

☒

Is not attached because the document is already in the U.S. application.

**c. English translations of the documents in a. and b. above are attached (if the documents are not in the English  
language). A statement that the English translation is accurate is attached for the document in b. above.**

[Page 1 of 2]

This collection of information is required by 35 U.S.C. 119, 37 CFR 1.55, and 37 CFR 1.102(d). The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.

# **REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM BETWEEN THE EPO AND THE USPTO**

(continued)

Application No.: 12/679,237

First Named Inventor: Ayse Tulay Massey et al.

- d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

☐

Is attached

☒

Has already been filed in the above-identified U.S. application on

March 19, 2010

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)

☐

Are attached.

☒

Have already been filed in the above-identified U.S. application on

March 19, 2010

## **II. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
1	1	
2	2	
3	3	
4	4	
5	5	
6	6	
7	7	
8	8	
9	9	
10	10	
11	11	
12	12	
13	13	
14	14	
15	15	
16	1, 16	Combination of claims 1 and 16
17	1, 17	Combination of claims 1 and 17
18	3	New method claim with limitation of product claim 3
19	4	New method claim with limitation of product claim 4

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature /Calista J. Mitchell/

Date August 26, 2011

Name (Print/Typed) Calista J. Mitchell

Registration Number 63,944

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM BETWEEN THE EPO AND THE USPTO

(continued)

Application No.:	12/679,237
First Named Inventor:	Ayşe Tulay Massey et al.

- d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

☐ Is attached

☒ Has already been filed in the above-identified U.S. application on March 19, 2010

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)**

☐ Are attached.

☒ Have already been filed in the above-identified U.S. application on March 19, 2010

## II. Claims Correspondence Table:

[illegible]

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature <b>/Calista J. Mitchell/</b>	Date <b>August 26, 2011</b>
Name (Print/Typed) <b>Calista J. Mitchell</b>	Registration Number <b>63,944</b>



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/679,237	07/19/2010	Aysec Tulay Massey	1410-77518-US	4299
48940 7590 11/10/2011 FITCH EVEN TABIN & FLANNERY 120 SOUTH LASALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			EXAMINER WEIER, ANTHONY J	
			ART UNIT 1781	PAPER NUMBER
			MAIL DATE 11/10/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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NOV 10 2011

BC

In re application of	:	DECISION ON REQUEST TO
Ayse T. Massey et al.	:	PARTICIPATE IN PATENT
Serial No. 12/679,237	:	PROSECUTION HIGHWAY
Filed: March 19, 2010	:	PROGRAM AND
Attorney Docket No: 1410-77518-US	:	PETITION TO MAKE SPECIAL
	:	UNDER 37 CFR 1.102(a)

This is a decision on the request for reconsideration to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed August 26, 2011, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the APO, IPA, JPO, KIPO, NBPR, NPI, EPO, Rospatent, IPOS, SPTO, PRV, UK IPO or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;
- (6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof if the latest international work

Application No. 12/679,237

product is not in the English language; and

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Blaine Copenheaver, Quality Assurance Specialist, at (571) 272-1156.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.

/Blaine Copenheaver/

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Blaine Copenheaver  
Quality Assurance Specialist  
Technology Center 1700

Doc Code: PET.GREEN

Document Description: Petition for Green Tech Pilot

PTO/SB/420 (11-10)

Approved for use through 01/31/2011. OMB 0651-0062

U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

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## PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket  
Number: ADO-305

Application Number  
(if known): 12679250

Filing date: October 18, 2010

First Named  
Inventor: Harald Becker

Title: COMPOSITE EDGE FOR PRODUCING DOUBLE OR MULTIPLE PANE INSULATION GLASS OR SOLAR MODULES

**APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.**

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

**Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request.**

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirements for the Green Technology Pilot Program, if the Office determines that the claims are not obviously directed to a single invention. See Instruction Sheet.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

Copy of Request for Early Publication filed 10-18-2010,

6. Other attachments: Statement of Special Status, Second Preliminary Amendment

Signature

Date

3/29/11

Name  
(Print/Typed) Raymond J. Vivacqua

Registration Number 45,369

**Note:** Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No. 12/679,250

Filing Date: 03/19/2010

Applicant: Harald Becker

Group Art Unit:

Examiner:

Title: COMPOSITE EDGE FOR PRODUCING DOUBLE OR  
MULTIPLE PANE INSULATION GLASS OR SOLAR  
MODULES

Attorney Docket: ADO-305

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Mail Stop PGPUB  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

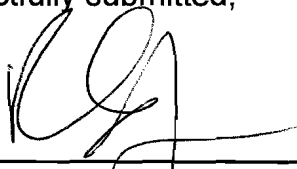
**REQUEST FOR EARLY PUBLICATION**

Sir:

Applicant hereby submits a Request for Early Publication in compliance with 37 CFR 1.219. Applicant hereby pays the required fees of \$300.00 set forth in 37 CFR 1.18(d).

Respectfully submitted,

Dated: 10/18/10

By:   
Raymond J. Vivacqua - Attorney  
Reg. No. 45,369  
(734) 418-3142



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/679,250	10/18/2010	Harald Becker	ADO-305	4368

67462 7590 05/25/2011  
VIVACQUA LAW, PLLC  
455 East Eisenhower Parkway, Suite 200  
ANN ARBOR, MI 48108

EXAMINER
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ART UNIT	PAPER NUMBER
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1725

NOTIFICATION DATE	DELIVERY MODE
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05/25/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rvivacqualaw@vivacqualaw.com



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

MAY 25 2011

VIVACQUA LAW, PLLC  
455 East Eisenhower Parkway, Suite 200  
ANN ARBOR MI 48108

In re Application of

Becker et al.

Application No. 12/679,250

Filed: 10/18/2010

Attorney Docket No. ADO-305

DECISION ON PETITION  
TO MAKE SPECIAL UNDER  
THE GREEN TECHNOLOGY  
PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed 3/29/11, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth in 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010) and 75 Federal Register Notice 69049 (November 10, 2010).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1 – 8 above. Accordingly, the above-identified application has been accorded “special” status.

Telephone inquiries concerning this decision should be directed to Tom Dunn at 571-272-1171.

The application is being forwarded to the Technology Center Art Unit 1725 for action on the merits commensurate with this decision.

/Tom Dunn/

---

Tom Dunn  
Quality Assurance Specialist  
Technology Center 1700



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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DOWELL BAKER, P.C.  
201 MAIN STREET  
SUITE 710  
LAFAYETTE, IN 47901

**MAILED**

**MAR 28 2011**

**OFFICE OF PETITIONS**

In re Application of  
George A. Holmes, et. al.  
Application No. 12/679,255  
Filed: March 19, 2010  
Attorney Docket No. CDL07-001

**DECISION ON PETITION  
TO WITHDRAW FROM  
RECORD**

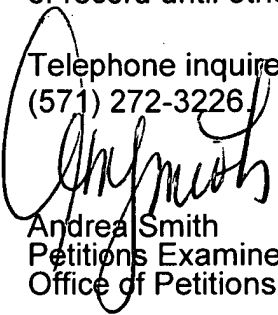
This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR §§ 1.36(b) or 10.40, filed February 11, 2011.

The request is **MOOT**.

A review of the file record indicates that any previous power of attorney was revoked by the inventors of the above application on March 9, 2011. Accordingly, the request to withdraw under 37 CFR §§ 1.36(b) or 10.40 is unnecessary.

All future communications from the Office will be directed to the below-listed address of record until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

  
Andrea Smith  
Petitions Examiner  
Office of Petitions

cc: CLIFFORD H. KRAFT  
320 ROBIN HILL DR.  
NAPERVILLE, IL 60540



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/679,255	03/19/2010	George A. Holmes	CDL07-001

64194  
DOWELL BAKER, P.C.  
201 MAIN STREET  
SUITE 710  
LAFAYETTE, IN 47901

**CONFIRMATION NO. 4402**  
**POWER OF ATTORNEY NOTICE**



Date Mailed: 03/25/2011

**NOTICE REGARDING CHANGE OF POWER OF ATTORNEY**

This is in response to the Power of Attorney filed 03/09/2011.

- The Power of Attorney to you in this application has been revoked by the applicant. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

/amsmith/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/679,255	03/19/2010	George A. Holmes	CDL07-001

CONFIRMATION NO. 4402

POA ACCEPTANCE LETTER

74642  
CLIFFORD H. KRAFT  
320 ROBIN HILL DR.  
NAPERVILLE, IL 60540



Date Mailed: 03/25/2011

**NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY**

This is in response to the Power of Attorney filed 03/09/2011.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

/amsmith/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101



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ARENT FOX LLP  
1050 CONNECTICUT AVENUE, N.W.  
SUITE 400  
WASHINGTON, DC 20036

**MAILED**  
**SEP 23 2011**  
**OFFICE OF PETITIONS**

Applicant: Rivas, et al.  
Appl. No.: 12/679,264  
International Filing Date: November 25, 2008  
Title: Method For The Ambient-Temperature Production Of Micro-And Nano-Fibers Of Lignin And Other Resinous Compounds  
Attorney Docket No.: 027318.00054  
Pub. No.: US 2010/0311943 A1  
Pub. Date: December 9, 2010

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on January 3, 2011, for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication contains material errors on the front page of the publication wherein the name and residence of the second inventor "Tomas Cardero Alcantara, Malaga (ES)" was misprinted as "Thomas Cardero Alcantara Malagra (ES)", the name for the third inventor "Jose Rodreguez Mirasol" was misprinted as "Jose Rodriguez Mirasol", and the name for the fourth inventor "Ignacio Gonzalez Loscertales" was misprinted as "Ignacio Gonzales Loscertales.

37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.<sup>1</sup>

The error on the front page of the publication wherein the spelling of the inventor's name and/or residence is incorrect may be Office error, but is not a material Office error under 37 CFR 1.221(b). The typographical error of the inventor's name and/or residence does not affect the

<sup>1</sup>Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

understanding of the application. The mistake does not affect the public's ability to appreciate the technical disclosure of the patent application publication, or determine the scope of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.

On September 2, 2010 and October 1, 2010, Filing Receipts were mailed by the Office, which incorrectly listed the second inventors name and residence and incorrectly listed the names of the third and fourth inventors. To avoid this type of problem in the future, applicant's representative should correct the error, if applicable and make a request for a corrected filing receipt prior to export of the application to the publisher and publication of the application.

Applicants are encouraged to use and submit an eADS (PTO/SB/14) as an EFS-Web Fillable Form, rather than a scanned PDF image, to benefit from having the data loaded directly into USPTO electronic systems. For questions contact the Patent EBC (Electronic Business Center):

Telephone: 1-866-217-9197 (toll-free) or E-mail: [ebc@uspto.gov](mailto:ebc@uspto.gov)  
571-272-4100 (local)

The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application compliance with the Office's electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i)." If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

A guide for filing a request for a Pre-Grant Publication, such as a request for republication, may be found on the link below:

<http://www.uspto.gov/patents/process/file/efs/guidance/index.jsp>

[http://www.uspto.gov/ebc/portal/efs/pgpub\\_quickstart.pdf](http://www.uspto.gov/ebc/portal/efs/pgpub_quickstart.pdf)

Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system, as a "Pre-Grant Publication."

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709.



Mark Polutta  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy



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United States Patent and Trademark Office  
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Alexandria, VA 22313-1450  
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28264  
BOND, SCHOENECK & KING, PLLC  
One Lincoln Center  
Syracuse, NY 13202-1355

**MAILED**

AUG 05 2011

PCT LEGAL ADMINISTRATION

In re Application of  
LEONARDI *et al*  
U.S. Application No.: 12/679,335  
PCT No.: PCT/US2008/062900  
Int. Filing Date: 07 May 2008  
Priority Date: 22 August 2007  
Docket No.: 158P035D  
For: STUMP GRINDING TOOTH  
ASSEMBLY

**DECISION ON  
RENEWED PETITION  
UNDER 37 CFR 1.497(d)**

This is a decision on the renewed petition under 37 CFR 1.497(d) filed 22 July 2011.

**BACKGROUND**

On 16 June 2011, a decision dismissing applicants' petition pursuant to 37 CFR 1.497(d) was mailed. Applicants were given two months to respond with extensions of time available.

On 22 July 2011, applicants filed the subject response.

**DISCUSSION**

Applicants request to add Bruce C. JORDAN as an inventor in the above-captioned national stage application.

Applicants failed to satisfy item (3) of 37 CFR 1.497(d) in the initial petition as applicants did not provide the written consent of the assignee.

In the renewed petition, applicants submitted a written consent of the assignee, Leonardi Manufacturing Co., which was signed by Joseph Leonardi as Vice President. The position of Vice President is presumed to have authority to sign for an organization. See MPEP § 324.

The written consent of the assignee must also comply with 37 CFR 3.73.

In this case, applicants did not provide a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was

or concurrently is being submitted for recordation, or provide a statement specifying where the chain of title is recorded in the assignment records of the Office. See 37 CFR 3.73(b)(1).

Therefore, item (3) of 37 CFR 1.497(d) is still not satisfied.

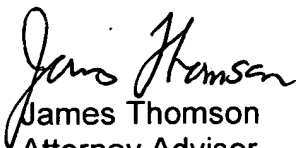
### **CONCLUSION**

Applicants' renewed request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

**Failure to timely respond will result in the abandonment of the application.**

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302



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One Lincoln Center  
Syracuse, NY 13202-1355

**MAILED**

OCT 07 2011

PCT LEGAL ADMINISTRATION

In re Application of  
LEONARDI *et al*  
U.S. Application No.: 12/679,335  
PCT No.: PCT/US2008/062900  
Int. Filing Date: 07 May 2008  
Priority Date: 22 August 2007  
Docket No.: 158P035D  
For: STUMP GRINDING TOOTH  
ASSEMBLY

**DECISION ON SECOND  
RENEWED PETITION  
UNDER 37 CFR 1.497(d)**

This is a decision on the second renewed petition under 37 CFR 1.497(d) filed 15 August 2011.

**BACKGROUND**

On 05 August 2011, a decision dismissing applicants' renewed petition pursuant to 37 CFR 1.497(d) was mailed. Applicants were given two months to respond with extensions of time available.

On 15 August 2011, applicants filed the subject response.

**DISCUSSION**

Applicants request to add Bruce C. JORDAN as an inventor in the above-captioned national stage application. Applicants failed to satisfy all the requirements of item (3) of 37 CFR 1.497(d) with the first two petitions.

The written consent of the assignee, Leonardi Manufacturing Co.; was previously submitted; however, applicants did not provide a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation, or provide a statement specifying where the chain of title is recorded in the assignment records of the Office.

In the renewed response, applicants provided the reel/frame number of the assignment as required along with a copy of the notice of recorded assignment. This is sufficient to meet the requirements of MPEP § 324 and item (3) of 37 CFR 1.497(d).

All items of 37 CFR 1.497(d) are now complete.

**CONCLUSION**

Applicants' second renewed request to add Bruce C. JORDAN as an inventor in the above-captioned application pursuant to 37 CFR 1.497(d) is **GRANTED**.

The declaration filed 22 March 2010 is now in compliance with 37 CFR 1.497(a) and (b).

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

A handwritten signature in black ink, appearing to read "James Thomson". The signature is written in a cursive, flowing style.

James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302



United States Patent and Trademark Office

EASTMAN KODAK COMPANY  
PATENT LEGAL STAFF  
343 STATE STREET  
ROCHESTER NY 14650-2201

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MAR 08 2011

PCT LEGAL ADMINISTRATION

Commissioner for Patents  
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In re Application of :  
Peregrym :  
Application No.: 12/679,336 :  
PCT No.: PCT/IB2007/002797 :  
Int. Filing Date: 25 September 2007 : **DECISION**  
Priority Date: N/A :  
Attorney Docket No.: 93904NAB :  
For: Bidirectional Imaging With Varying Speeds :

This is in response to the papers filed on 22 March 2010.

### **BACKGROUND**

International application PCT/IB2007/002797 was filed on 25 September 2007, claimed no earlier priority date, and designated the United States. The International Bureau transmitted a copy of the published international application to the USPTO on 02 April 2009. The period for payment of the basic national fee in the United States expired as of midnight on 25 March 2010. Applicants filed *inter alia* a basic national fee in 12/679,336 on 22 March 2010.

### **DISCUSSION**

Review of the instant application file reveals that the Transmittal Letter and executed declaration filed on 22 March 2010 were directed toward the national stage under 35 U.S.C. 371 of "PCT/IB2007/002797," while the Electronic Acknowledgment Receipt generated during the EFS-Web filing on even date shows that applicants indicated that "PCT/US07/02797" was to enter the national stage. Inspection of published international application PCT/IB2007/002797 reveals that its bibliographic data is similar to that for this application. In view of the discrepancy, it is not sufficiently clear which international application was intended to enter the national stage. Resolution of this matter would require a formal petition (and fee) under 37 CFR 1.182, clarifying which international application was intended to enter the national stage under 35 U.S.C. 371.

### **DECISION**

The papers filed on 22 March 2010 are **NOT ACCEPTED** under 35 U.S.C. 371, without prejudice, as described above.

A proper response (as described herein) must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/George Dombroske/

George Dombroske

PCT Legal Examiner

Office of PCT Legal Administration

Tel: (571) 272-3283



United States Patent and Trademark Office

EASTMAN KODAK COMPANY  
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PCT LEGAL ADMINISTRATION

In re Application of	:	
Peregrym	:	
Application No.: 12/679,336	:	
PCT No.: PCT/IB2007/002797	:	
Int. Filing Date: 25 September 2007	:	DECISION
Priority Date: N/A	:	
Attorney Docket No.: 93904NAB	:	
For: Bidirectional Imaging With Varying Speeds	:	

This is in response to the petition under 37 CFR 1.182 filed on 25 March 2011.

**DISCUSSION**

In a Decision mailed on 08 March 2011, applicant was advised that

Review of the instant application file reveals that the Transmittal Letter and executed declaration filed on 22 March 2010 were directed toward the national stage under 35 U.S.C. 371 of "PCT/IB2007/002797," while the Electronic Acknowledgment Receipt generated during the EFS-Web filing on even date shows that applicants indicated that "PCT/US07/02797" was to enter the national stage. Inspection of published international application PCT/IB2007/002797 reveals that its bibliographic data is similar to that for this application. In view of the discrepancy, it is not sufficiently clear which international application was intended to enter the national stage. Resolution of this matter would require a formal petition (and fee) under 37 CFR 1.182, clarifying which international application was intended to enter the national stage under 35 U.S.C. 371.

In response, counsel has filed the instant petition, which clarifies that "Applicant incorrectly identified the international application on the Electronic Filing System (EFS) as PCT/US2007/002797. The correct application number of PCT/IB2007/002797 appears on the executed declaration and transmittal letter as previously submitted on March 22, 2010." In view of the totality of the evidence of record, it would be appropriate to accept petitioner's statements as to the nature of the discrepancy and as to the identity of the international application intended to enter the national stage under 35 U.S.C. 371. The \$400.00 petition fee will be charged to counsel's Deposit Account, as authorized.

**DECISION**

The petition under 37 CFR 1.182 is **GRANTED**.

This application is being returned to the Office of Patent Application Processing for processing as the national stage under 35 U.S.C. 371 of PCT/IB2007/002797.

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283

## REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE EUROPEAN PATENT OFFICE (EPO) AND THE USPTO

Application No:	12/679,366	Filing date:	March 22, 2010
First Named Inventor:	Glynn Milner		
Title of the Invention:	COMBUSTION CHAMBER		

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBS/EF5\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/EP2008/061801

**The international date of the corresponding PCT application(s) is/are:**

September 05, 2008

**I. List of Required Documents:**

- a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**

☐

Is attached

☒

Is not attached because the document is already in the U.S. application.

- b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**

☐

Is attached.

☒

Is not attached because the document is already in the U.S. application.

- c. English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM  
BETWEEN THE EPO AND THE USPTO**

(continued)

Application No.:	12/679,366
First Named Inventor:	Glynn Milner

- d. **(1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.**

☐

Is attached

☒Has already been filed in the above-identified U.S. application on March 22, 2010

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)**

☐

Are attached.

☒Have already been filed in the above-identified U.S. application on March 22, 2010**II. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
8	1	US claim as per Preliminary Amendment filed 03/22/2010
9	2	US claim as per Preliminary Amendment filed 03/22/2010
10	2	US claim as per Preliminary Amendment filed 03/22/2010
11	2	US claim as per Preliminary Amendment filed 03/22/2010
12	2	US claim as per Preliminary Amendment filed 03/22/2010
13	3	US claim as per Preliminary Amendment filed 03/22/2010
14	4	US claim as per Preliminary Amendment filed 03/22/2010
15	5	US claim as per Preliminary Amendment filed 03/22/2010
16	6	US claim as per Preliminary Amendment filed 03/22/2010
17	7, 1	US claim as per Preliminary Amendment filed 03/22/2010
18	7, 2	US claim as per Preliminary Amendment filed 03/22/2010
19	7, 2	US claim as per Preliminary Amendment filed 03/22/2010
20	7, 2	US claim as per Preliminary Amendment filed 03/22/2010
21	7, 2	US claim as per Preliminary Amendment filed 03/22/2010
22	7, 3	US claim as per Preliminary Amendment filed 03/22/2010
23	7, 4	US claim as per Preliminary Amendment filed 03/22/2010
24	7, 5	US claim as per Preliminary Amendment filed 03/22/2010
25	7, 6	US claim as per Preliminary Amendment filed 03/22/2010

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature <u>/Tina Gonka/</u>	Date <u>March 08, 2011</u>
Name (Print/Typed) <u>Tina Gonka</u>	Registration Number <u>L0623</u>

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant ( i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/679,366	03/22/2010	Glynn Milner	2007P06782WOUS	5451

22116 7590 03/09/2011  
SIEMENS CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
170 WOOD AVENUE SOUTH  
ISELIN, NJ 08830

EXAMINER
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ART UNIT	PAPER NUMBER
3741	

MAIL DATE	DELIVERY MODE
03/09/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



SIEMENS CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
170 WOOD AVENUE SOUTH  
ISELIN NJ 08830

In re Application of	:	
MILNER, GLYNN	:	DECISION ON REQUEST TO
Application No. 12/679,366	:	PARTICIPATE IN PATENT
Filed: March 22, 2010	:	PROSECUTION HIGHWAY
Attorney Docket No. 2007P06782WOUS	:	PILOT PROGRAM AND PETITION
For: COMBUSTION CHAMBER	:	TO MAKE SPECIAL UNDER
	:	37 CFR 1.102(a)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(a), filed March 22, 2010 to make the above-identified application special.

The request and petition are granted.

A grantable request to participate in the PPH program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications filed in the JPO, EPO, KIPO or USPTO;
- (2) Applicant must submit a copy of the allowable/patentable claim(s) from the PCT application(s) latest international work product (the written opinion or the IPER) along with an English translation thereof and a statement that the English translation is accurate;
- (3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the PCT application(s);
- (4) Examination of the U.S. application has not begun;
- (5) Applicant must submit a copy of the latest international work product from the PCT application containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate; and
- (6) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

In light of the petition being properly submitted, the request to participate in the PPH program and the petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application.

All other inquiries concerning the examination or status of the application should be directed to Mike Cuff, the SPE of Art Unit 3741 and (571)272-6778 for Class 60/806 and also accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

This application will be forwarded and docketed to an examiner for action on the merits commensurate with this decision.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen, at 571-272-4856.

The petition is **granted**.

/Henry C. Yuen/

---

Henry C. Yuen, Special Programs Examiner  
Technology Center 3700 – Mechanical Engineering,  
Manufacturing and Products  
571-272-4856



United States Patent and Trademark Office

Gary C. Cohn, PLLC  
215 E. 96TH ST., #19L  
New York NY 10128

**MAILED**

NOV 16 2010

PCT LEGAL ADMINISTRATION

Commissioner for Patents  
United States Patent and Trademark Office  
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Alexandria, VA 22313-1450  
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In re Application of	:	
Schroeder et al.	:	
Application No.: 12/679,376	:	DECISION
PCT No.: PCT/US2008/077806	:	
Int. Filing Date: 26 September 2008	:	ON
Priority Date: 28 September 2007	:	
Attorney Docket No.: 1251A	:	PETITION
For: Method For Making PLA Stereocomplexes	:	

The petition to revive under 37 CFR 1.137(b) filed on 02 June 2010 in the above-captioned application is hereby **GRANTED** as follows:

Petitioner states that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 C.F.R. 1.137(b) was unintentional." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has paid the petition fee. The required reply has been filed. No terminal disclaimer is required. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the national stage in the United States of America.

This application is being returned to the Office of Patent Application Processing for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283



UNITED STATES PATENT AND TRADEMARK OFFICE

10 SEP 2010

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209 Madison Street  
Suite 500  
Alexandria VA 22314

In re Application of:	:	
CISALE, Felicia., et al.	:	
U.S. Application No.: 12/679,494	:	DECISION REGARDING
PCT No.: PCT/EP2008/008172	:	SUBMISSION UNDER
International Filing Date: 25 September 2008	:	37 CFR 1.42
Priority Date: 27 September 2007	:	
Attorney Docket No.: 2503-1332	:	
For: PROCESS FOR MANUFACTURING	:	
ARTEMISININ	:	

This decision is issued in response to applicants' submission on 07 May 2010 of a declaration executed on behalf of deceased inventor Luigi VILLANOVA by the deceased inventor's legal representatives Felicia CISALE, Azzura VILLANOVA, and Luciano VILLANOVA, considered herein as a submission under 37 CFR 1.42.

**BACKGROUND**

On 25 September 2008, applicants filed international application PCT/EP2008/008172. The international application claimed a priority date of 27 September 2007, and it designated the United States. On 02 April 2009, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 27 March 2010.

On 23 March 2010, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 29 April 2010, the United States Designated/Elected Office (DO/EO/US) issued a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date.

On 21 May 2010, applicants filed a response to the Notification Of Missing Requirements that included payment of the required surcharge and a declaration executed by the three surviving applicant/inventors, Luigi VILLANOVA by the deceased inventor's legal representatives Felicia CISALE, Azzura VILLANOVA, and Luciano VILLANOVA, on their

own behalf and on behalf of deceased inventor Luigi VILLANOVA as legal representatives of the deceased inventor. The declaration is considered herein under 37 CFR 1.42 and 1.497.

### **DISCUSSION**

37 CFR 1.42 states in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the MPEP states that the application can also be executed by all of the heirs of the deceased inventor, where no legal representative has been appointed or is required to be appointed by law.

37 CFR 1.497(b)(2) states the following:

If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), the citizenship for both the deceased inventor and the legal representative must be identified on the declaration, as well as the mailing address and residence information of the legal representative and all other information required under 37 CFR 1.497. Here, the declaration filed 07 May 2010 includes the required citizenship, residence, and mailing address information for the three persons signing the declaration on behalf of the deceased inventor, as well as the required citizenship of the deceased inventor. The declaration also states the relationship of the persons signing to the deceased inventor (i.e., "legal representative"). The declaration therefore includes all information required under 37 CFR 1.497(b)(2).

It is noted that the PCT Request (Form PCT/RO/101) and the published application identified Felicia CISALE, Azzura VILLANOVA, and Luciano VILLANOVA as both heirs to the deceased inventor Luigi VILLANOVA and joint inventors. The declaration is consistent with the international application in identifying Felicia CISALE, Azzura VILLANOVA, and Luciano VILLANOVA as both joint inventors and legal representatives of the deceased joint inventor and is therefore acceptable under 37 CFR 1.497 and 1.42.

### **CONCLUSION**

Applicants' request for status under 37 CFR 1.42 with respect to deceased inventor Luigi VILLANOVA is **GRANTED**.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 07 May 2010.

A handwritten signature in black ink, appearing to read 'nee n'.

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296  
Facsimile: (571) 273-0459

# REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE EUROPEAN PATENT OFFICE (EPO) AND THE USPTO

Application No:	12/679557	Filing date:	24-SEP-2008
First Named Inventor:	Moon, Anthony		

Title of the Invention: Capacitive Sensor and Proximity Detector Using It

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT [HTTP://WWW.USPTO.GOV/EBS/DFS\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application.

**The corresponding PCT application number(s) is/are:** PCT/US2008/077534

**The international date of the corresponding PCT application(s) is/are:** 24-SEP-2008

## I. List of Required Documents:

- a. **A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)**

☒

Is attached

☐

Is not attached because the document is already in the U.S. application.

- b. **A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).**

☒

Is attached.

☐

Is not attached because the document is already in the U.S. application.

- c. **English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.**

- d. **(1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.**

☐

Is attached

☒

Has already been filed in the above-identified U.S. application on 7-30-2010

- (2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)**

☐

Are attached.

☒

Have already been filed in the above-identified U.S. application on 7-30-2010

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM  
BETWEEN THE EPO AND THE USPTO**

(continued)

Application No.: 12/679557

First Named Inventor: Moon, Anthony

**II. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
48	1	identical
49	2	identical
50	3	corresponds to claim 3 as it directly depended from claim 1
51	4	corresponds to claim 4 as it indirectly depended from claim 1 through claim 3
52	5	corresponds to claim 5 as it directly depended from claim 1
53	6	corresponds to claim 6 as it directly depended from claim 1
54	7	corresponds to claim 7 as it indirectly depended from claim 1 through claim 6
55	8	corresponds to claim 8 as it indirectly depended from claim 1 through claim 7
56	9	corresponds to claim 9 as it indirectly depended from claim 1 through claim 8
57	10	corresponds to claim 10 as it indirectly depended from claim 1 through claim 9
58	11	corresponds to claim 11 as it indirectly depended from claim 1 through claim 7
59	12	corresponds to claim 12 as it directly depended from claim 1
60	13	corresponds to claim 13 as it directly depended from claim 1
61	14	corresponds to claim 14 as it directly depended from claim 1
62	15	corresponds to claim 15 as it directly depended from claim 1
63	--	canceled
64	--	canceled
65	6, 15, and 19	Corresponds to claim 19 as it depends on claim 15, incorporating claim 6
66	20	corresponds to claim 20 as it directly depended from claim 19
67	21	corresponds to claim 21 as it directly depended from claim 20
68	23	corresponds to claim 23 as it directly depended from claim 19
69	24	corresponds to claim 24 as it directly depended from claim 19

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
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P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/679,557	06/28/2010	Anthony Moon	63504US005	7516
32692	7590	12/03/2010		
3M INNOVATIVE PROPERTIES COMPANY			EXAMINER	
PO BOX 33427				
ST. PAUL, MN 55133-3427			ART UNIT	PAPER NUMBER
			2858	
			NOTIFICATION DATE	DELIVERY MODE
			12/03/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com  
LegalDocketing@mmm.com



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL MN 55133-3427**

**In re Application of  
Anthony MOON  
Application No.: 12/679,557  
Filed: 28 June 2010  
Attorney Docket No.: 63504US005  
For: CAPACITIVE SENSOR AND  
PROXIMITY DETECTOR USING IT**

**: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PCT PATENT  
: PROSECUTION HIGHWAY PILOT  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(d)**

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed 13 August 2010, to make the above-identified application special.

The request and petition are **DISMISSED**.

**Discussion**

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must have an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, KIPO, or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;
- (6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate.

if the latest international work product is not in the English language;

(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

Conditions (1-5) and (7) above are considered to have been met. However, the request to participate in the PPH pilot program and petition fails meet condition (6).

Regarding the requirement of condition (6), applicant has failed submit a copy of the ISA/237.

Applicant is given **ONE** opportunity within a time period of **ONE MONTH or THIRTY DAYS**, whichever is longer, from the mailing date of this decision to correct the deficiencies. **NO EXTENSION OF TIME UNDER 37 CFR 1.136 IS PERMITTED.** If the deficiencies are not corrected with the time period given, the application will await action in its regular turn.

Response must be filed via the Electronic Filing System (EFS) with the Document Code PPH.PCT.652. Any preliminary amendments and IDS submitted with the PPH documents must be separately indexed as a preliminary amendment and IDS, respectively.

Telephone inquiries concerning this decision should be directed to Lee W. Young at 571-272-4549.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc/index.html>.



Lee W. Young  
TQAS Technology Center 2800 - Semiconductors,  
Electrical & Optical Systems & Components

32692

Customer Number

Patent  
Case No.: 63504US005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Inventor: MOON, ANTHONY

Application No.: 12/679557

Confirmation No.: 7516

Filed: 24-SEP-2008

Title: CAPACITIVE SENSOR AND PROXIMITY DETECTOR USING IT

**RESPONSE TO DECISION ON REQUEST TO PARTICIPATE IN THE PCT PATENT  
PROSECUTION HIGHWAY PILOT PROGRAM AND PETITION TO MAKE SPECIAL UNDER  
37 CFR 1.102(D)**

**CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR § 1.8(a)]**

I hereby certify that this correspondence is being:

- ☒ transmitted to United States Patent and Trademark Office on the date shown below via the Office electronic filing system.
- ☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
- ☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at 571-273-8300.

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

December 14, 2010  
Date

/Joyce M. Courtney/  
Signed by: Joyce M. Courtney

Dear Sir:

This is in response to the Decision on Request to Participate in the PCT Patent Prosecution Highway Pilot Program and Petition to Make Special Under 37 CF 1.102(d). The request and petition were dismissed for failing to meet condition (6).

Regarding the requirement of condition (6), applicant hereby submits a copy of ISA/237.

**Fees**

- ☐ Any required fee will be made at the time of submission via EFS-Web. In the event fees are not or cannot be paid at the time of EFS-Web submission, please charge any fees under 37 CFR § 1.17 which may be required to Deposit Account No. 13-3723.
- ☐ Please charge any fees under 37 CFR §§ 1.16 and 1.17 which may be required to Deposit Account No. 13-3723.
- ☒ Please charge any additional fees associated with the prosecution of this application to Deposit Account No. 13-3723. This authorization includes the fee for any necessary extension of time under 37 CFR § 1.136(a). To the extent any such extension should become necessary, it is hereby requested.
- ☒ Please credit any overpayment to the same deposit account.

**Remarks**

In addition to addressing the concern regarding item (6), Applicants further note the following. The items listed in Box VII of the Written Opinion are not relevant requirements of the USPTO, and have not been addressed.

In view of the above, the request to participate in the PPH program and petition comply with the requirements. It is submitted that the request and petition be granted to participate in the PCT-PPH pilot program.

Respectfully submitted,

December 14, 2010  
Date

By: /Thomas M. Spielbauer/  
Thomas M. Spielbauer, Reg. No.: 58,492  
Telephone No.: 651-736-9814

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/679,557	06/28/2010	Anthony Moon	63504US005	7516
32692 7590 01/20/2011 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER	
			ART UNIT	PAPER NUMBER
			2858	
			NOTIFICATION DATE	DELIVERY MODE
			01/20/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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LegalDocketing@mmm.com



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**3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL MN 55133-3427**

**In re Application of  
Anthony MOON  
Application No.: 12/679,557  
Filed: 28 June 2010  
Attorney Docket No.: 63504US005  
For: CAPACITIVE SENSOR AND  
PROXIMITY DETECTOR USING IT**

**: DECISION ON REQUEST TO  
: PARTICIPATE IN THE PCT PATENT  
: PROSECUTION HIGHWAY PILOT  
: PROGRAM AND PETITION  
: TO MAKE SPECIAL UNDER  
: 37 CFR 1.102(d)**

This is a decision on the request to participate in the PCT Patent Prosecution Highway (PCT-PPH) pilot program and the petition under 37 CFR 1.102(a), filed 13 August 2010 and renewed on 14 December 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PCT-PPH pilot program and petition to make special require:

- (1) The U.S. application must disclose an eligible relationship to one or more PCT applications where the ISA or IPEA are the JPO, EPO, KIPO, or USPTO;
- (2) At least one claim in the PCT application has novelty, inventive step, and industrial applicability and must be free of any observations in Box VIII in the latest work product in the international stage or applicant must identify and explain why the claim(s) is/are not subject to the observation in Box VIII;
- (3) Applicant must submit a copy of the claim(s) from the PCT application(s) that have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate, if the claims are not in the English language;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the claim(s) that have novelty, inventive step, and industrial applicability in the PCT application(s);
- (5) Examination of the U.S. application has not begun;
- (6) Applicant must submit a copy of the latest international work product from the PCT application indicating that the claim(s) have novelty, inventive step, and industrial applicability along with an English translation thereof and a statement that the English translation is accurate

if the latest international work product is not in the English language;

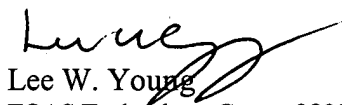
(7) Applicant must submit an IDS listing the documents cited by the PCT examiner in the international work product along with copies of documents except U.S. patents or U.S. patent application publications.

The request to participate in the PCT-PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Lee W. Young at 571-272-4549.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/ebc.index.html>.

This application will be forwarded to the examiner for action on the merits commensurate with this decision once this application's formality reviews have been completed.



Lee W. Young  
TQAS Technology Center 2800 - Semiconductors,  
Electrical & Optical Systems & Components



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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON DC 20001-4413

**MAILED**

**NOV 03 2011**

**OFFICE OF PETITIONS**

Applicants: Greaves, et al.  
Appl. No.: 12/679,665  
International Filing Date: September 23, 2008  
Title: DYE COMPOSITION COMPRISING AT LEAST ONE COLORLESS  
DISULFIDE/THIOL PRECURSOR, AND DYEING PROCESS USING THE COMPOSITION  
Attorney Docket: 05725.1835  
Pub. No.: US 2011/0016642 A1  
Pub. Date: January 27, 2011

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on March 18, 2011, for the above-identified application.

The request is Dismissed as Moot.

A review of the record discloses that the above-identified application issued as U.S. Patent No. 8,034,125 on October 11, 2011, which is prior to consideration of the present request for reconsideration. Applicant may wish to consider filing a request for a certificate of correction under the provisions 37 CFR 1.322 to correct Office errors in the patent, if necessary.

Inquiries relating to this matter may be directed to Sherry D. Brinkley at (571) 272-3204.

/Christopher Bottorff/

Christopher Bottorff  
Petitions Examiner  
Office of Petitions



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C/O GREENBERG TRAURIG, LLP  
77 W. WACKER DRIVE  
SUITE 3100  
CHICAGO, IL 60601-1732

**MAILED**  
**MAR 26 2012**  
**OFFICE OF PETITIONS**

In re Application of :  
David Hargreaves, et al. :  
Application No. 12/679,719 : NOTICE  
Filed: March 24, 2010 :  
Attorney Docket No. 119520.10US1 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989).** Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-1642.

/AMW/  
April M. Wise  
Petitions Examiner  
Office of Petitions

**REQUEST FOR PARTICIPATION IN THE PATENT COOPERATION TREATY - PATENT PROSECUTION  
HIGHWAY (PCT-PPH) PILOT PROGRAM BETWEEN THE JAPAN PATENT OFFICE (JPO) AND THE  
USPTO**

Application No:	12/679744	Filing date:	3/24/2010
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First Named Inventor:	Tetsunori Matsumoto
-----------------------	---------------------

Title of the Invention:	Swellable Crosslinked Hyaluronan Powder And Method For Producing The Same
----------------------------	---

**THIS REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE  
SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT  
[HTTP://WWW.USPTO.GOV/EBS/EF5\\_HELP.HTML](http://www.uspto.gov/ebs/efs_help.html)**

**APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PCT-PPH PROGRAM AND PETITIONS TO MAKE THE  
ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PCT-PPH PROGRAM.**

The above-identified application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/ foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application, or (5) a continuing application of a U.S. application that satisfies one of (1) to (4) above, or (6) a U.S. application that claims domestic benefit to a U.S. provisional application which forms the basis for the priority claim in the corresponding PCT application.

The corresponding PCT application number(s) is/are: PCT/JP2008/067508

The international date of the corresponding PCT application(s) is/are: September 26, 2008

**I. List of Required Documents:**

- a. A copy of the latest international work product (WO/ISA, WO/IPEA, or IPER) in the above-identified corresponding PCT application(s)

☐

Is attached.

☒Is not attached because the document is already in the U.S. application.

- b. A copy of all claims which were indicated as having novelty, inventive step and industrial applicability in the above-identified corresponding PCT application(s).

☒

Is attached.

☐Is not attached because the document is already in the U.S. application.

- c. English translations of the documents in a. and b. above are attached (if the documents are not in the English language). A statement that the English translation is accurate is attached for the document in b. above.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**REQUEST FOR PARTICIPATION IN THE PCT-PPH PILOT PROGRAM  
BETWEEN THE JPO AND THE USPTO**

(continued)

Application No.:	12/679744
First Named Inventor:	Tetsunori Matsumoto

d. (1) An information disclosure statement listing the documents cited in the international work products (ISR, WO/ISA, WO/IPEA, IPER) of the corresponding PCT application.

☐

Is attached

☒Has already been filed in the above-identified U.S. application on June 17, 2010

(2) Copies of all documents (except) for U.S. patents or U.S. patent application publications)

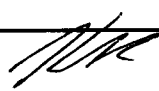
☐

Are attached.

☒Have already been filed in the above-identified U.S. application on June 17, 2010**I. Claims Correspondence Table:**

Claims in US Application	Patentable Claims in the corresponding PCT Application	Explanation regarding the correspondence
1-20	N/A	US claims have been canceled
21	1	The US and JP claims are of the same or similar scope
22	2	The US and JP claims are of the same or similar scope
23	3	The US and JP claims are of the same or similar scope
24	4	The US and JP claims are of the same or similar scope
25	5	The US and JP claims are of the same or similar scope
26	6	The US and JP claims are of the same or similar scope
27	7	The US and JP claims are of the same or similar scope
28	8	The US and JP claims are of the same or similar scope
29	9	The US and JP claims are of the same or similar scope
30	10	The US and JP claims are of the same or similar scope
31	11	The US and JP claims are of the same or similar scope
32	5	The US and JP claims are of the same or similar scope
33	6	The US and JP claims are of the same or similar scope
34	6	The US and JP claims are of the same or similar scope
35	6	The US and JP claims are of the same or similar scope

**III. All the claims in the US application sufficiently correspond to the patentable claims in the corresponding PCT application.**

Signature 	Date <u>August 9, 2010</u>
Name (Print/Typed) <u>Kenneth A. Clark</u>	Registration Number <u>32119</u>

### **Statement**

I, Kanako Ohtsuka, a technical translator to Iwahashi International Patent & Trademark Agency, do solemnly and sincerely declare:

1. that I am fully conversant with the Japanese and English languages;
2. that the attached document is a copy of the allowed claims, of the PCT Application No. PCT/JP2008/067508, which is indicated in the Japanese Patent No. JP4460617B2;
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Declared in Kanagawa, Japan

This 9 day of July, 2010

A handwritten signature in black ink, reading "Kanako Ohtsuka", written over a horizontal line.

Kanako Ohtsuka

(19) 日本国特許庁 (JP)

(12) 特 許 公 報 (B2)

(11) 特許番号

特許第4460617号

(P4460617)

(45) 発行日 平成22年5月12日 (2010.5.12)

(24) 登録日 平成22年2月19日 (2010.2.19)

(51) Int. Cl.

C08B 37/08 (2006.01)

F 1

C08B 37/08

Z

請求項の数 11 (全 21 頁)

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		(56) 参考文献	特開平8-333402 (JP, A)
			特開平7-102002 (JP, A)
			特開昭60-130601 (JP, A)
			最終頁に続く

(54) 【発明の名称】 膨潤性架橋ヒアルロン酸粉末及びその製造方法

(57) 【特許請求の範囲】

【請求項1】

水中における膨潤率が500%以上であり、  
 ヒアルロン酸粉末を、炭素数1～4の1価アルコールを含有し、且つ該ヒアルロン酸粉末  
 の溶解度が0.1g/L未満である液状媒体中に分散した状態で、架橋剤とともに混合し  
 、架橋反応を行なって得ることを特徴とする膨潤性架橋ヒアルロン酸粉末。

【請求項2】

水を用いて限界まで膨潤させたときのヒアルロン酸濃度が0.1～2  
 0重量%であることを特徴とする請求項1に記載の膨潤性架橋ヒアルロン酸粉末。

【請求項3】

ヒアルロン酸粉末を、炭素数1～4の1価アルコールを含有し、且つ  
 該ヒアルロン酸粉末の溶解度が0.1g/L未満である液状媒体中に分散した状態で、架  
 橋剤とともに混合し、架橋反応を行なうことを特徴とする膨潤性架橋ヒアルロン酸粉末の  
 製造方法。

【請求項4】

請求項3に記載の膨潤性架橋ヒアルロン酸粉末の製造方法において、  
 前記液状媒体が、前記1価アルコールと水との混合溶媒であることを特徴とする膨潤性架  
 橋ヒアルロン酸粉末の製造方法。

【請求項5】

請求項3または4に記載の膨潤性架橋ヒアルロン酸粉末の製造方法に

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において、前記1価アルコールがエタノールまたは2-プロパノールであることを特徴とする膨潤性架橋ヒアルロン酸粉末の製造方法。

【請求項6】

請求項3～5のいずれかに記載の膨潤性架橋ヒアルロン酸粉末の製造方法において、前記1価アルコールと水との混合比が、質量比で99：9：0.1～65：35であることを特徴とする膨潤性架橋ヒアルロン酸粉末の製造方法。

【請求項7】

請求項3～6のいずれかに記載の膨潤性架橋ヒアルロン酸粉末の製造方法において、前記水がアルカリ性緩衝液または酸性緩衝液であることを特徴とする膨潤性架橋ヒアルロン酸粉末の製造方法。

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【請求項8】

請求項3～7のいずれかに記載の膨潤性架橋ヒアルロン酸粉末の製造方法において、前記架橋剤が、ジビニルスルホン、1,4-ブタンジオール・ジグリシジルエーテル、及び／またはエチレングリコール・ジグリシジルエーテルであることを特徴とする膨潤性架橋ヒアルロン酸粉末の製造方法。

【請求項9】

下記工程(1)及び(2)を含む膨潤性架橋ヒアルロン酸粉末の製造方法。

(1) ヒアルロン酸粉末を、炭素数1～4の1価アルコールとアルカリ性緩衝液とを含有し、且つ該ヒアルロン酸粉末の溶解度が0.1g/L未満である溶媒に分散した状態で、架橋剤とともに混合し、架橋反応を行なう。

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(2) 前記(1)工程の生成物を、炭素数1～4の1価アルコールと酸性緩衝液とを含有し、且つ該ヒアルロン酸粉末の溶解度が0.1g/L未満である溶媒に分散した状態で、架橋剤とともに混合し、架橋反応を行なう。

【請求項10】

請求項9に記載の膨潤性架橋ヒアルロン酸粉末の製造方法において、前記1価アルコールとアルカリ性緩衝液または酸性緩衝液との混合比が、質量比で99：9：0.1～65：35であることを特徴とする膨潤性架橋ヒアルロン酸粉末の製造方法。

【請求項11】

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請求項9または10に記載の膨潤性架橋ヒアルロン酸粉末の製造方法において、前記架橋剤が、ジビニルスルホン、1,4-ブタンジオール・ジグリシジルエーテル、及び／またはエチレングリコール・ジグリシジルエーテルであることを特徴とする膨潤性架橋ヒアルロン酸粉末の製造方法。

【発明の詳細な説明】

【技術分野】

【0001】

本発明は膨潤性架橋ヒアルロン酸粉末及びその製造方法、特に膨潤性に優れた架橋ヒアルロン酸粉末と、その簡便な製造方法に関するものである。

【背景技術】

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【0002】

ヒアルロン酸を架橋した架橋ヒアルロン酸ゲルは、生体適合性に優れるとともに、生体内において経時的に分解が進み、最終的には消滅するという生分解性も兼ね備えている。従来、架橋ヒアルロン酸ゲルのこのような性質を利用して、癒着防止剤、骨修復剤、薬物徐放性組成物、及び組織増大物質等への応用に関する研究・開発が盛んに行なわれており、例えば、組織増大物質への代表的な応用例として、美容形成の分野における皺伸ばし注入剤が知られている。

【0003】

架橋ヒアルロン酸ゲルを、例えば、皺伸ばし注入剤として用いる場合には、注入部位において一定の体積を確保するため、より濃密な高粘弾性の架橋ゲルが要求される。また、

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薬物徐放製剤として架橋ヒアルロン酸ゲルを用いる場合においても、薬剤の適正な効果を一定期間維持するためには生体内に長期間滞留させる必要があり、濃密な高い粘弾性を有する架橋ヒアルロン酸ゲルが望ましい。

【0004】

従来、架橋ヒアルロン酸ゲルは、固体のヒアルロン酸を水中に溶解し、架橋剤及びアルカリを添加して架橋反応し、さらに得られたヒアルロン酸ゲルから不純物（余剰の架橋剤及びアルカリ）を除去する等の工程を経て調製されている（特許文献1）。

しかしながら、ヒアルロン酸は分子量が大きく、水に溶解した場合には低濃度でも水溶液の粘弾性が非常に大きくなるため、工業的規模で水に溶解するには非常に時間と手間がかかってしまう。特に、高密度の架橋ヒアルロン酸ゲルを得ようとして、ヒアルロン酸濃度を高めた場合、液相が著しく増粘してしまい、水溶液中で架橋剤やアルカリと均一に攪拌混合する際や、透析等によってこれらを除去する際において、非常に煩雑な工程となってしまう、多くの時間や手間を要するという問題があった。

【0005】

また、架橋ヒアルロン酸は基本的に高い水膨潤性及び粘弾性を有するため、保存時、ゲル調製時、ないしは生体への注入時などに取扱い難いという問題点があった。したがって、使用時に水を添加することによって所望のゲルとして使用することのできる、粉末形態の架橋ヒアルロン酸ゲルが求められてきた。さらには、生体への注入負担を低減し、且つ生体内により長期間滞留させるという観点から、架橋ヒアルロン酸を粉末状態で製造し、そのまま生体内に注入する試みも期待されている。

前記特許文献1のような架橋ヒアルロン酸ゲルは、水に溶解したヒアルロン酸を架橋して製造するものである。したがって、このような従来製法から架橋ヒアルロン酸粉末を得るには、架橋ヒアルロン酸ゲルを製造した後、該ゲルを乾燥させて粉末とすることになる。しかしながら、架橋ヒアルロン酸ゲルを乾燥させた粉末に水を加えても、膨潤せずに離水してしまい、乾燥前のゲルを再現することはできなかった。

また、特許文献2には、ヒアルロン酸を水-アセトン混液において架橋後、加熱乾燥させた粉末が記載されているが、この方法において得られた架橋ヒアルロン酸粉末もまた、水中における膨潤率が極めて低く、ほぼ粘稠液の状態となってしまうため、ゲルとしての実用性には乏しいものであった。

【特許文献1】特許第3094074号

【特許文献2】特開昭60-130601号

【発明の開示】

【発明が解決しようとする課題】

【0006】

本発明は、前記従来技術に鑑みてなされたものであり、その解決すべき課題は、水中における膨潤性に優れた架橋ヒアルロン酸粉末と、その簡便な製造方法を提供することにある。

【課題を解決するための手段】

【0007】

前記従来技術の課題に鑑み、本発明者らが鋭意検討を行なった結果、ヒアルロン酸粉末を、1価の低級アルコールを含有し、該ヒアルロン酸粉末を溶解しない液状媒体中に分散した状態で、架橋剤とともに混合し、架橋反応を行なうことにより、膨潤性架橋ヒアルロン酸粉末を容易に製造できることを見出した。また、この方法により得られた膨潤性架橋ヒアルロン酸粉末が水中において顕著に膨潤し、粘弾性に優れた架橋ヒアルロン酸ゲルとなることを見出し、本発明を完成するに至った。

【0008】

すなわち、本発明にかかる膨潤性架橋ヒアルロン酸粉末は、水中における膨潤率が50%以上であることを特徴とする。

また、前記膨潤性架橋ヒアルロン酸粉末は、水を用いて限界まで膨潤させたときのヒアルロン酸濃度が0.1～20重量%であることが好適である。

## 【0009】

また、本発明にかかる膨潤性架橋ヒアルロン酸粉末の製造方法は、ヒアルロン酸粉末を、炭素数1～4の1価アルコールを含有し、且つ該ヒアルロン酸粉末の溶解度が0.1g/L未満である液状媒体中に分散した状態で、架橋剤とともに混合し、架橋反応を行なうことを特徴とする。

前記膨潤性架橋ヒアルロン酸粉末の製造方法において、前記液状媒体が、前記1価アルコールと水との混合溶媒であることが好適である。

前記膨潤性架橋ヒアルロン酸粉末の製造方法において、前記1価アルコールがエタノールまたは2-プロパノールであることが好適である。

前記膨潤性架橋ヒアルロン酸粉末の製造方法において、前記1価アルコールと水との混合比が、質量比で99.9：0.1～65：35であることが好適である。 10

前記膨潤性架橋ヒアルロン酸粉末の製造方法において、前記水がアルカリ性緩衝液または酸性緩衝液であることが好適である。

前記膨潤性架橋ヒアルロン酸粉末の製造方法において、前記架橋剤が、ジビニルスルホン、1,4-ブタンジオール・ジグリシジルエーテル、及び／またはエチレングリコール・ジグリシジルエーテルであることが好適である。

## 【0010】

また、本発明にかかる膨潤性架橋ヒアルロン酸粉末の製造方法は、下記工程(1)及び(2)を含むことを特徴とする。

(1) ヒアルロン酸粉末を、炭素数1～4の1価アルコールとアルカリ性緩衝液とを含有し、且つ該ヒアルロン酸粉末の溶解度が0.1g/L未満である溶媒に分散した状態で、架橋剤とともに混合し、架橋反応を行なう。 20

(2) 前記(1)工程の生成物を、炭素数1～4の1価アルコールと酸性緩衝液とを含有し、且つ該ヒアルロン酸粉末の溶解度が0.1g/L未満である溶媒に分散した状態で、架橋剤とともに混合し、架橋反応を行なう。

前記膨潤性架橋ヒアルロン酸粉末の製造方法において、前記1価アルコールとアルカリ性緩衝液または酸性緩衝液との混合比が、質量比で99.9：0.1～65：35であることが好適である。

前記膨潤性架橋ヒアルロン酸粉末の製造方法において、前記架橋剤が、ジビニルスルホン、1,4-ブタンジオール・ジグリシジルエーテル、及び／またはエチレングリコール・ジグリシジルエーテルであることが好適である。 30

## 【発明の効果】

## 【0011】

本発明によれば、ヒアルロン酸粉末を分散した状態で架橋反応を行なうことにより、従来の方法で行なわれていたような煩雑な工程を経ることなく、容易に膨潤性架橋ヒアルロン酸粉末が得られるため、時間やコスト面で非常に有用である。また、本発明により得られる膨潤性架橋ヒアルロン酸粉末は、水膨潤させた場合の膨潤率が高く、優れた粘弾性を有するものである。

## 【発明を実施するための最良の形態】

## 【0012】

本発明にかかる膨潤性架橋ヒアルロン酸粉末は、水中における膨潤率が500%以上であることを特徴とするものである。 40

ここで、膨潤率が500%以上とは、所定量の膨潤性架橋ヒアルロン酸粉末を大過剰の純水中で膨潤させ、架橋ヒアルロン酸ゲルとした場合において、架橋ヒアルロン酸粉末の重量100%に対し、膨潤した架橋ヒアルロン酸ゲルの重量が500%以上、すなわち前記粉末が5倍以上に膨潤することを意味する。

また、前記膨潤性架橋ヒアルロン酸粉末は、水を用いて限界まで膨潤させたときのヒアルロン酸濃度が0.1～20重量%である。したがって、本発明にかかる膨潤性架橋ヒアルロン酸粉末は、好ましくは膨潤率500%～100000%である。

## 【0013】

本発明にかかる膨潤性架橋ヒアルロン酸粉末は、そのまま、あるいは適当な処方中に配合することにより、医薬品、化粧品等に用いることが可能である。また、特に本発明にかかる架橋架橋ヒアルロン酸粉末は、粉末の状態から再膨潤させることが可能であることから、生体中に適用する物質への応用、例えば、皺伸ばし注入剤等の組織増大物質、薬物徐放性組成物、癒着防止剤、骨修復剤等に好適に応用することが可能である。

また、本発明にかかる膨潤性架橋ヒアルロン酸粉末を水中で膨潤させて架橋ヒアルロン酸ゲルとしたのち、これを上記のような用途に適用することもできる。

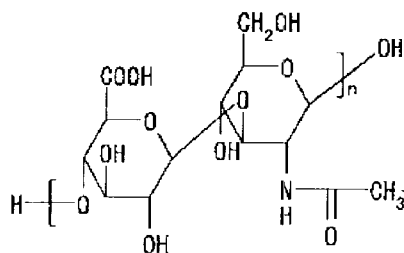
#### 【0014】

また、本発明にかかる膨潤性架橋ヒアルロン酸粉末の製造方法は、ヒアルロン酸粉末を、炭素数1～4の1価アルコールを含有し、且つ該ヒアルロン酸粉末を溶解しない液状媒体中に分散した状態で、架橋剤とともに混合し、架橋反応を行なうことを特徴とするものである。

#### 【0015】

本発明の製造方法に用いるヒアルロン酸粉末は、下記一般式に示されるようにN-アセチル-D-グルコサミン残基と、D-グルクロン酸残基が交互に結合した直鎖状高分子であり、これを粉末状に加工したものであれば特に限定することなく用いることができる。

#### 【化1】



#### 【0016】

ヒアルロン酸は、例えば、鶏冠や他の動物組織からの単離抽出、あるいはストレプト・コッカス属などの微生物を用いた発酵法により得ることができる。また、本発明においては、例えば、ヒアルロン酸の誘導体として、ヒアルロン酸ナトリウム塩、ヒアルロン酸カリウム塩等のヒアルロン酸金属塩や、ヒアルロン酸のヒドロキシル基、カルボキシル基等をエーテル化、エステル化、アミド化、アセタール化、ケタール化させて得られるヒアルロン酸誘導体等の粉末を用いても構わない。

また、ヒアルロン酸粉末としては、市販品を用いることもできる。市販のヒアルロン酸としては、例えば、バイオヒアロ12（資生堂社製）、ヒアルロン酸（紀文社製）等が挙げられる。

#### 【0017】

本発明の製造方法に用いるヒアルロン酸粉末の分子量は、特に限定されるものではないが、分子量10万以上、さらには分子量が50万～300万程度であることが好適である。通常、一般的に用いられるヒアルロン酸はそのほとんどが分子量10万以上であるものの、特別に低分子化した分子量1万程度のヒアルロン酸も存在する。本発明において、このような分子量1万程度の低分子化ヒアルロン酸を用いると、膨潤性架橋ヒアルロン酸粉末を水膨潤させた際に、所望の粘弾性を有する架橋ヒアルロン酸ゲルを得ることができない場合があるため、あまり好ましくない。

#### 【0018】

なお、ヒアルロン酸粉末が液状媒体中に溶解する場合には、外観が透明の粘稠液状となる。他方、ヒアルロン酸粉末が液状媒体中に溶解せずに分散している場合には、液状媒体中にヒアルロン酸粉末分散粒子の存在が確認される。そして、本発明の製造方法においては、ヒアルロン酸粉末を溶解させずに、粉末状態のままで液状媒体中に分散させて架橋反

応を行なうので、液相の増粘が起こらず、高濃度のヒアルロン酸分散液であっても容易に処理することができる。本発明の製造方法において、架橋反応に供するヒアルロン酸粉末の濃度は、特に架橋反応に支障のない限り限定されるものではなく、50 W/V %程度の高濃度でも処理可能であるが、好ましくは、架橋反応に供する混合物中、0.1～30 W/V %、さらに好ましくは1～20 W/V %である。

#### 【0019】

本発明の製造方法に用いる液状媒体は、炭素数1～4の1価アルコールを含有し、且つ該ヒアルロン酸粉末を溶解しない液状媒体である。

炭素数1～4の1価アルコールとしては、特に限定されるものではないが、例えば、メタノール、エタノール、1-プロパノール、2-プロパノール、1-ブタノール、2-メチル-1-プロパノール、2-ブタノール、2-メチル-2-プロパノール等が挙げられる。これらのうち、メタノール、エタノール、1-プロパノール、又は2-プロパノールを特に好適に用いることができる。本発明においては、特にエタノールまたは2-プロパノールの使用が好適である。

なお、本発明の製造方法において、例えば、エチレングリコール等の多価アルコール類を用いた場合には、ヒアルロン酸粉末が溶解してしまい、また、アセトン等のケトン類を用いた場合には、得られた架橋ヒアルロン酸粉末の水中における膨潤率が500%に満たず、所望の架橋ヒアルロン酸ゲルが得られない場合がある。

また、本発明において、ヒアルロン酸粉末を溶解しないとは、具体的には、ヒアルロン酸粉末の溶解度が0.1 g/l (25℃) 未満であることを意味する。

#### 【0020】

本発明の製造方法に用いる液状媒体としては、具体的には、前記1価アルコールと水との混合溶媒が挙げられる。ここで、混合溶媒中の水の配合割合が多くなりすぎると、液状媒体中にヒアルロン酸粉末が溶解してしまい、液相が増粘してしまうためにハンドリングしにくくなり、膨潤性架橋ヒアルロン酸粉末の製造が困難になる。このため、前記混合溶媒中の1価アルコールと水との質量比(1価アルコール：水)は、99.9：0.1～65：35であることが好ましい。さらに、前記質量比(1価アルコール：水)が、99.9：0.1～85：15であることがより好ましい。

#### 【0021】

本発明の製造方法に用いる架橋剤は、前記ヒアルロン酸の高分子鎖間を化学結合によって架橋し得るものであれば、どのようなものを用いても構わない。ヒアルロン酸の架橋剤としては、ヒアルロン酸分子の持つカルボキシル基、水酸基、アセトアミド基といった反応性官能基と反応して共有結合を形成し得る官能基を2以上有する多官能性化合物を用いることができる。本発明に用いる架橋剤としては、具体的には、1,3-ブタジエンジエポキシド、1,2,7,8-ジエポキシオクタン、1,5-ヘキサジエンジエポキシド等のアルキルジエポキシ体、エチレングリコールジグリシジルエーテル、1,4-ブタンジオールジグリシジルエーテル、ビスフェノールAジグリシジルエーテル等のジグリシジルエーテル体、ジビニルスルホン、エピクロルヒドリン等が挙げられる。これらの中でも、特にジビニルスルホン、1,4-ブタンジオール・ジグリシジルエーテル、及びエチレングリコール・ジグリシジルエーテルを好適に用いることができる。また、本発明においては、2種以上の架橋剤を適宜組み合わせ用いても構わない。

また、本発明の製造方法において、架橋剤の配合量は特に限定されるものではないが、具体的には、架橋反応に供する混合物中、0.1～10 W/V %であることが好ましく、また、より好ましくは0.5～5 W/V %である。

#### 【0022】

また、本発明の製造方法においては、架橋反応時のヒアルロン酸の反応性を高める目的で、架橋反応に供する混合物中に、塩酸、硫酸等の酸、水酸化ナトリウム、水酸化カリウム等の塩基、あるいはリン酸塩、4級アンモニウム塩等の適当な緩衝液を添加して、混合物のpHを適宜調整したり、アルカリ又は酸条件下で架橋反応を行なってもよい。

例えば、前記液状媒体中の水に代えて0.001～0.1Nのアルカリ性緩衝液を用い

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、アルカリ条件下で架橋反応を行なうと、ヒアルロン酸分子のヒドロキシメチル基が架橋剤とエーテル結合を形成して架橋が達成される。

また、前記液状媒体中の水に代えて0.001～0.1Nの酸性緩衝液を用い、酸条件下で架橋反応を行なうと、ヒアルロン酸分子のカルボキシル基が架橋剤とエステル結合を形成して架橋が達成される。

#### 【0023】

架橋反応をアルカリ又は酸条件下で行なって得た膨潤性架橋ヒアルロン酸粉末を水膨潤させると、液状媒体として水を用いて得た粉末の場合よりも、さらに膨潤率が高く、粘弾性に優れた架橋ヒアルロン酸ゲルとなる。また、前記架橋ヒアルロン酸ゲルの粘弾性は、各緩衝液の濃度によっても変化し、通常、アルカリ濃度が高いほど損失弾性率が低下し、保形性の高いゲルとなる傾向にある。したがって、本発明にかかる膨潤性架橋ヒアルロン酸粉末の製造において、架橋反応時のアルカリ又は酸条件を調整することにより、用途や目的に応じた膨潤性及び粘弾性の架橋ヒアルロン酸ゲルを得ることができる。

#### 【0024】

また、本発明の製造方法において、架橋反応に供する混合物中、前記必須成分の他にも、予め、通常、医薬品、化粧料等に用いられる成分を、本発明の目的及び効果に影響が出ない範囲で配合しても構わない。配合可能な成分としては、例えば、アスコルビン酸及びその誘導体、グリセリン等の保湿剤、レチノール及びその誘導体、サリチル酸等の抗炎症剤等が挙げられる。

#### 【0025】

本発明の製造方法において、架橋反応に供する反応時間は、原料ヒアルロン酸粉末や架橋剤配合量、さらには目的とする架橋ヒアルロン酸粉末の物性等によっても異なるが、通常の場合、30分～100時間、より好ましくは1時間～72時間である。

また、本発明の製造方法においては、架橋反応を速やかに進行させて反応時間を短縮するために加熱してもよい。反応温度としては、20～120℃とすることができるが、より好ましくは25～90℃である。また、架橋反応後は、遠心分離やろ過など公知の方法により固液分離し、得られた粉末を常法によって洗浄、乾燥することにより、粉末状の架橋ヒアルロン酸ゲルを得ることができる。

#### 【0026】

また、本発明の製造方法においては、反応温度、反応時間、使用するヒアルロン酸粉末、架橋剤等の種類・濃度等を変化させることによって、水中に膨潤させた際の膨潤率や粘弾性等の物性が異なる膨潤性架橋ヒアルロン酸粉末を得ることができる。よって、目的とする膨潤性架橋ヒアルロン酸粉末の物性に依拠して、これらを適宜決定すればよい。

#### 【0027】

また、本発明にかかる製造方法は、別の実施形態として、2重架橋を施した膨潤性架橋ヒアルロン酸粉末の製造方法を包含する。

ここで2重架橋とは、ヒアルロン酸分子のヒドロキシ基とカルボキシル基の両方を架橋剤と架橋反応させることを意味する。

本発明において、2重架橋を施した膨潤性架橋ヒアルロン酸粉末は、下記工程(1)及び(2)を経て製造することができる。

(1) ヒアルロン酸粉末を、炭素数1～4の1価アルコールとアルカリ性緩衝液とを含有し、且つ該ヒアルロン酸粉末の溶解度が0.1g/L未満である溶媒に分散した状態で、架橋剤とともに混合し、架橋反応を行なう。

(2) 前記(1)工程の生成物を、炭素数1～4の1価アルコールと酸性緩衝液とを含有し、且つ該ヒアルロン酸粉末の溶解度が0.1g/L未満である溶媒に分散した状態で、架橋剤とともに混合し、架橋反応を行なう。

#### 【0028】

前記(1)工程は、前述した架橋反応をアルカリ条件下で行ない、ヒアルロン酸分子中にエーテル架橋を形成させることを示す。また、前記(2)工程は、前述の架橋反応を酸条件下で行ない、前記ヒアルロン酸分子中にさらにエステル架橋を形成することを示す。

したがって、(1)及び(2)工程において、ヒアルロン酸粉末、溶媒、及び架橋反応に関する構成等は、前述の説明に準ずることができる。

架橋剤は、(1)及び(2)の両工程を通じ、ジビニルスルホン、1, 4-ブタンジオール・ジグリシジルエーテル、及びエチレングリコール・ジグリシジルエーテル等のジグリシジルエーテルを使用することが好ましい。

#### 【0029】

以下に2重架橋を施した膨潤性架橋ヒアルロン酸粉末の製造方法を例示するが、これらは単なる一例であって本発明を制限するものではない。

(膨潤性架橋ヒアルロン酸粉末の製造例)

炭素数1～4の1価アルコールと0.01～0.1N水酸化ナトリウム水溶液とを99.9:0.1～65:35の質量比で混合して得た液溶媒へ架橋剤を混合し、ヒアルロン酸粉末を添加・分散し、適当な条件下で架橋反応を行なう。架橋反応後、遠心分離やろ過などによりヒアルロン酸粉末を回収し、常法によって洗浄、乾燥して膨潤性架橋ヒアルロン酸粉末を得る。

その後、前記膨潤性架橋ヒアルロン酸粉末を、炭素数1～4の1価アルコールと0.01～0.1N塩酸水溶液とを99.9:0.1～65:35の質量比で混合して得た液溶媒と架橋剤の混合液に添加・分散し、適当な条件下で再度架橋反応を行なう。架橋反応後、同様にろ過によるヒアルロン酸粉末の回収、該粉末の洗浄及び乾燥を行ない、2重架橋された膨潤性架橋ヒアルロン酸粉末を得る。

#### 【0030】

2重架橋を施すことにより、アルカリ又は酸性のいずれか一方の条件で架橋させた場合に比べ、水膨潤時の架橋ヒアルロン酸ゲルの保形性が高くなる傾向にある。また、前記ゲルの粘弾性は、アルカリ及び酸性緩衝液の濃度によって調整することが可能であり、通常、アルカリ濃度が高いほど弾性的なゲルが得られる。

このような2重架橋の膨潤性架橋ヒアルロン酸粉末及び、該粉末に由来するゲルは、いわゆる皮膚の弾力に近い物性を示すため、皺伸ばし注入剤等の組織増大物質における使用に特に好適である。

#### 【0031】

なお、酸条件下で架橋反応を行った後にアルカリ条件下で架橋反応を行なうと、アルカリ条件への曝露によって先に形成したエステル架橋が加水分解を受け、同時にヒドロキシ基におけるエーテル架橋の形成が抑制される傾向にある。このようにして得た架橋ヒアルロン酸粉末及び、該粉末に由来するゲルは、膨潤性及び増粘性が低くなるため、組織増大物質としての利用には不適であるが、一方で化粧品の保湿剤等への利用が期待できる。

#### 【0032】

従来の架橋ヒアルロン酸ゲルの製造方法では、液状媒体として水を用いるため、ヒアルロン酸水溶液が低濃度であっても非常に高い粘度となってしまう。

これに対し、本発明の方法においては、ヒアルロン酸粉末を溶解させずに粉末のまま液状媒体中に分散させるので、液相の増粘が起こらない。そのため、分散液は、マグネティックスターラーや攪拌棒、振とう機等により非常に容易に攪拌混合することができる。また、反応中においても液相の増粘が生じないため、高濃度のヒアルロン酸分散液を処理

#### 【0033】

また、本発明の製造方法によれば、従来、非常に時間のかかっていたヒアルロン酸の水への溶解工程が不要である。加えて、遠心分離やろ過等により、生成した架橋ヒアルロン酸を容易に分離することができるため、従来の方法に比べて、架橋剤や酸・アルカリ等の除去工程も大幅に簡素化される。したがって、本発明の製造方法によれば、従来のヒアルロン酸水溶液を用いた方法と比較して、非常に容易に架橋ヒアルロン酸を製造することが可能となり、製造時間やコストを大幅に低減できる。

#### 【0034】

さらに、前記従来製法の場合、架橋ヒアルロン酸は水を含むゲルの状態で得られるが、

これを公知の方法によって乾燥させて得た架橋ヒアルロン酸粉末は、これを再度水中に加えても膨潤することなく離水ないしは溶解してしまう。

これに対し、本発明の方法によって得た膨潤性架橋ヒアルロン酸粉末は、水中において500%以上の極めて高い膨潤率を示す。すなわち、本発明によって、従来実現不可能であった「膨潤性」架橋ヒアルロン酸粉末を得ることが可能となる。

#### 【実施例】

##### 【0035】

以下、具体的な実施例を挙げて、本発明についてさらに詳しく説明するが、本発明はこれらの実施例により限定されるものではない。

本発明者らは、最初に、ヒアルロン酸粉末を、1価低級アルコール／水の混合溶媒中に分散した状態で、架橋剤とともに混合し、膨潤性架橋ヒアルロン酸粉末の調製を試みた。

##### 【0036】

##### 実施例1、2

0. 1N水酸化ナトリウム水溶液10部、エタノール87部、架橋剤（エチレングリコールジグリシジルエーテル；デナコールEX810P、長瀬産業社製）3部を混合した反応液中に、ヒアルロン酸粉末（バイオヒアロ12、分子量120万、資生堂社製）を3.3W/V%となるように添加・分散して、室温（実施例1）又は45℃（実施例2）で16時間架橋反応を行なった。反応終了後、ヒアルロン酸粉末をろ過回収した後、エタノールを用いて洗浄し、乾燥させた。得られた架橋ヒアルロン酸粉末を過剰の精製水で膨潤させたところ、室温条件（実施例1）、45℃加温条件（実施例2）のいずれにおいても、無色澄明～白色の架橋ヒアルロン酸ゲルとなった。その際の架橋ヒアルロン酸粉末の膨潤率（重量）は、いずれも500%以上であった。

室温条件下で調製した実施例1の架橋ヒアルロン酸粉末について、過剰の精製水で膨潤させた状態の写真を図1（a）に、乾燥状態の写真を図2（a）に示す。膨潤させた状態の架橋ヒアルロン酸ゲルの大きさは約2～7mmであった。

##### 【0037】

##### 実施例3

架橋剤としてエチレングリコールジグリシジルエーテル3部に換えて、ジビニルスルホン3部を用いたほかは、上記実施例1、2と同様にして室温条件で架橋ヒアルロン酸粉末の調製を試みた。得られた架橋ヒアルロン酸粉末を過剰の精製水で膨潤させたところ、無色澄明～白色の架橋ヒアルロン酸ゲルとなった。この架橋ヒアルロン酸ゲルの大きさは約1～5mmであった。また、架橋ヒアルロン酸粉末の膨潤率（重量）は、500%以上であった。

##### 【0038】

##### 実施例4

架橋剤としてエチレングリコールジグリシジルエーテル3部に換えて、1,4-ブタンジオール・ジグリシジルエーテル3部を用いたほかは、上記実施例1、2と同様にして室温条件で架橋ヒアルロン酸粉末の調製を試みた。得られた架橋ヒアルロン酸粉末を過剰の精製水で膨潤させたところ、無色澄明～白色の架橋ヒアルロン酸ゲルとなった。この架橋ヒアルロン酸ゲルの大きさは約2～8mmであった。また、架橋ヒアルロン酸粉末の膨潤率（重量）は、500%以上であった。

##### 【0039】

##### 実施例5、6

0. 1N水酸化ナトリウム水溶液10部に換えて、精製水10部を用いたほかは、上記実施例1、2と同様にして、架橋ヒアルロン酸粉末の調製を試みた。得られた架橋ヒアルロン酸粉末を過剰の精製水で膨潤させたところ、室温条件（実施例5）、45℃加温条件（実施例6）のいずれにおいても、無色澄明～白色の架橋ヒアルロン酸ゲルとなった。その際の架橋ヒアルロン酸粉末の膨潤率（重量）は、いずれも500%以上であった。

室温条件下で調製した実施例5の架橋ヒアルロン酸粉末について、過剰の精製水で膨潤させた状態の写真を図1（b）に、乾燥状態の写真を図2（b）に示す。膨潤させた

状態の架橋ヒアルロン酸ゲルの大きさは約0.1～0.5 mmであった。

【0040】

上記実施例1～6において用いた原料、反応条件及びその結果をまとめたものを、下記表1に示す

【表1】

	実施例					
	1	2	3	4	5	6
ヒアルロン酸	3.3	3.3	3.3	3.3	3.3	3.3
0.1N 水酸化ナトリウム	10	10	10	10	-	-
精製水	-	-	-	-	10	10
エタノール	87	87	87	87	87	87
エチレングリコールジグリシジルエーテル	3	3	-	-	3	3
ジビニルホルモン	-	-	3	-	-	-
1,4-ブタンジオールジグリシジルエーテル	-	-	-	3	-	-
反応温度	室温	45℃	室温	室温	室温	45℃
架橋ヒアルロン酸ゲル生成 (膨潤率 500%以上)	○	○	○	○	○	○

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【0041】

上記実施例1～6より、エタノール／水の混合溶媒（エタノール：水＝10：89.7）を用い、この混合溶媒中にヒアルロン酸粉末を分散させた状態で架橋反応を行なうことによって、室温条件、45℃加温条件、各架橋剤のいずれにおいても、水中における膨潤率が500%の膨潤性架橋ヒアルロン酸粉末が得られることが明らかとなった。

なお、上記実施例1～6においては、架橋反応の際にヒアルロン酸粉末が液状媒体中に溶解していないため、液相の増粘が起こらず、攪拌等の操作が非常に容易であり、さらに、ろ過によって容易に生成物を分離することが可能であった。

【0042】

また、図1、2より、アルカリを添加した実施例1の粉末からは、より架橋反応が進み、大きな粒子のゲルが得られることがわかった（図1（a）及び図2（a））。他方、アルカリを添加しなかった実施例5の粉末においても、細かい粒子の架橋ヒアルロン酸ゲルが得られ、この1つ1つの粒子は純水膨潤することから、粒子内部での架橋が進行していることが認められた（図1（b）及び図2（b））。また、この架橋ヒアルロン酸粉末を水中で限界膨潤させたときのヒアルロン酸濃度は0.1～20重量%の範囲にあり、膨潤性及び粘弾性に優れた架橋ヒアルロン酸ゲルが得られることが明らかとなった。

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【0043】

実施例7、8

エタノール87部に換えて、イソプロパノール87部を用いたほかは、上記実施例1、2と同様にして、架橋ヒアルロン酸ゲルの調製を試みた。得られた架橋ヒアルロン酸粉末を過剰の精製水で膨潤させたところ、室温条件（実施例7）、45℃加温条件（実施例8）のいずれにおいても、無色澄明～白色の架橋ヒアルロン酸ゲルを得た。その際の架橋ヒアルロン酸粉末の膨潤率（重量）は、500%以上であった。

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【0044】

実施例9、10

エタノール87部に換えて、イソプロパノール87部を用いたほかは、上記実施例5、6と同様にして、架橋ヒアルロン酸ゲルの調製を試みた。得られた架橋ヒアルロン酸粉末を過剰の精製水で膨潤させたところ、室温条件（実施例9）、45℃加温条件（実施例10）のいずれにおいても、無色澄明～白色の架橋ヒアルロン酸ゲルを得た。その際の架橋

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ヒアルロン酸粉末の膨潤率（重量）は、500%以上であった。

【0045】

比較例 1

エタノール 87 部に換えて、エチレングリコール 87 部を用いたほかは、上記実施例 2 と同様にして、架橋ヒアルロン酸ゲルの調製を試みた。この結果、ヒアルロン酸粉末が混合溶媒中に溶解し、攪拌混合が不可能となったため、操作を中止した。

比較例 2

エタノール 87 部に換えて、アセトン 87 部を用いたほかは、上記実施例 2 と同様にして、架橋ヒアルロン酸ゲルの調製を試みた。得られた架橋ヒアルロン酸粉末を過剰の精製水で膨潤させたところ、分散媒が黄色く着色し、ヒアルロン酸が変質していることが示唆されたため、操作を中止した。また、架橋ヒアルロン酸粉末は水中で離水してしまい、膨潤率（重量）は、500%に満たなかった。

【0046】

上記実施例 7～10 及び比較例 1, 2 において用いた原料、反応条件及びその結果をまとめたものを、下記表 2 に示す。

【表 2】

	実施例				比較例	
	7	8	9	10	1	2
ヒアルロン酸	3.3	3.3	3.3	3.3	3.3	3.3
0.1N 水酸化ナトリウム	10	10	-	-	10	10
精製水	-	-	10	10	-	-
イソプロパノール	87	87	87	87	-	-
エチレングリコール	-	-	-	-	87	-
アセトン	-	-	-	-	-	87
架橋剤	3	3	3	3	3	3
反応温度	室温	45℃	室温	45℃	45℃	45℃
架橋ヒアルロン酸ゲル生成 （膨潤率 500%以上）	○	○	○	○	×	×

【0047】

上記実施例 7～10 より、イソプロパノール／水の混合溶媒（イソプロパノール：水＝10：3：89：7）を用いることによって、エタノール／水混合溶媒を用いた実施例 1～4 と同様に、室温条件、45℃加温条件のいずれにおいても、水中における膨潤率が 500%の膨潤性架橋ヒアルロン酸粉末が得られることが明らかとなった。

【0048】

一方、上記比較例 1 より、多価アルコールであるエチレングリコール／水の混合溶媒を用いた場合には、ヒアルロン酸粉末が溶解してしまい、攪拌混合が困難になるため、架橋ヒアルロン酸ゲルの製造を容易に行なうことはできなかった。また、上記比較例 2 より、アセトン／水の混合溶媒を用いた場合には、製造時にヒアルロン酸粉末は溶解しないものの、分散媒が黄色く着色してしまい、品質の良い架橋ヒアルロン酸粉末を得ることはできなかった。また、比較例 2 の粉末は水中でほとんど膨潤せず、膨潤率においても実施例 7～10 に及ばなかった。

【0049】

つづいて、本発明者らは、1 価低級アルコールと水との混合割合について検討するため、エタノールと水との質量比を適宜変化させて、上記実施例 2 と同様にして、膨潤性架橋ヒアルロン酸粉末の調製を試みた。

【0050】

実施例 1 1

精製水 20 部と、エタノール 77 部とを用いたほかは、上記実施例 2 と同様にして、架橋ヒアルロン酸粉末の調製を試みた。得られた架橋ヒアルロン酸粉末を過剰の精製水で膨潤させたところ、粉末に対する膨潤率が 500 % 以上の無色澄明～白色の架橋ヒアルロン酸ゲルを得た。

【0051】

#### 実施例 12

精製水 30 部と、エタノール 67 部とを用いたほかは、上記実施例 2 と同様にして、架橋ヒアルロン酸粉末の調製を試みた。得られた架橋ヒアルロン酸粉末を過剰の精製水で膨潤させたところ、粉末に対する膨潤率が 500 % 以上の無色澄明～白色の架橋ヒアルロン酸ゲルを得た。

【0052】

#### 比較例 3

精製水 40 部と、エタノール 57 部とを用いたほかは、上記実施例 2 と同様にして、架橋ヒアルロン酸粉末の調製を試みた。この結果、ヒアルロン酸粉末が混合溶媒中に溶解し、攪拌混合が不可能となったため、操作を中止した。

【0053】

上記実施例 11、12 及び比較例 3 において用いた原料、反応条件及びその結果をまとめたものを、下記表 3 に示す。

【表 3】

	実施例			比較例
	2	11	12	3
ヒアルロン酸	3.3	3.3	3.3	3.3
精製水	10	20	30	40
エタノール	87	77	67	57
架橋剤	3	3	3	3
エタノール：水（質量比）	89.7:10.3	79.4:20.6	69.1:30.9	58.8:41.2
反応温度	室温	室温	室温	室温
架橋ヒアルロン酸ゲル生成 （膨潤率 500% 以上）	○	○	○	○

【0054】

上記表 3 より、エタノール／水の質量比が約 90：10～70：30 の混合溶媒を用いた場合、溶媒におけるヒアルロン酸の溶解度が 0.1 g/L となり、膨潤性架橋ヒアルロン酸を粉末状態で得ることができることが明らかとなった。なお、前記各粉末を水膨潤させた架橋ヒアルロン酸ゲルの粒子の大きさは、水の割合が高くなるほど大きくなることがわかった（実施例 2 < 実施例 11 < 実施例 12）。

一方で、比較例 3 に示すとおり、水の割合が 40 % を超えると液相が増粘してしまい、攪拌混合が困難になるため、架橋ヒアルロン酸粉末を製造することはできなかった。

【0055】

本発明者がさらに検討を行なった結果、混合溶媒中の 1 価アルコールと水との質量比（1 価アルコール：水）が 65：35 程度まで、ヒアルロン酸粉末が溶解することなく、容易に膨潤性架橋ヒアルロン酸粉末の製造を行なうことができたことがわかった。

【0056】

本発明者らは、異なる方法で得た粉末状の架橋ヒアルロン酸について、膨潤性の有無を検討するため、下記比較例 4～6 の粉末による架橋ヒアルロン酸ゲル生成を上記実施例 2 と比較した。結果を下記表 4 に示す。

【0057】

#### 比較例 4

市販の架橋ヒアルロン酸ゲル（レスチレン、スウェーデン Q-Med 社製）を凍結乾燥

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させ、粉末状態とした。得られた粉末を過剰の精製水で再度膨潤させたところ、離水を起こしてしまい、元の架橋ヒアルロン酸ゲルとはならなかった。

【0058】

#### 比較例 5

市販の架橋ヒアルロン酸ゲル（ハイラフォーム、米国Genzyme社製）を凍結乾燥させ、粉末状態とした。得られた粉末を過剰の精製水で再度膨潤させたところ、離水を起こしてしまい、元の架橋ヒアルロン酸ゲルとはならなかった。

【0059】

#### 比較例 6

実施例 2 により得た架橋ヒアルロン酸粉末を過剰の精製水中で膨潤させて架橋ヒアルロン酸ゲルとした。前記ゲルを凍結乾燥させ、粉末状態とした。この粉末を過剰の精製水で再度膨潤させたところ、離水を起こしてしまい、元の架橋ヒアルロン酸ゲルとはならなかった。

【0060】

【表 4】

	実施例 2	比較例 4	比較例 5	比較例 6
架橋ヒアルロン酸ゲル生成 （膨潤率 500%以上）	○	×	×	×

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【0061】

上記表 4 に示すとおり、架橋ヒアルロン酸ゲルを乾燥させて粉末としても、再度膨潤させても架橋ヒアルロン酸ゲルを得ることはできないことが明らかである。したがって、膨潤率が 500% 以上の「膨潤性」架橋ヒアルロン酸「粉末」を得るためには、本発明にかかる製造方法が好適である。

【0062】

下記実施例及び比較例に示す架橋ヒアルロン酸ゲルについて、動的粘弾性の評価を行った。結果を図 3 に示す（図 3（a）実施例 13、（b）比較例 7、（c）比較例 8）。（動的粘弾性の測定）

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T A I n s t r u m e n t s 社製のストレス制御式レオメーター（A R 1 0 0 0 - N）を用い、a n g u l a r f r e q u e n c y 0.1~100（1/sec）の範囲にて貯蔵弾性率  $G'$  [Pa] 及び損失弾性率  $G''$  [Pa] を測定した。

【0063】

#### 実施例 13

0.1N水酸化ナトリウム水溶液 10 部、エタノール 87 部に、ヒアルロン酸粉末（バイオヒアロ 12、分子量 120 万、資生堂社製）を 3.3W/V% となるように添加・分散し、架橋剤（エチレングリコールジグリシジルエーテル；デナコール EX 810P、長瀬産業社製）3 部を添加混合し、90℃で 1 時間架橋反応を行なった。反応終了後、ヒアルロン酸粉末をろ過回収した後、エタノールによる洗浄及び乾燥を施し、膨潤性架橋ヒアルロン酸粉末を得た。該粉末を濃度 2 重量%として生理食塩水に加えて膨潤させ、得られた架橋ヒアルロン酸ゲルを粘弾性測定に使用した。

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【0064】

#### 比較例 7

市販の架橋ヒアルロン酸ゲル（レスチレン、スウェーデン Q-Med 社製）を粘弾性測定に使用した。

【0065】

#### 比較例 8

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市販ヒアルロン酸製剤（ハイラフォーム、米国Genzyme社製）を粘弾性測定に使用した。

【0066】

図3に示すとおり、本発明にかかる製造方法による架橋ヒアルロン酸ゲル（実施例13）は、皺伸ばし注入剤として用いられる市販の架橋ヒアルロン酸ゲル（比較例7、8）のほぼ中間に位置する優れた粘弾性を示した。

比較例7、8の架橋ヒアルロン酸ゲルは、ヒアルロン酸水溶液において架橋反応を行なって得られたものであり、粉末の状態を経ずに直接ゲルが生成されたと推察される。

以上の結果から、本発明にかかる製造方法により得られる膨潤性架橋ヒアルロン酸粉末は、膨潤により、組織増大物質として使用可能な優れた粘弾性を有するゲルとなることが明らかとなった。該粉末は、各周波数に依存しない優れた弾性を示すことから、特に皺伸ばし注入剤として好適であると考えられる。

【0067】

続いて、上記実施例13及び下記実施例14に示す架橋ヒアルロン酸ゲルについて、動的粘弾性を測定し、その特性を比較した。結果を図4に示す（図4（a）実施例13、（b）実施例14）。なお、動的粘弾性の測定方法は上記に準じて行なった。

【0068】

実施例14

0.001N水酸化ナトリウム水溶液10部、エタノール87部に、ヒアルロン酸粉末（バイオヒアロ12、分子量120万、資生堂社製）を3.3W/V%となるように添加・分散し、架橋剤（エチレングリコールジグリシジルエーテル；デナコールEX810P、長瀬産業社製）3部を添加混合し、90℃で1時間架橋反応を行なった。反応終了後、ヒアルロン酸粉末をろ過回収した後、エタノールによる洗浄及び乾燥を施し、膨潤性架橋ヒアルロン酸粉末を得た。該粉末を濃度2重量%として生理食塩水に加えて膨潤させ、得られた架橋ヒアルロン酸ゲルを粘弾性測定に使用した。

【0069】

図4に示すとおり、本発明にかかる膨潤性架橋ヒアルロン酸粉末から得た実施例13及び14の架橋ヒアルロン酸ゲルは、いずれも優れた粘弾性を示した。特に、製造系のアルカリ濃度を高くした実施例13では、実施例14に比べてゲルの貯蔵弾性率（ $G'$ ）に周波数依存性が少なく、また損失弾性率（ $G''$ ）が低かった。

以上のことから、本発明にかかる製造方法において、液状媒体に0.001～0.1Nアルカリ緩衝液を含有させて得た膨潤性架橋ヒアルロン酸粉末は、粘弾性に優れた架橋ヒアルロン酸ゲルとなることが明らかになった。特に、架橋反応時のアルカリ濃度を高めるほど、変形に対してより弾性的な性質を有するゲルを製造することができる。

【0070】

また、上記実施例14及び下記実施例15～17に示す架橋ヒアルロン酸ゲルについて、動的粘弾性を測定し、その特性を比較した。結果を図5に示す（図5（a）実施例14、（b）実施例15、（c）実施例16、（d）実施例17）。なお、動的粘弾性の測定方法は上記に準じて行なった。

【0071】

実施例15

0.001N塩酸水溶液10部、エタノール87部に、ヒアルロン酸粉末（バイオヒアロ12、分子量120万、資生堂社製）を3.3W/V%となるように添加・分散し、架橋剤（エチレングリコールジグリシジルエーテル；デナコールEX810P、長瀬産業社製）3部を添加混合し、90℃で1時間架橋反応を行なった。反応終了後、ヒアルロン酸粉末をろ過回収した後、エタノールによる洗浄及び乾燥を施し、膨潤性架橋ヒアルロン酸粉末を得た。該粉末を濃度2重量%として生理食塩水に加えて膨潤させ、得られた架橋ヒアルロン酸ゲルを粘弾性測定に使用した。

【0072】

実施例16

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0.001N水酸化ナトリウム水溶液10部、エタノール87部に、ヒアルロン酸粉末（バイオヒアロ12、分子量120万、資生堂社製）を3.3W/V%となるように添加・分散し、架橋剤（エチレングリコールジグリシジルエーテル；デナコールEX810P、長瀬産業社製）3部を添加混合し、90℃で1時間架橋反応を行なった。反応終了後、混合液をろ過してろ物を回収した後、エタノールによる洗浄及び乾燥を行なって架橋ヒアルロン酸粉末を得た。

その後、0.001N塩酸水溶液10部、エタノール87部に、前記架橋ヒアルロン酸粉末を3.3W/V%となるように添加・分散し、架橋剤（エチレングリコールジグリシジルエーテル；デナコールEX810P、長瀬産業社製）3部を添加混合し、90℃で1時間架橋反応を行なった。反応終了後、ヒアルロン酸粉末をろ過回収した後、エタノールによる洗浄及び乾燥を施し、膨潤性架橋ヒアルロン酸粉末を得た。該粉末を濃度2重量%として生理食塩水に加えて膨潤させ、得られた架橋ヒアルロン酸ゲルを粘弾性測定に使用した。

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#### 【0073】

##### 実施例17

0.001N塩酸水溶液10部、エタノール87部に、ヒアルロン酸粉末（バイオヒアロ12、分子量120万、資生堂社製）を3.3W/V%となるように添加・分散し、架橋剤（エチレングリコールジグリシジルエーテル；デナコールEX810P、長瀬産業社製）3部を添加混合し、90℃で1時間架橋反応を行なった。反応終了後、混合液をろ過してろ物を回収した後、エタノールによる洗浄及び乾燥を行なって架橋ヒアルロン酸粉末を得た。

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その後、0.001N水酸化ナトリウム水溶液10部、エタノール87部に、前記ヒアルロン酸粉末を3.3W/V%となるように添加・分散し、架橋剤（エチレングリコールジグリシジルエーテル；デナコールEX810P、長瀬産業社製）3部を添加混合し、90℃で1時間架橋反応を行なった。反応終了後、ヒアルロン酸粉末をろ過回収した後、エタノールによる洗浄及び乾燥を施し、膨潤性架橋ヒアルロン酸粉末を得た。該粉末を濃度2重量%として生理食塩水に加えて膨潤させ、得られた架橋ヒアルロン酸ゲルを粘弾性測定に使用した。

#### 【0074】

図5に示すとおり、アルカリ条件下でエーテル架橋を行なった実施例14及び酸条件下でエステル架橋を行なった実施例15の架橋ヒアルロン酸粉末を水膨潤させたゲルは、共に角周波数に依存しない優れた粘弾性を示した。また、エーテル架橋を行った後にエステル架橋を行って得た実施例16の2重架橋ヒアルロン酸粉末を水膨潤させたゲルも同様に高い粘弾性を示したが、実施例14及び15に比べ、損失弾性率（ $G''$ ）の低下が認められた。

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一方、エステル架橋を行った後にエーテル架橋を行った実施例17は、角周波数に依存して粘弾性が著しく低下した。

以上のことから、本発明にかかる製造方法において、アルカリ条件下又は酸条件下で架橋反応を行なって得た膨潤性架橋ヒアルロン酸粉末は、粘弾性に優れた架橋ヒアルロン酸ゲルとなることが明らかである。さらに、アルカリ条件下で架橋反応を行った後で、酸条件下で再度架橋反応を行なって得た膨潤性架橋ヒアルロン酸粉末は、変形に対してより弾性的な性質を有するゲルとすることができる。

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また、例えば、架橋ヒアルロン酸ゲルをしわ伸ばし剤として使用する場合、上記粘弾性に加え、生体内の酵素分解に対する耐性の点からも、2重に架橋した方が有利であると考えられる。

#### 【図面の簡単な説明】

#### 【0075】

【図1】本発明の実施例1及び実施例5により得られた架橋ヒアルロン酸粉末を過剰の精製水で膨潤させた状態の写真図である（（a）実施例1，（b）実施例5）。

【図2】本発明の実施例1及び実施例5により得られた架橋ヒアルロン酸粉末の乾燥状態

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の写真図である（（a）実施例 1、（b）実施例 5）。

【図 3】本発明の実施例 1 3 により得られた架橋ヒアルロン酸ゲル、及び、従来の製造方法による市販の架橋ヒアルロン酸ゲルにより得られたヒアルロン酸ゲルの動的粘弾性を比較したグラフである（（a）実施例 1 3、（b）：比較例 7、（c）：比較例 8）。

【図 4】本発明の実施例 1 3 及び実施例 1 4 により得られた架橋ヒアルロン酸ゲルの動的粘弾性を比較したグラフである（（a）：実施例 1 3、（b）：実施例 1 4）。

【図 5】本発明の実施例 1 4 ～ 1 7 により得られたヒアルロン酸ゲルの動的粘弾性を比較したグラフである（（a）：実施例 1 3、（b）：実施例 1 4、（c）：実施例 1 5、（d）：実施例 1 6）。

【図 1】

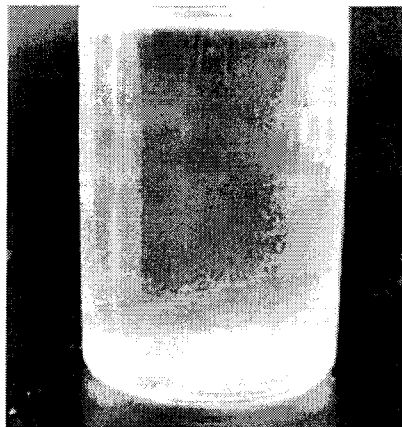
### 実施例1

(a)



### 実施例5

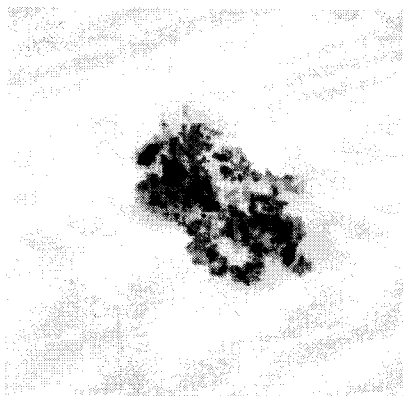
(b)



【図 2】

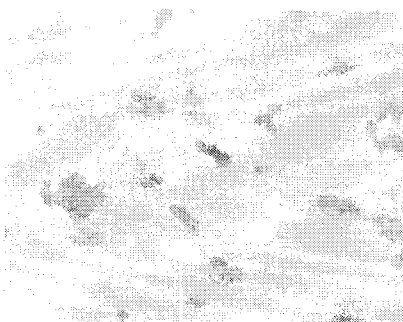
### 実施例 1

(a)



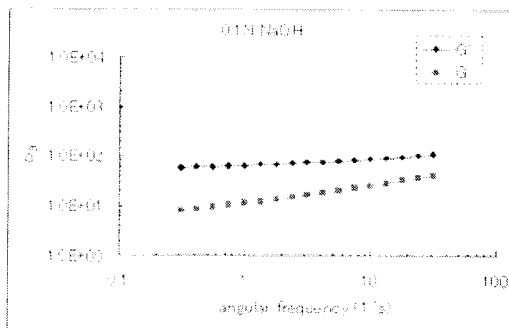
### 実施例 5

(b)

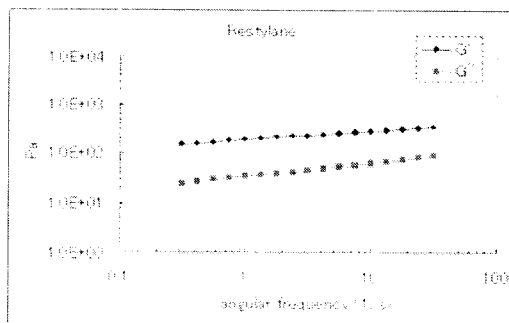


【図3】

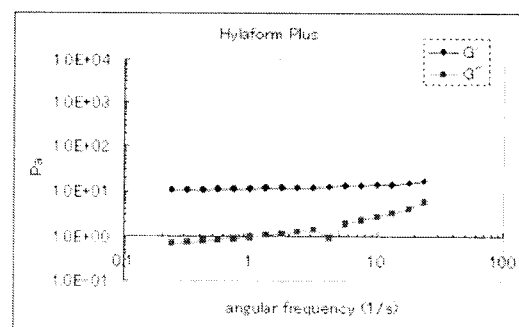
(a)



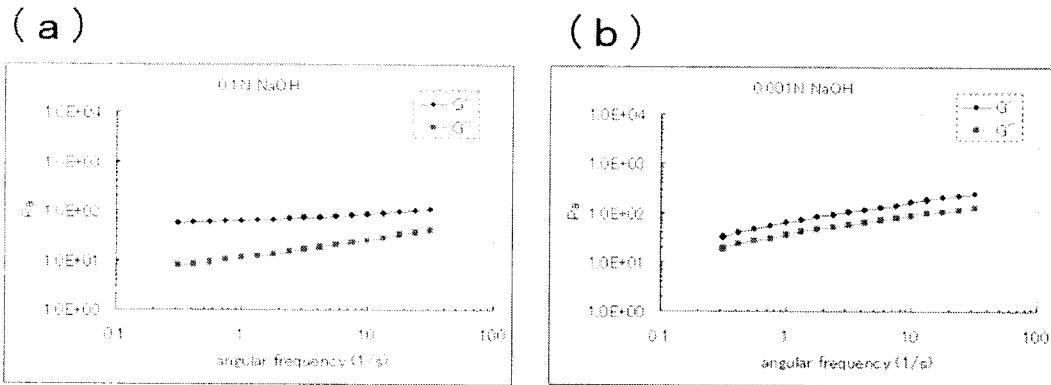
(b)



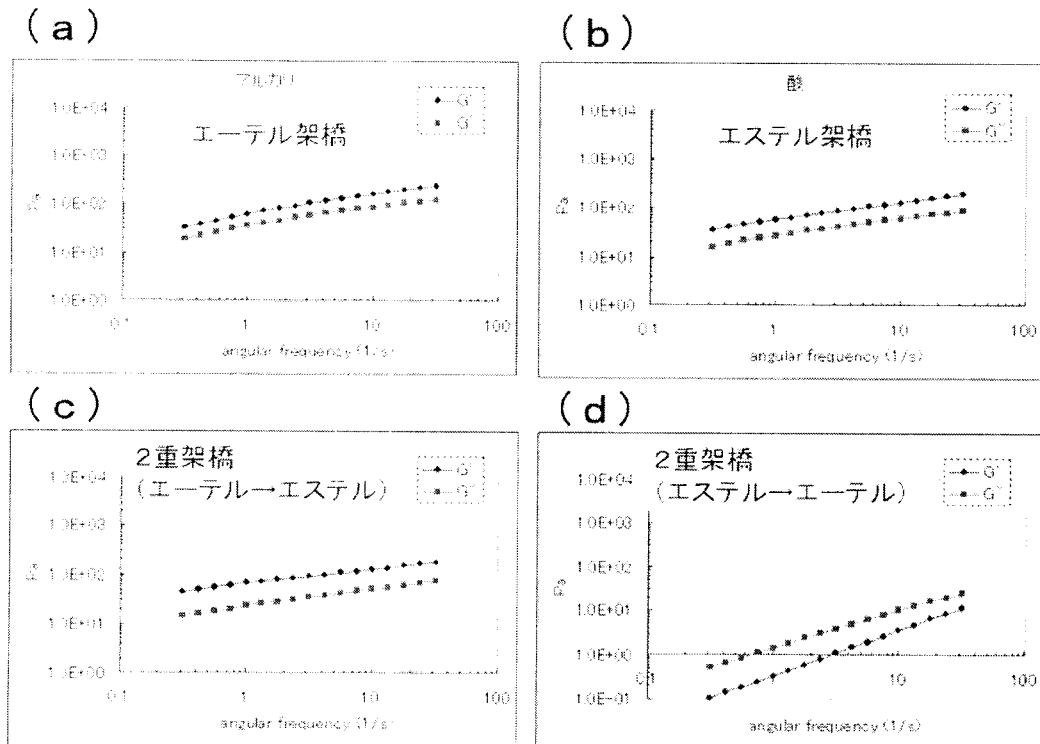
(c)



【図 4】



【図 5】



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フロントページの続き

(58)調査した分野(Int.Cl., DB名)

C08B 37/08

CA/REGISTRY(STN)

JSTPlus/JMEDPlus/JST7580(JDreamII)

Allowed Claims of PCT/JP2008/067508 that issued at JP

Claim 1: A swellable crosslinked hyaluronan powder characterized by having a swelling ratio in water of 500% or more, and comprising  
mixing (a) a hyaluronan powder,  
(b) a liquid medium containing a monovalent alcohol having 1 to 4 carbon atoms and having a solubility of the hyaluronan powder of less than 0.1 g/L and  
(c) a crosslinking agent, to cause a crosslinking reaction, and  
wherein the hyaluronan powder is in a state of dispersed in the liquid medium during the mixing step.

Claim 2: The swellable crosslinked hyaluronan powder according to claim 1, having a concentration of the hyaluronan of 0.1 to 20% by weight when the powder is swollen with water to its utmost limit.

Claim 3: A method for producing the swellable crosslinked hyaluronan powder, comprising

mixing (a) a hyaluronan powder,  
(b) a liquid medium containing a monovalent alcohol having 1 to 4 carbon atoms and having solubility of the hyaluronan powder of less than 0.1 g/L and  
(c) a crosslinking agent, to cause a crosslinking reaction, and  
wherein the hyaluronan powder is in a state dispersed in the liquid medium during the mixing step.

Claim 4: The method for producing the swellable crosslinked hyaluronan powder according to claim 3, the liquid medium is a solvent mixture of the monovalent alcohol and water.

Claim 5: The method for producing the swellable crosslinked hyaluronan powder according to claim 3 or 4, the monovalent alcohol is ethanol or 2-propanol.

Claim 6: The method for producing the swellable crosslinked hyaluronan powder according to any of claims 3 to 5, the mixing ratio of the monovalent alcohol to water is 99.9:0.1 to 65:35 as the mass ratio.

Claim 7: The method for producing the swellable crosslinked hyaluronan powder according to any of claims 3 to 6, the water is an alkaline buffer solution or an acidic buffer solution.

Claim 8: The method for producing the swellable crosslinked hyaluronan

powder according to any of claims 3 to 7, the crosslinking agent is divinyl sulfone, 1, 4-butanediol diglycidyl ether and/or ethylene glycol diglycidyl ether.

Claim 9: A method for producing the swellable crosslinked hyaluronan powder, comprising

- (1) mixing (a) a hyaluronan powder,
  - (b) a solvent containing a monovalent alcohol having 1 to 4 carbon atoms and an alkaline buffer solution and having solubility of the hyaluronan powder of less than 0.1 g/L and
  - (c) a crosslinking agent, to cause a crosslinking reaction, and wherein the hyaluronan powder is in a state dispersed in the solvent during the mixing step, and
- (2) mixing (a) a product in the step (1),
  - (b) a solvent containing a monovalent alcohol having 1 to 4 carbon atoms and an acidic buffer solution and having a solubility of the hyaluronan powder of less than 0.1 g/L and
  - (c) a crosslinking agent, to cause a crosslinking reaction, and wherein the product in the step (1) is in a state dispersed in the solvent during the mixing step.

Claim 10: The method for producing the swellable crosslinked hyaluronan powder according to claim 9, the mixing ratio of the monovalent alcohol to the alkaline buffer solution or the acidic buffer solution is 99.9:0.1 to 65:35 as the mass ratio.

Claim 11: The method for producing the swellable crosslinked hyaluronan powder according to claim 9 or 10, the crosslinking agent is divinyl sulfone, 1, 4-butanediol diglycidyl ether, and/or ethylene glycol diglycidyl ether.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/679,744	03/24/2010	Tetsunori Matsumoto	IWI-19869	9289
7609 7590 12/23/2010 RANKIN, HILL & CLARK LLP 23755 Lorain Road - Suite 200 North Olmsted, OH 44070-2224			EXAMINER	
			ART UNIT	PAPER NUMBER
			1623	
			MAIL DATE	DELIVERY MODE
			12/23/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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DEC 23 2010

Commissioner for Patents  
United States Patent and Trademark Office  
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RANKIN, HILL & CLARK LLP  
23755 Lorain Road - Suite 200  
North Olmsted OH 44070-2224

In re Application of	:	
MATSUMOTO, TETSUNORI	:	DECISION ON REQUEST TO
Application No. 12/679,744	:	PARTICIPATE IN PCT-PATENT
Filed: March 24, 2010	:	PROSECUTION HIGHWAY PILOT
Attorney Docket No. IWI-19869	:	PROGRAM AND PETITION
	:	TO MAKE SPECIAL UNDER
	:	37 CFR 1.102(d)

This is a decision on the request to participate in the PCT-Patent Prosecution Highway (PPH) Pilot program and the petition under 37 CFR 1.102(d), filed August 9, 2010, and November 16, 2010 to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PCT- PPH Pilot program and petition to make special require:

- (1) The U.S. application is a national stage entry of the corresponding JPO PCT application;
- (2) The latest work product in the international phase of the PCT application corresponding to the US application, namely the WO/ISA, or the WO/IPEA, or the IPER, indicates at least one claim in the PCT claim has novelty, inventive step and industrial applicability.
- (3) Applicant must submit a copy of the allowable/patentable claim(s) from the corresponding PCT application(s) along with an English translation thereof;
- (4) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the PCT application;
- (5) Examination of the U.S. application has not begun;
- (6) Unless already filed in the U.S. application for which participation in the PCT-PPH pilot program is requested, applicant must submit a copy of the latest international work product, WO/ISA, or WO/IPEA or IPER, which indicated that the claim(s) has/have novelty, inventive step and industrial applicability along with an English translation thereof;
- (7) Applicant must submit an IDS listing the documents cited international work product, WO/ISA, or WO/IPEA or IPER along with copies of documents except U.S. patents or U.S. patent application publications; and

The request to participate in the PCT-PPH Pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Ram R. Shukla at 571-272-0735.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system at the <http://www.uspto.gov/ebc/index.html>.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

A handwritten signature in black ink, appearing to be 'R. Shukla', written over a horizontal line.

Ram R. Shukla, Ph.D.

Supervisory Patent Examiner

TC 1600

RAM R. SHUKLA, PH.D.  
SUPERVISORY PATENT EXAMINER



UNITED STATES PATENT AND TRADEMARK OFFICE

02 AUG 2010

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United States Patent and Trademark Office  
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[www.uspto.gov](http://www.uspto.gov)

LAW OFFICE OF DELIO & PETERSON, LLC.  
121 WHITNEY AVENUE  
NEW HAVEN CT 06510

In re Application of  
JUSTEN, et al.

Application No.: 12/679,777

PCT No.: PCT/F2008/001319

Int. Filing Date: 23 September 2008

Priority Date: 25 September 2007

Attorney Docket No.: LESA100002000

For: USE OF A NOVEL NATURAL AGENT IN  
COSMETIC COMPOSITIONS

DECISION ON PETITION

UNDER 37 CFR 1.181

This decision is in response to applicant's petition under 37 CFR 1.181 filed 20 July 2010 in the United States Patent and Trademark Office (USPTO). No petition fee is due.

**BACKGROUND**

On 23 September 2008, applicant filed international application PCT/FR2008/001319, which claimed priority to an earlier application filed 25 September 2007. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 18 June 2009. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 25 March 2010.

On 24 March 2010, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by among other items, payment of the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 04 May 2010, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 03 June 2010, applicant filed an executed combined declaration and power of attorney. The declaration instructed the USPTO to send correspondence to:

David Chen  
DeLIO & PETERSON, LLC  
121 Whitney Avenue  
New Haven, CT 06510

Application No.: 12/679,777

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Customer No.: 79906

On 16 June 2010, applicant filed a change of correspondence address application (Form PTO/SB/122) asking that the correspondence address be changed to that associated with customer number 22891. The form was signed by Anthony P. Delio.

On 20 July 2010, applicant filed the petition under 37 CFR 1.181 discussed herein asking that the correspondence address be changed back to the associated with customer number 79906. The petition was signed by David Chen.

### **DISCUSSION**

Applicant in the present petition states that, "Anthony Delio did not submit a new Power of Attorney. Even though no new Power of Attorney signed by the Applicant naming Anthony Delio as the new attorney of record was submitted, the United States Patent and Trademark Office changed the correspondence address from David Chen to Anthony Delio."

Applicant is advised that correspondence address has not changed from the address listed on the declaration filed 03 June 2010. What has changed is the customer number associated with the application. As to the contention that Anthony Delio did not file a new power of attorney, Mr. Delio was listed among the attorneys appointed in the original combined declaration and power of attorney filed 03 June 2010. As such, it was proper for the USPTO to make the requested change signed by Mr. Delio.

Applicant is advised that the office will not entertain competing requests for changes in correspondence addresses and customer numbers from the attorneys appointed in this case. Absent a revocation and power of attorney which solely appoints David Chen accompanied by a new request for change to the customer number, the customer number and correspondence address will remain as is.


### **CONCLUSION**

Applicant's petition under 37 CFR 1.181 is **DISMISSED**.

Application No.: 12/679,777

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Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294

cc:

David Chen  
IP ATTORNEYS GROUP LLC  
57 Plains Road, Suite 3A  
Milford, CT 06461



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**MAILED**

**JUN 08 2011**

**OFFICE OF PETITIONS**

**ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE NC 28280-4000**

In re Application of  
Skaja et al.  
Application No. 12/679,810  
Filed: June 17, 2010  
Attorney Docket No. 053600/387359

DECISION ON PETITION  
TO WITHDRAW  
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 20, 2011.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40 (c).

The request was signed by Trent A. Kirk on behalf of all the practitioners of record associated with Customer Number 00826.

Customer Number 00826 has been withdrawn as attorney from record. Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

There are no outstanding Office actions mailed that requires a reply.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-6059. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Alicia Kelley-Collier  
Petitions Examiner  
Office of Petitions

cc: AETREX WORLDWIDE, INC.  
414 ALFRED AVENUE  
TEANECK, NJ 07666



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/679,810	06/17/2010	Joseph J. Skaja	053600/387359

**CONFIRMATION NO. 9718**

**POWER OF ATTORNEY NOTICE**



826  
ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

Date Mailed: 06/07/2011

**NOTICE REGARDING CHANGE OF POWER OF ATTORNEY**

This is in response to the Power of Attorney filed 04/20/2011.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

/atkelley-collier/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

20 SEP 2010



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Alexandria, VA 22313-1450  
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PEDERSEN & COMPANY, PLLC  
P.O. BOX 2666  
BOISE ID 83701

In re Application of	:	
HOPKINS, Andrew, et al.	:	
Application No.: 12/679,850	:	DECISION
PCT No.: PCT/GB2008/002162	:	
Int. Filing Date: 25 June 2008	:	ON PETITION UNDER
Priority Date: 25 June 2007	:	
Docket No.: 4793	:	37 CFR 1.137(b)
For: READER DEVICE AND METHODS	:	
OF USE	:	

Applicant's Petition For Revival Under 37 CFR 1.137(b), filed in the above-captioned application on 22 July 2010 is **GRANTED**.

Applicant states that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," as required by 37 CFR 1.137(b)(3). The basic national fee and petition fee have been paid. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

The surcharge for late filing of the search fee, examination fee or oath or declaration will be charged to deposit account no. 50-2236, as authorized.

/Erin P. Thomson/

Erin P. Thomson  
Attorney Advisor  
PCT Legal Administration

Telephone: 571-272-3292